No 220

Supreme Court, U.S.
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United States Court of Appeals

FOR THE SECOND CIRCUIT

EDWARD B. MARKS MUSIC CORPORATION,

Plaintiff-Appellant-Appellee,

against

CHARLES K. HARRIS MUSIC PUBLISHING CO., INC.,

Defendant-Appellee-Appellant.

PLAINTIFF-APPELLANT-APPELLEE'S APPENDIX

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INDEX

	PAGE
Statement Under Rule 15(b)	1a
Complaint	3a
Exhibits A-E, Annexed to Complaint	18a
Opinion After Trial	19a
Judgment	24a
Plaintiff's Motion to Amend Judgment and for Further Relief	28a
Affidavit in Support of Plaintiff's Motion	29a
Affidavit in Opposition to Plaintiff's Motion	42a
Affidavit for Adjournment of Trial Upon Consent	52a
Affidavit for Adjournment of Trial at Request of Both Parties	53a
Affidavit for Adjournment of Trial Upon Consent	54a
Affidavit for Adjournment of Trial Upon Consent	55a
Affidavit for Adjournment of Trial Upon Consent	56a
Affidavit for Adjournment of Trial at Request of Both Parties	57a
Affidavit for Adjournment of Trial at Request of Both Parties	58a
Affidavit for Adjournment of Pre-trial Hearing Upon Consent	59a
Exhibit "A"	60a
Stipulation Extending Defendant's Time to Appear for Examinations Before Trial	61a

PAGE

Affidavit for Adjournment of Pre-trial Hearing at Request of Both Parties 62a

Affidavit for Adjournment of Trial at Request of Both Parties 63a

Stipulation Extending Defendant's Time to Appear for Examination Before Trial 64a

Stipulation for Adjournment of Pre-Trial Hearing Upon Consent 65a

Affidavit for Adjournment of Trial at Request of Both Parties 66a

Affidavit for Adjournment of Trial at Request of Both Parties 67a

Affidavit for Adjournment of Trial at Request of Defendant 68a

Affidavit for Adjournment of Trial at Request of Both Parties 69a

Affidavit for Adjournment of Trial at Request of Defendant 70a

Affidavit for Adjournment of Trial at Request of Defendant. 71a

Affidavit for Adjournment of Trial Upon Consent ... 72a

Opinion Upon Plaintiff's Motion 73a

Amended Judgment 75a

Plaintiff's Notice of Appeal 81a

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FOR THE SECOND CIRCUIT

EDWARD B. MARKS MUSIC CORPORATION,

Plaintiff-Appellant-Appellee,

against

CHARLES K. HARRIS MUSIC PUBLISHING CO., INC.,

Defendant-Appellee-Appellant.

Statement Under Rule 15(b).

This suit was commenced by the filing of the complaint on August 31, 1944. The names of the original parties appear in the above caption. The answer of the defendant was filed on November 6, 1944. The defendant was not arrested, no bail was taken, and its property was not attached.

The action was tried before Honorable Sylvester J. Ryan, District Judge, on April 18, 1955, upon an agreed statement of facts supported by additional evidence offered by both parties. On July 25, 1955, the District Judge filed his opinion, in which he found that the plaintiff was entitled to judgment declaring it to be the owner of the renewal copyrights in the litigated compositions. On September 23, 1955, judgment was entered pursuant thereto and whereby the District Court retained jurisdiction of the cause in all respects for the purpose of enforcing the provisions thereof and for the purpose of issuing such further orders and directions upon application of

either party as might be necessary or appropriate to make the decree effective. On September 29, 1949, the plaintiff moved the District Court, pursuant to Rule 59 (e) F.R.C.P. to alter and amend the judgment in certain particulars, and pursuant to Section 2202, Title 28, U.S.C. for such further relief as prayed for in the complaint based upon said declaratory judgment as is available under the Copyright Act for the infringement of the said renewal copyrights of the plaintiff. On December 6, 1955, the District Judge filed his opinion granting in part the motion to alter and amend the judgment and denying the motion for such further relief. On February 3, 1956, an amended judgment was entered pursuant thereto.

On February 28, 1958, the plaintiff filed its notice of appeal from so much of the amended judgment as denied the plaintiff's said application for further relief based thereon, and a bond for costs on appeal was filed concurrently therewith.

On March 2, 1956, the defendant filed its notice of appeal from so much of the amended judgment as adjudged the plaintiff to be the owner of the renewal copyrights in the litigated compositions and that the plaintiff should have certain incidental relief, and a bond for costs on appeal was filed concurrently therewith.

The plaintiff appeared by Julian T. Abeles and the defendant appeared by Arthur L. Fishbein.

Complaint.

(Record pages 26-42)

Plaintiff, by its attorney Julian T. Abeles, respectfully alleges:

FOR A FIRST CAUSE OF ACTION

1. Plaintiff is a corporation incorporated under the laws of the State of New York and defendant is a corporation incorporated under the laws of the State of New Jersey. The matter in controversy exceeds, exclusive of interest and costs, the sum of three thousand dollars. This action likewise arises under the Act of March 4, 1909, Chap. 320, 35 Stat. 1075 et seq.; U.S.C., Title 17, in force July 1, 1909, and the amendments thereto, as hereinafter more fully appears.

2. This action is brought under Section 274-D of the Judicial Code, 28 U.S.C. § 400, because there is an actual controversy now existing between the parties, in respect to which plaintiff needs a declaration of its rights by this Court.

3. Prior to the year 1910, one Joseph E. Howard, who then was and ever since has been a citizen of the United States, either alone or in collaboration with one or more other writers who then were and ever since have been citizens of the United States, created and wrote certain original musical compositions, listed in Exhibit A hereto annexed and made a part hereof, which musical compositions contain a large amount of material wholly original with said Joseph E. Howard and said co-writers and is copyrightable subject matter under the laws of the United States.

4. On the respective dates set forth in Exhibit A annexed, said Joseph E. Howard, or those in interest with

or through him, duly copyrighted said musical compositions by duly complying in all respects with the United States Copyright Law and all other laws governing copyright, and secured the exclusive rights and privileges in and to the copyrights of said musical compositions, and received from the Register of Copyrights a certificate of the registration of the claim to each of said copyrights, identified by the respective entry numbers set forth in Exhibit A annexed.

5. On the respective dates set forth in Exhibit A annexed, being in each instance during the year prior to the expiration of each said copyright, said Joseph E. Howard, being then living and having become entitled thereto, duly renewed and extended each of said copyrights for the further term of 28 years in his name as author, by duly complying in all respects with the Act of March 4, 1909, as amended, and all other laws governing copyright, and received from the Register of Copyrights a certificate that each said application for the renewal and extension of each said copyright was duly registered in the Copyright Office, identified by the respective entry numbers set forth in Exhibit A annexed.

6. By a written instrument made and dated June 6, 1933, said Joseph E. Howard, for a valuable consideration to him, assigned to plaintiff the renewal copyrights in the musical compositions listed in Exhibit A annexed.

7. After the registration in his name of the respective renewal copyrights in the musical compositions listed in Exhibit A annexed, and pursuant to said instrument dated June 6, 1933, said Joseph E. Howard, by a written instrument made and dated March 3, 1936, and recorded in the Copyright Office on March 4, 1936, book 346, pages 177-178, for a valuable consideration to him, assigned to plaintiff said renewal copyrights in said musical compositions

8. Since June 6, 1933, plaintiff has been and still is the sole proprietor of the interest of said Joseph E. Howard in said renewal copyrights in the musical compositions listed in Exhibit A annexed.

9. Defendant acting under the purported claim that it acquired by assignment from said Joseph E. Howard his interest in the renewal copyrights in the musical compositions listed in Exhibit A annexed, has represented and asserted and continues to represent and assert, to the trade and prospective users and licensees of rights to said musical compositions, that it is the owner of said interest therein and has the sole right and authority to exercise and license such rights thereunder, and to realize all benefits therefrom to its own use and purpose, and that plaintiff has no right or interest therein or thereto.

10. No assignment to defendant of any interest of said Joseph E. Howard in said renewal copyrights in the musical compositions listed in Exhibit A annexed, executed prior to the execution or recording of said assignment of March 3, 1936 by said Joseph E. Howard to plaintiff of his interest therein, was ever recorded in the Copyright Office within the time prescribed in Sec. 44 of the Act of March 4, 1909, as amended, and at the time of the execution or recording of said assignment by said Joseph E. Howard to plaintiff of March 3, 1936 plaintiff had no notice or knowledge of any such assignment to defendant.

11. By reason of such acts of defendant, defendant has seriously hampered and interfered with plaintiff in the exercising and licensing of its rights under the interest of said Joseph E. Howard to said renewal copyrights in the musical compositions listed in Exhibit A annexed, and has prevented plaintiff from exercising and licensing such rights, and from realizing substantial returns which would

otherwise inure to plaintiff therefrom, in that by reason of such claim of defendant the trade and prospective users and licensees have been unwilling to have dealings with plaintiff involving such rights or to make payment to plaintiff therefor.

12. By reason of such claim of defendant, a serious conflict has arisen between plaintiff and defendant as to the title to the interest of said Joseph E. Howard in said renewal copyrights in the musical compositions listed in Exhibit A annexed, and there is an actual controversy between plaintiff and defendant in respect thereto.

FOR A SECOND CAUSE OF ACTION

13. Plaintiff repeats and realleges each and every allegation contained in paragraphs 1 and 2, with the same force and effect as if here set forth.

14. Prior to the year 1911, one Joseph E. Howard, who then was and ever since has been a citizen of the United States, either alone or in collaboration with one or more other writers who then were and ever since have been citizens of the United States, created and wrote certain original musical compositions, listed in Exhibit B hereto annexed and made a part hereof, which musical compositions contain a large amount of material wholly original with said Joseph E. Howard and said co-writers and is copyrightable subject matter under the laws of the United States.

15. On the respective dates set forth in Exhibit B annexed, said Joseph E. Howard, or those in interest with or through him, duly copyrighted said musical compositions by duly complying in all respects with the United States Copyright [illegible] and all other laws [illegible]

right, and secured the exclusive rights and privileges in and to the copyrights of said musical compositions, and received from the Register of Copyrights a certificate of the registration of the claim to each of said copyrights, identified by the respective entry numbers set forth in Exhibit B annexed.

16. On the respective dates set forth in Exhibit B annexed, being in each instance during the year prior to the expiration of each said copyright, said Joseph E. Howard, being then living and having become entitled thereto, duly renewed and extended each of said copyrights for the further term of 28 years in his name as author, by duly complying in all respects with the Act of March 4, 1909, as amended, and all other laws governing copyright, and received from the Register of Copyrights a certificate that each said application for the renewal and extension of each said copyright was duly registered in the Copyright Office, identified by the respective entry numbers set forth in Exhibit B annexed.

17. By a written instrument made and dated June 6, 1933, said Joseph E. Howard, for a valuable consideration to him, assigned to plaintiff the renewal copyrights in the musical compositions listed in Exhibit B annexed.

18. After the registration in his name of the respective renewal copyrights in the musical compositions listed in Exhibit B annexed, and pursuant to said instrument dated June 6, 1933, said Joseph E. Howard, by a written instrument made and dated November 3, 1937, and recorded in the Copyright Office on November 4, 1937, book 385, pages 219-220, for a valuable consideration to him, assigned to plaintiff said renewal copyrights in said musical compositions.

19. Since June 6, 1933, plaintiff has been and still is the sole proprietor of the interest of said Joseph E. Howard in said renewal copyrights in the musical compositions listed in Exhibit B annexed.

20. Defendant acting under the purported claim that it acquired by assignment from said Joseph E. Howard his interest in the renewal copyrights in the musical compositions listed in Exhibit B annexed, has represented and asserted and continues to represent and assert, to the trade and prospective users and licensees of rights to said musical compositions, that it is the owner of said interest therein and has the sole right and authority to exercise and license such rights thereunder, and to realize all benefits therefrom to its own use and purpose, and that plaintiff has no right or interest therein or thereto.

21. No assignment to defendant of any interest of said Joseph E. Howard in said renewal copyrights in the musical compositions listed in Exhibit B annexed, executed prior to the execution or recording of said assignment of November 3, 1937 by said Joseph E. Howard to plaintiff of his interest therein, was ever recorded in the Copyright Office within the time prescribed in Sec. 44 of the Act of March 4, 1909, as amended, and at the time of the execution or recording of said assignment by said Joseph E. Howard to plaintiff of November 3, 1937 plaintiff had no notice or knowledge of any such assignment to defendant.

22. By reason of such acts of defendant, defendant has seriously hampered and interfered with plaintiff in the exercising and licensing of its rights under the interest of said Joseph E. Howard to said renewal copyrights in the musical compositions listed in Exhibit B annexed, and has prevented plaintiff from exercising and licensing such rights, and from realizing substantial returns which would

otherwise inure to plaintiff therefrom, in that by reason of such claim of defendant the trade and prospective users and licensees have been unwilling to have dealings with plaintiff involving such rights or to make payment to plaintiff therefor.

23. By reason of such claim of defendant, a serious conflict has arisen between plaintiff and defendant as to the title to the interest of said Joseph E. Howard in said renewal copyrights in the musical compositions listed in Exhibit B annexed, and there is an actual controversy between plaintiff and defendant in respect thereto.

FOR A THIRD CAUSE OF ACTION

24. Plaintiff repeats and realleges each and every allegation contained in paragraphs 1 and 2, with the same force and effect as if here set forth.

25. Prior to the year 1917, one Joseph E. Howard, who then was and ever since has been a citizen of the United States, either alone or in collaboration with one or more other writers who then were and ever since have been citizens of the United States, created and wrote certain original musical compositions, listed in Exhibit C hereto annexed and made a part hereof, which musical compositions contain a large amount of material wholly original with said Joseph E. Howard and said co-writers and is copyrightable subject matter under the laws of the United States.

26. On the respective dates set forth in Exhibit C annexed, said Joseph E. Howard, or those in interest with or through him, duly copyrighted said musical compositions by duly complying in all respects with the United States Copyright Law and all other laws governing copyright, and secured the exclusive rights and privileges in and to the

copyrights of said musical compositions, and received from the Register of Copyrights a certificate of the registration of the claim to each of said copyrights, identified by the respective entry numbers set forth in Exhibit C annexed.

27. On the respective dates set forth in Exhibit C annexed, being in each instance during the year prior to the expiration of each said copyright, said Joseph E. Howard, being then living and having become entitled thereto, duly renewed and extended each of said copyrights for the further term of 28 years in his name as author, by duly complying in all respects with the Act of March 4, 1909, as amended, and all other laws governing copyright, and received from the Register of Copyrights a certificate that each said application for the renewal and extension of each said copyright was duly registered in the Copyright Office, identified by the respective entry numbers set forth in Exhibit C annexed.

28. By a written instrument made and dated June 6, 1933, said Joseph E. Howard, for a valuable consideration to him, assigned to plaintiff the renewal copyrights in the musical compositions listed in Exhibit C annexed.

29. After the registration in his name of the respective renewal copyrights in the musical compositions listed in Exhibit C annexed, and pursuant to said instrument dated June 6, 1933, said Joseph E. Howard, by a written instrument made and dated May 9, 1944, and recorded in the Copyright Office on May 10, 1944, book 536, pages 219-220, for a valuable consideration to him, assigned to plaintiff said renewal copyrights in said musical compositions.

30. Since June 6, 1933, plaintiff has been and still is the sole proprietor of the interest of said Joseph E. Howard in said renewal copyrights in the musical compositions listed in Exhibit C annexed.

31. Defendant acting under the purported claim that it acquired by assignment from said Joseph E. Howard his interest in the renewal copyrights in the musical compositions listed in Exhibit C annexed, has represented and asserted and continues to represent and assert, to the trade and prospective users and licensees of rights to said musical compositions, that it is the owner of said interest therein and has the sole right and authority to exercise and license such rights thereunder, and to realize all benefits therefrom to its own use and purpose, and that plaintiff has no right or interest therein or thereto.

32. No assignment to defendant of any interest of said Joseph E. Howard in said renewal copyrights in the musical compositions listed on Exhibit C annexed, executed prior to the execution or recording of said assignment of May 9, 1944 by said Joseph E. Howard to plaintiff of his interest therein, was ever recorded in the Copyright Office within the time prescribed in Sec. 44 of the Act of March 4, 1909, as amended, and at the time of the execution or recording of said assignment by said Joseph E. Howard to plaintiff of May 9, 1944, plaintiff had no notice or knowledge of any such assignment to defendant.

33. By reason of such acts of defendant, defendant has seriously hampered and interfered with plaintiff in the exercising and licensing of its rights under the interest of said Joseph E. Howard to said renewal copyrights in the musical compositions listed in Exhibit C annexed, and has prevented plaintiff from exercising and licensing such rights, and from realizing substantial returns which would otherwise inure to plaintiff therefrom, in that by reason of such claim of defendant the trade and prospective users and licensees have been unwilling to have dealings with plaintiff involving such rights or to make payment to plaintiff therefor.

34. By reason of such claim of defendant, a serious conflict has arisen between plaintiff and defendant as to the title to the interest of said Joseph E. Howard in said renewal copyrights in the musical compositions listed in Exhibit C annexed, and there is an actual controversy between plaintiff and defendant in respect thereto.

FOR A FOURTH CAUSE OF ACTION

35. Plaintiff repeats and realleges each and every allegation contained in paragraphs 1 and 2, with the same force and effect as if here set forth.

36. Prior to the year 1909, one Joseph E. Howard, who then was and ever since has been a citizen of the United States, either alone or in collaboration with one or more other writers who then were and ever since have been citizens of the United States, created and wrote certain original musical compositions, listed in Exhibit D hereto annexed and made a part hereof, which musical compositions contain a large amount of material wholly original with said Joseph E. Howard and said co-writers and is copyrightable subject matter under the laws of the United States.

37. On the respective dates set forth in Exhibit D annexed, said Joseph E. Howard, or those in interest with or through him, duly copyrighted said musical compositions by duly complying in all respects with the United States Copyright Law and all other laws governing copyright, and secured the exclusive rights and privileges in and to the copyrights of said musical compositions, and received from the Register of Copyrights a certificate of the registration of the claim to each of said copyrights, identified by the respective entry numbers set forth in Exhibit D annexed.

38. On the respective dates set forth in Exhibit D annexed, being in each instance during the year prior to the expiration of each said copyright, said Joseph E. Howard, being then living and having become entitled thereto, duly renewed and extended each of said copyrights for the further term of 28 years in his name as author, by duly complying in all respects with the Act of March 4, 1909, as amended, and all other laws governing copyright, and received from the Register of Copyrights a certificate that each said application for the renewal and extension of each said copyright was duly registered in the Copyright Office, identified by the respective entry numbers set forth in Exhibit D annexed.

39. By a written instrument made and dated June 6, 1933, said Joseph E. Howard, for a valuable consideration to him, assigned to plaintiff the renewal copyrights in certain musical compositions.

40. After the registration in his name of the respective renewal copyrights in the musical compositions listed in Exhibit D annexed, and pursuant to said instrument dated June 6, 1933, said Joseph E. Howard, by a written instrument made and dated March 3, 1936, and recorded in the Copyright Office on March 4, 1936, book 346, pages 177-178, for a valuable consideration to him, assigned to plaintiff said renewal copyrights in said musical compositions.

41. Since March 3, 1936, plaintiff has been and still is the sole proprietor of the interest of said Joseph E. Howard in said renewal copyrights in the musical compositions listed in Exhibit D annexed.

42. Defendant acting under the purported claim that it acquired by assignment from said Joseph E. Howard his interest in the renewal copyrights in the musical composi-

tions listed in Exhibit D annexed, has represented and asserted and continues to represent and assert, to the trade and prospective users and licensees of rights to said musical compositions, that it is the owner of said interest therein and has the sole right and authority to exercise and license such rights thereunder, and to realize all benefits therefrom to its own use and purpose, and that plaintiff has no right or interest therein or thereto.

43. No assignment to defendant of any interest of said Joseph E. Howard in said renewal copyrights in the musical compositions listed on Exhibit D annexed, executed prior to the execution or recording of said assignment of March 3, 1936 by said Joseph E. Howard to plaintiff of his interest therein, was ever recorded in the Copyright Office within the time prescribed in Sec. 44 of the Act of March 4, 1909, as amended, and at the time of the execution or recording of said assignment by said Joseph E. Howard to plaintiff of March 3, 1936 plaintiff had no notice or knowledge of any such assignment to defendant.

44. By reason of such acts of defendant, defendant has seriously hampered and interfered with plaintiff in the exercising and licensing of its rights under the interest of said Joseph E. Howard to said renewal copyrights in the musical compositions listed in Exhibit D annexed, and has prevented plaintiff from exercising and licensing such rights, and from realizing substantial returns which would otherwise inure to plaintiff therefrom, in that by reason of such claim of defendant the trade and prospective users and licensees have been unwilling to have dealings with plaintiff involving such rights or to make payment to plaintiff therefor.

45. By reason of such claim of defendant, a serious conflict has arisen between plaintiff and defendant as to the

title to the interest of said Joseph E. Howard in said renewal copyrights in the musical compositions listed in Exhibit D annexed, and there is an actual controversy between plaintiff and defendant in respect thereto.

FOR A FIFTH CAUSE OF ACTION

46. Plaintiff repeats and realleges each and every allegation contained in paragraphs 1 and 2, with the same force and effect as if here set forth.

47. Prior to the year 1911, one Joseph E. Howard, who then was and ever since has been a citizen of the United States, either alone or in collaboration with one or more other writers who then were and ever since have been citizens of the United States, created and wrote certain original musical compositions, listed in Exhibit E. hereto annexed and made a part hereof, which musical compositions contain a large amount of material wholly original with said Joseph E. Howard and said co-writers and is copyrightable subject matter under the laws of the United States.

48. On the respective dates set forth in Exhibit E annexed, said Joseph E. Howard, or those in interest with or through him, duly copyrighted said musical compositions by duly complying in all respects with the United States Copyright Law and all other laws governing copyright, and secured the exclusive rights and privileges in and to the copyrights of said musical compositions, and received from the Register of Copyrights a certificate of the registration of the claim to each of said copyrights, identified by the respective entry numbers set forth in Exhibit E annexed.

49. On the respective dates set forth in Exhibit E annexed, being in each instance during the year prior to the

expiration of each said copyright, said Joseph E. Howard, being then living and having become entitled thereto, duly renewed and extended each of said copyrights for the further term of 28 years in his name as author, by duly complying in all respects with the Act of March 4, 1909, as amended, and all other laws governing copyright, and received from the Register of Copyrights a certificate that each said application for the renewal and extension of each said copyright was duly registered in the Copyright Office, identified by the respective entry numbers set forth in Exhibit E annexed.

50. By a written instrument made and dated June 6, 1933, said Joseph E. Howard, for a valuable consideration to him, assigned to plaintiff the renewal copyrights in certain musical compositions.

51. After the registration in his name of the respective renewal copyrights in the musical compositions listed in Exhibit E annexed, and pursuant to said instrument dated June 6, 1933, said Joseph E. Howard, by a written instrument made and dated November 3, 1937, and recorded in the Copyright Office on November 4, 1937, book 385, pages 219-220, for a valuable consideration to him, assigned to plaintiff said renewal copyrights in said musical compositions.

52. Since November 3, 1937, plaintiff has been and still is the sole proprietor of the interest of said Joseph E. Howard in said renewal copyrights in the musical compositions listed in Exhibit E annexed.

53. Defendant acting under the purported claim that it acquired by assignment from said Joseph E. Howard his interest in the renewal copyrights in the musical compositions listed in Exhibit E annexed, has represented and asserted and continues to represent and assert, to the trade

and prospective users and licensees of rights to said musical compositions, that it is the owner of said interest therein and has the sole right and authority to exercise and license such rights thereunder, and to realize all benefits therefrom to its own use and purpose, and that plaintiff has no right or interest therein or thereto.

54. No assignment to defendant of any interest of said Joseph E. Howard in said renewal copyrights in the musical compositions listed on Exhibit E annexed, executed prior to the execution or recording of said assignment of November 3, 1937 by said Joseph E. Howard to plaintiff of his interest therein, was ever recorded in the Copyright Office within the time prescribed in Sec. 44 of the Act of March 4, 1909, as amended, and at the time of the execution or recording of said assignment by said Joseph E. Howard to plaintiff of November 3, 1937 plaintiff had no notice or knowledge of any such assignment to defendant.

55. By reason of such acts of defendant, defendant has seriously hampered and interfered with plaintiff in the exercising and licensing of its rights under the interest of said Joseph E. Howard to said renewal copyrights in said musical compositions listed in Exhibit E annexed, and has prevented plaintiff from exercising and licensing such rights, and from realizing substantial returns which would otherwise inure to plaintiff therefrom, in that by reason of such claim of defendant the trade and prospective users and licensees have been unwilling to have dealings with plaintiff involving such rights or to make payment to plaintiff therefor.

56. By reason of such claim of defendant, a serious conflict has arisen between plaintiff and defendant as to the title to the interest of said Joseph E. Howard in said re-

newal copyrights in the musical compositions listed in Exhibit E annexed, and there is an actual controversy between plaintiff and defendant in respect thereto.

WHEREFORE plaintiff prays:

1. That this Court declare that plaintiff is the sole owner and proprietor of the interest of Joseph E. Howard in the renewal copyrights in the musical compositions listed in Exhibits A, B, C, D and E annexed, and that defendant never acquired and has no right or interest therein.

2. That this Court during the pendency of this action and permanently, enjoin and restrain defendant, its officers, agents, servants and employees, and all those acting through them or any of them, from exercising any rights under the interest of Joseph E. Howard in the renewal copyrights in the musical compositions listed in Exhibits A, B, C, D and E annexed, and from representing or asserting that defendant is possessed of any rights thereunder.

3. That plaintiff recover its costs.

4. That upon application therefor, plaintiff be granted such further relief based on said declaratory judgment as may be necessary or proper.

Exhibits A-E, Annexed to Complaint.

(Comprising 6 pages of titles of musical compositions, with original copyright dates and entry numbers, and renewal copyright dates and entry numbers. Record, pages 43-48.)

Opinion After Trial.

(Record pages 147-153.)

This suit for a declaratory judgment filed on August 31, 1944 has finally been brought on for trial. Both, plaintiff a New York corporation, and defendant, a New Jersey corporation, have long been publishers of sheet music. Each seeks injunctive relief against present and threatened copyright infringement, a judgment declaring it the proprietor of renewal copyrights in a number of musical compositions of which Joseph E. Howard was a co-writer and each claims proprietorship through documents and assignments executed by Howard to it.

The complaint as amended pleads eight separate counts; each count asks the same relief with respect to the compositions which are listed in eight schedules or exhibits, each schedule being numbered to correspond to the count in which it is pleaded. Schedules 1 to 8 list a total of 202 compositions—all now in the renewal period. Prior to trial plaintiff stipulated that it withdrew all claim to ownership of the renewal copyright in the 22 compositions listed in Schedule 7 and in 6 other compositions—two in Schedule 3; three in Schedule 5 and one in Schedule 6; as to these 28 compositions the defendant is entitled to judgment. As to the remaining 174 scheduled compositions, defendant stipulated that it made claim only to those compositions as to which it was indicated that defendant was the original publisher, thus withdrawing all claim with respect to 19 of the compositions; as to these 19 plaintiff is entitled to judgment. Concerning three of the remaining 155 compositions, it was stipulated that defendant had not received an assignment. The suit proceeded to trial with respect to the remaining 152 compositions of the 202 originally scheduled; these are referred to herein as the litigated compositions.

Opinion After Trial.

Plaintiff's claim to the litigated compositions in Schedules 1-6 and 8 is asserted by virtue of an agreement dated June 6, 1933 recorded in the Copyright Office on April 30, 1934 between plaintiff and Joseph E. Howard. Plaintiff's claim is further predicated on individual assignments of the compositions executed by Howard after the copyright renewals and recorded in the Copyright Office within the three-month statutory period pursuant to Sec. 30 of the Copyright Law, 17 USCA. These assignments were made pursuant to the June 6, 1933 agreement.

This agreement recites that the parties desire to provide for renewal copyrights to the listed compositions upon the expiration of the original copyrights and to make provision for their continued publication during the renewal period. Howard by the agreement sold and transferred to plaintiff "the renewal and/or extension and/or the sole and exclusive right to secure and effect upon its expiration the renewal and/or extension of each and every copyright" of the listed compositions. The agreement purports to secure to plaintiff "the full benefit and enjoyment of the renewal and extension" of each of the copyrights. Defendant's predecessor was informed of the execution of the June 6, 1933 agreement within a couple of weeks after it was signed.

The separate assignments of the renewal copyrights to the litigated compositions recite that each is made pursuant and subject to the June 6, 1933 agreement.

Defendant's claim to the compositions of which it was the original publisher is predicated on an agreement executed on December 2, 1916 (never recorded), and upon separate assignments executed by Howard on April 28, 1936, subsequently recorded. A number of these assignments were executed by Howard in blank, defendant having permission to insert subsequently the dates and so

Opinion After Trial.

The agreement of December 2, 1916 recites that Howard has sold to defendant's predecessor "all the right, title and interest by way of copyrights or otherwise . . . in and to all my musical compositions published by CHAS. K. HARRIS." There is no mention made of renewal rights.

From the stipulation of facts entered into by the attorneys for both parties, the following appears to have been the sequence of the assignments and recording of the compositions listed in the various Schedules annexed to the stipulation:

Schedule 1—each separate assignment to plaintiff was dated March 3, 1936 and recorded March 4, 1936—prior to the date and recording of each assignment to defendant;

Schedule 2—each separate assignment to plaintiff was dated November 3, 1937 and recorded November 4, 1937—prior to the date and recording of each assignment to defendant, except that five assignments to defendant were dated February 3, 1937 but not recorded until November 6, 1945;

Schedule 3—each separate assignment to plaintiff was dated May 9, 1944 and recorded May 10, 1944; each separate assignment to defendant was dated prior to plaintiff's but not recorded until after plaintiff's;

Schedule 4—each separate assignment to plaintiff was dated March 3, 1936 and recorded March 4, 1936, prior to the date and recording of each assignment to defendant;

Schedule 5—each separate assignment to plaintiff was dated November 3, 1937 and recorded November 4, 1937, prior to the date and recording of the assignments to defendant with the exception of one dated February 3

Schedule 6—each separate assignment to plaintiff was dated between June 15, 1944 and May 10, 1946 and recorded within a period of two days; defendant's assignments were undated and none were recorded;

Schedule 7—withdrawn by stipulation;

Schedule 8—each separate assignment to plaintiff dated either February 20, 1945 or May 10, 1946 and recorded February 21, 1945 or May 13, 1946 respectively; defendant had separate assignments to only four compositions all executed between December 7, 1937 and January 11, 1940, but not recorded until October 4, 1945.

Section 30 provides that every assignment of copyright "shall be recorded in the copyright office within three calendar months after its execution . . . in default of which it shall be void as against any subsequent purchaser . . . for a valuable consideration, without notice, whose assignment has been duly recorded."

Defendant's rights must be based on whatever rights its predecessor obtained by the agreement of December 2, 1916. The agreement is silent on the renewal period of copyright. The right of renewal is not a continuation of the old copyright, but is the grant of a new one. Thus, any assignment in 1916 to defendant of Howard's copyrights could not convey any interest in his renewal rights unless specific mention of them were made in the 1916 agreement. *G. Ricordi & Co. v. Paramount Pictures, Inc.*, 189 F. 2d 469, cert. den. 342 U. S. 849.

Indeed, defendant as much as conceded this, when it states:

> "The earliest year in which an application for renewal of the copyrights could have been filed, was 1932, sixteen (16) years after the execution of this

agreement. Had Howard failed to survive until the twenty-eighth year of each copyright period, the 1916 agreement would have been of no value to Harris, because the renewal rights would then have vested in persons other than the author." (Trial brief, p. 7)

There is nothing before the court to indicate that such intangible, distant rights as the renewal copyrights were in the contemplation of the parties when they entered into the 1916 agreement. On the other hand, the agreement between Howard and plaintiff of June 6, 1933, followed as it was by the separate assignments is specific as a grant of rights for the renewal period. The intention of the parties here is unmistakable.

Plaintiff protected its rights to the renewal copyrights by prompt recording of its separate assignments. Any delay in the recording of the 1933 agreement did not confer any rights on defendant because the former's separate assignments to the litigated compositions were recorded prior to any assignments to defendant. No showing has been made of any notice to plaintiff of any right of defendant's to the renewal copyright prior to the recording of plaintiff's assignments.

I find that as to the litigated compositions plaintiff is entitled to judgment declaring it to be the owner of the renewal copyrights. With respect to the compositions as to which plaintiff or defendant has withdrawn its claims judgment shall issue as above indicated. Settle judgment on notice.

July 25th, 1955.

SYLVESTER J. RYAN,
U. S. D. J.

Judgment.

(Record pages 154-165.)

This cause having come on to be tried before the Court, without a jury, on April 18, 1955, and the evidence adduced by the parties having been heard and having been argued by counsel, and the Court having rendered and filed its decision on July 25, 1955, and having made its findings of fact and conclusions of law, which are embodied in said decision, it is hereby

ORDERED, ADJUDGED AND DECREED:

1. (a) The following musical compositions are hereinafter referred to as "Group 1":

(Listing the titles of 28 musical compositions, with original copyright dates and entry numbers, and renewal copyright dates and entry numbers.)

(b) The following musical compositions are hereinafter referred to as "Group 2":

(Listing the titles of 21 musical compositions, with original copyright dates and entry numbers, and renewal copyright dates and entry numbers.)

(c) The following musical compositions are hereinafter referred to as "Group 3":

(Listing the titles of 154 musical compositions, with original copyright dates and entry numbers, and renewal copyright dates and entry numbers.)

2. That defendant has at all times been, and now is, the sole owner and proprietor of the interest through Joseph E. Howard in the renewal copyright of each of the musical compositions listed in "Group 1".

3. That defendant has no right, title or interest through Joseph E. Howard in, the renewal copyrights of the musical compositions listed in "Group 2".

4. That plaintiff has at all times been, and now is, the sole owner and proprietor of the interest through Joseph E. Howard, in the renewal copyright of each of the musical compositions listed in "Group 3".

5. That plaintiff, its officers, agents, servants and employees, and all those acting or claiming or purporting to act through or on behalf of, in concert with, or under the direction, authorization, permission or license of, plaintiff, be and hereby are permanently restrained and enjoined from representing, claiming or asserting that plaintiff ever acquired or became possessed of, or has, any right, title or interest whatsoever in or to, or any right, power or authority to exercise or license any rights or interests in or to, any of the musical compositions listed in "Group 1" through or by virtue of the interest of Joseph E. Howard in the renewal copyrights therein; and from directly and indirectly printing, reprinting, publishing, copying, exploiting, distributing, vending, selling, offering for sale, translating, making versions of, dramatizing, representing, arranging, adapting, performing, recording, producing, reproducing, or otherwise using or exercising, or authorizing, sanctioning, permitting or licensing any use of, or the exercising of any right or interest in or to, any of the musical compositions listed in "Group 1", through or by virtue of the interest of the said Joseph E. Howard in the renewal copyrights therein; and from otherwise infringing the renewal copyright of the defendant in each of the musical compositions listed in "Group 1".

6. That defendant, its officers, agents, servants and employees, and all those acting or claiming or purporting

to act through or on behalf of, in concert with, or under the direction, authorization, permission or license of, defendant, be and hereby are permanently restrained and enjoined from representing, claiming or asserting that defendant ever acquired or became possessed of, or has, any right, title or interest whatsoever in or to, or any right, power or authority to exercise or license any rights or interests in or to, any of the musical compositions listed in "Group 3", through or by virtue of the interest of Joseph E. Howard in the renewal copyrights therein; and from directly and indirectly printing, reprinting, publishing, copying, exploiting, distributing, vending, selling, offering for sale, translating, making versions of, dramatizing, representing, arranging, adapting, performing, recording, producing, reproducing, or otherwise using or exercising, or authorizing, sanctioning, permitting or licensing any use of, or the exercising of any right or interest in or to, any of the musical compositions listed in "Group 3", through or by virtue of the interest of the said Joseph E. Howard in the renewal copyrights therein; and from otherwise infringing the renewal copyright of the plaintiff in each of the musical compositions listed in "Group 3".

7. That all purported assignments made by the said Joseph E. Howard to plaintiff corporation of the interest of the said Joseph E. Howard in the renewal copyrights of the musical compositions listed in "Group 1", and each and every recording and entry thereof in the Copyright Office, and all certificates of every such record and all certified copies thereof, are invalid, null and void, and the Register of Copyrights is hereby directed to revoke and cancel the same and to make appropriate notations of such revocation and cancellation upon the records of the Copyright Office.

8. That all purported assignments made by the said Joseph E. Howard to defenedant's assignor, Cora L. Harris doing business as Chas. K. Harris Music Publisher, and thereafter further assigned to defendant, of the interest of the said Joseph E. Howard in the renewal copyrights of the musical compositions listed in "Group 3", and each and every recording and entry thereof in the Copyright Office, and all certificates of every such record, and all certified copies thereof, are invalid, null and void, and the Register of Copyrights is hereby directed to revoke and cancel the same and to make appropriate notations of such revocation and cancellation upon the records of the Copyright Office.

9. That jurisdiction of this cause is hereby retained by the Court in all respects for the purpose of enforcing the provisions of this decree and for the purpose of issuing such further orders and directions upon application of either party as may be necessary or appropriate to make this decree effective in the future; and that either party may at any time hereafter, upon reasonable notice to the other party, apply at the foot of this decree for such relief.

Dated, New York, N. Y., September 23, 1955.

SYLVESTER J. RYAN,
United States District Judge.

Entered:

September 23, 1955.

WILLIAM V. CONNELL,
Clerk.

Plaintiff's Motion to Amend Judgment and for Further Relief.

(Record pages 191, 192.)

Upon the annexed affidavit of Julian T. Abeles, verified September 28, 1955, plaintiff moves the Court as follows:

1. Pursuant to Rule 59(e), Title 28, F.R.C.P., to alter and amend the judgment, entered herein on September 23, 1955, in the particulars set forth in said affidavit.

2. Pursuant to Section 2202, Title 28, for such further relief to plaintiff based on said declaratory judgment as may be necessary or proper, and to enable the Court to grant such relief, for the appointment of a special master to take evidence, compute and ascertain and to report to the Court concerning:

(1) The infringement by defendant's predecessor Cora L. Harris, doing business as Chas. K. Harris Music Publisher, and defendant Charles K. Harris Music Publishing Co. Inc. of the renewal copyrights of plaintiff in the musical compositions listed in "Group 2" and "Group 3" of the said judgment entered herein.

(2) The damages sustained by plaintiff in consequence of the infringement by defendant's said predecessor and defendant of plaintiff's said renewal copyrights.

(3) All gains, profits and advantages, derived by defendant's said predecessor and defendant by their infringement of plaintiff's said renewal copyrights, or such damages as shall appear proper within the provisions of the copyright statutes.

Reserving for the Court upon the coming in of such report the award to plaintiff of such other and further relief to which plaintiff shall be entitled against defendant, including the amount of attorneys' fee as part of the costs of plaintiff.

Dated, New York, N. Y., September 28, 1955.

Affidavit in Support of Plaintiff's Motion.

(Record pages 193-206.)

JULIAN T. ABELES, being duly sworn, deposes and says:

1. I am a member of the firm of Abeles & Bernstein, attorneys for plaintiff.

2. This affidavit is submitted in support of plaintiff's motion (a) pursuant to Rule 59(e), Title 28, F.R.C.P., to alter and amend the judgment entered herein on September 23, 1955, and (b) pursuant to Section 2202, Title 28, for such further relief to plaintiff based on said declaratory judgment as may be necessary or proper.

3. The motion to alter and amend the judgment is directed to (a) the elimination of all affirmative relief to defendant in respect to the compositions listed in "Group 1", and (b) for the same affirmative relief to plaintiff in respect to the compositions listed in "Group 2" as in respect to the compositions listed in "Group 3." The motion in said respect is made upon the following grounds:

(1) In defendant's memorandum submitted in support of its proposed judgment (pp. 3-5) which was signed by the Court, it is said that plaintiff prior to trial having stipulated (Nov. 3, 1954, Pltf's Ex. 3) to withdraw all claims of ownership to the renewal copyrights in the compositions listed in "Group 1", defendant became entitled to affirmative judgment in respect to said compositions under its counterclaims, and therefore it would be improper to dismiss the separate defenses and counterclaims contained in defendant's answer as provided in plaintiff's proposed judgment.

(2) Defendant failed to bring to the attention of the Court that the compositions listed in "Group 1", referred to in the said stipulation of November 3, 1954, cannot be the subject matter of affirmative relief to defendant, by reason of the following:

(a) In the second sentence of the Agreed Statement of May 20, 1954, it is provided (par. "4") "The complaint shall be deemed amended to comprehend the additional compositions listed on 'Schedule 6', '*Schedule 7*' and 'Schedule 8' annexed, with the same claim asserted and the same prayer for relief demanded by the plaintiff, as in respect to the compositions listed in the schedules annexed to the complaint." It is further provided in the next sentence that "defendant shall have fifteen (15) days from the date hereto to serve a separate answer to the amendment of the complaint comprehended in the preceding sentence." By stipulation of June 9, 1954 (Deft's Ex., 2) paragraph "4" of the Agreed Statement was amended to provide that the two separate defenses pleaded in defendant's answer should be designated "Counterclaims."

(b) By the said stipulation of November 3, 1954 (Pltf's Ex. 3), paragraph "4" of the Agreed Statement was "further amended" to read as follows:

> "The complaint shall be deemed amended to comprehend the additional compositions listed on '*Schedule 6*' (with the exception of the composition entitled 'Love Me All The Time') and on '*Schedule 8*' annexed, with the same claim asserted and the same prayer for relief demanded by the plaintiff, as in respect to the compositions listed in the schedules annexed to the complaint. The plaintiff makes no claim in respect to the compositions listed on 'Schedule 7' annexed or

in respect to the following compositions, and *the same shall not be included in the causes of action set forth in the complaint as hereby amended.*"

Accordingly, while the Agreed Statement provided that the complaint shall be deemed amended to comprehend "Schedule 6, *Schedule 7* and Schedule 8", by the subsequent amendment pursuant to the aforesaid stipulation of November 3, 1954 the complaint was deemed amended to comprehend only "*Schedule 6 and Schedule 8*"; there being no reservation made by defendant under its counterclaims in respect to the compositions deleted by said stipulation.

(c) The separate defenses and counterclaims in defendant's answer relate solely to the compositions (par. Tenth) "*mentioned and described in the bill of complaint,*" and (par. "Eleventh") "*as described and listed*" in the exhibits annexed to "*the bill of complaint.*" The amendment to defendant's answer (pursuant to par. 4 of the Agreed Statement) incorporated "by reference, as though fully set forth *in its present answer,* including the denials, defenses and counterclaims." Accordingly, as the counterclaims in defendant's answer only relate to the compositions "*mentioned and described in the bill of complaint*" and "as described and listed" in the exhibits annexed "*to the bill of complaint*", defendant cannot have affirmative relief under said counterclaims in respect to the compositions which by the said stipulation of November 3, 1954 are expressly eliminated from the action, with the same force and effect as if they had never been included by the Agreed Statement.

(3) Defendant further says in its memorandum (p. 5) that regarding the compositions listed in "Group 2", "*as to which Charles K. Harris was not the original publisher,* the defendant *never made any claim with respect thereto*",

so that no provision for affirmative relief to plaintiff in respect to said compositions was included in defendant's proposed judgment. On the contrary, the denials and separate defenses and counterclaims contained in defendant's answer, are directed to all the compositions listed in the exhibits annexed to the complaint, as amended, viz:

In paragraph "First" defendant denies the allegations of the complaint that plaintiff is the sole proprietor of the interest through Joseph E. Howard in the renewal copyrights of the songs listed in the complaint.

In paragraph "Fourth" defendant denies certain allegations of the complaint, except defendant alleges that its "predecessors in interest duly (originally) copyrighted" all of the compositions listed in the complaint and "secured copyrights and *the exclusive rights and privileges in and to the copyrights of said musical compositions.*"

In paragraphs "Sixth" and "Seventh" defendant denies the allegations of the complaint that the said Joseph E. Howard assigned to plaintiff the renewal copyrights of the compositions listed in the complaint.

In the First Separate Defense And Counterclaim, defendant alleges (a) in paragraph "Tenth" that defendant's predecessor transferred and assigned to defendant "each and every musical work, published and unpublished, and the copyright thereof" which "assignment and transfers included *each and every musical work composed by Joseph E. Howard, and mentioned and described in the bill of complaint*, and that since that time the defendant has been conducting said business *and is the owner of said rights*"; (b) in paragraph "Twelfth" that prior to the year 1917 the said Joseph E. Howard "duly assigned *such musical compositions* to Charles K. Harris, predecessor in interest of the defendant, together with the right to secure

copyright therein and *all rights* therein and thereto"; (c) in paragraph "Thirteenth", that its said predecessor "duly copyrighted *said musical composition*" and "secured the copyrights and *all exclusive rights and privileges therein of said musical composition*, (d) in paragraph "Fourteen", that on or about December 2, 1916, the said Joseph E. Howard, duly granted and conveyed to defendant's predecessor all rights "*in and to the aforesaid musical compositions and in the copyrights and renewal copyrights thereof*"; and in paragraph "Eighteenth", that by reason thereof defendant is the "*lawful owner of all rights, title and interest of said Joseph E. Howard in and to the renewal copyrights of the aforesaid musical compositions and all rights therein, thereto and thereunder*, including but not limited to the exclusive right to print, reprint, publish, copy, vend and perform the aforesaid musical compositions."

In the Second Separate Defense And Counterclaim, defendant alleges (a) in paragraph "Twentieth", "that notwithstanding the foregoing, plaintiff with full knowledge" of the acquisition by defendant's predecessor of the interest of the said Joseph E. Howard "*in and to the aforementioned musical compositions, and in and to the copyrights and renewals thereof*" and "in wilful disregard of such rights" had obtained assignments from said Joseph E. Howard of his interest "*in and to the said renewal copyrights*", and with full knowledge of "*the rights of defendant's predecessors and defendant*, and in violation thereof, and *without the consent, permission or authority of the defendant or its predecessors in interest*" had exercised rights therein and thereto and "threatens to continue so to do", and (b) in paragraph "Twenty-First" that by reason thereof, "plaintiff has *hampered and interfered with defendant in the exercising and licensing of its rights*

under the interest of Joseph E. Howard, *to said renewal copyrights in the aforesaid musical compositions,* and has prevented defendant from exercising and licensing such rights, and from realizing benefits which would otherwise inure to defendant therefrom."

The prayer for relief in defendant's answer is (a) "*That the complaint be dismissed*" (b) that this Court declare "that defendant is the sole owner and proprietor of the interest of Joseph E. Howard *in the renewal copyrights in and to the aforesaid musical compositions, and that the plaintiff never acquired and has no right or interest therein*", and (c) that this Court enjoin plaintiff "from exercising any rights under the interest of Joseph E. Howard *in the renewal copyrights of the aforesaid musical compositions, and from representing or asserting that plaintiff is possessed of any rights thereunder.*"

Accordingly, defendant's statement in its memorandum that it "*never made any claim with respect*" to the compositions listed in the complaint, as to which its predecessor "*was not the original publisher*", is completely dissipated by said allegations of its answer. *Nowhere in the answer does defendant except such compositions.* On the contrary, as has been pointed out, all of said allegations in its answer specifically relate to "*each and every* musical composition composed by Joseph E. Howard, and *mentioned and described in the bill of complaint.*" The answer was served on *November 6, 1941*, and the first time that defendant conceded that it had no right in said compositions, of which its predecessor was not the original publisher, was in the subsequent Agreed Statement of *May 20, 1954.* Incidentally, as to three of the compositions listed in "Group 2", as the Court said in its opinion, defendant subsequently withdrew its claim not because they were not published by the predecessor but because "de-

(4) In accord with the stipulation of November 3, 1954, plaintiff in its proposed judgment recited "2. That plaintiff has no right, title or interest through Joseph E. Howard, in the renewal copyrights of the musical compositions listed in Group 1", without any declaration of title in defendant or any provision for affirmative relief. While under the Agreed Statement plaintiff was entitled to a declaratory judgment of title and affirmative relief, in respect to the compositions listed in "Group 2", plaintiff's proposed judgment contained the same recital "That defendant has no right, title or interest through Joseph E. Howard, in the renewal copyrights of the musical compositions listed in Group 2", as in respect to plaintiff's rights in the compositions listed in Group 1, without any declaration of title in plaintiff or any provision for affirmative relief. However, defendant's proposed judgment, signed by the Court, specifically declares that defendant has title to the compositions listed in "Group 1", with no like recital of title in plaintiff to the compositions listed in "Group 2." Likewise, while defendant's proposed judgment grants defendant affirmative relief by way of injunction and a revocation and cancellation of record in respect to the compositions listed in "Group 1", no such affirmative relief is granted to plaintiff in respect to the compositions listed in "Group 2."

In this respect the Court will note, that while the compositions listed in "Group 1" were specifically eliminated from the action in its entirety, the Agreed Statement merely recites that Defendant makes claim only to those of the compositions listed on the annexed schedules as to which defendant is indicated as being the "Original Publisher", and excepts three compositions as to which defendant did not receive an assignment. None of said compositions are deleted from the action, and the Agreed

Statement specifically recites that plaintiff's claim to said compositions is "asserted" under the respective documents therein set forth and that in respect to said compositions plaintiff is entitled to judgment as prayed for in the complaint.

While the Court said in its opinion that "*as to these 19 compositions plaintiff is entitled to judgment*" plaintiff's counsel has assumed that as only the title to the contested compositions was litigated (referred to by the Court as the "litigated compositions"), the Court did not intend any affirmative relief to be granted in respect to the compositions listed in either "Group 1" or "Group 2."

(5) The Court now having expressed its intention to grant affirmative relief in respect to all of the compositions listed in the complaint, which were not expressly eliminated from the action by the stipulation of November 3, 1954, it is respectfully submitted that the judgment should be altered and amended, pursuant to Rule 59(e) in the following respects:

(a) All provision in respect to the compositions listed in "Group 1", for a declaration of title in defendant and for affirmative relief to defendant, should be deleted.

(b) The separate defenses and counterclaims contained in defendant's answer should be dismissed.

(c) Plaintiff should have the same affirmative relief in respect to the compositions listed in "Group 2" as in respect to the compositions listed in "Group 3."

(d) The judgment should provide that plaintiff shall have such further, necessary and proper relief against defendant based upon the declaratory judgment, in respect to the compositions listed in "Group 2" and "Group 3", as is available under the Copyright Act, after reasonable notice and hearing pursuant to Section 2202, Title 28,

U.S.C. A provision to this effect (as to "Group 3") was contained in paragraph "8" of plaintiff's proposed judgment, which was deleted by defendant. There is a provision in the judgment (par. 9) whereby jurisdiction of the cause is retained by the Court, for the purpose of enforcing the provisions thereof and of issuing such further orders and directions upon application of either party as may be necessary or appropriate to make the judgments effective in the future, and that either party may at any time apply at the foot of the judgment for such relief. The defendant has deleted that part of the provision in paragraph "9" of plaintiff's proposed judgment, which provides (pursuant to Section 2202) that such further orders and directions may issue "to grant plaintiff further, necessary and proper relief against defendant based upon this decree." The deletion by defendant of this provision, together with the deletion of the aforementioned provision of paragraph "8" of plaintiff's proposed judgment, may affect plaintiff's right to further relief based upon said judgment under Section 2202, as prayed for in the complaint. Under the authorities the provision for further relief should be incorporated, and the additional provision for the Court to retain jurisdiction should be included for the purpose of carrying into effect the provision for further relief. Accordingly, the judgment should be amended to incorporate both paragraphs "8" and "9" of plaintiff's proposed judgment in their entirety.

(6) The defendant in deleting paragraph "8" of plaintiff's proposed judgment has deleted the provision that plaintiff shall have further relief under Section 2202, as is available under the Copyright Act, "for the infringement by defendant's said predecessor and defendant of the renewal copyrights of plaintiff", saying (defts. memo. p. 7) "Nowhere in the complaint did plaintiff allege, nor did it prove at the trial, any facts upon which this Court could predicate an adjudication that the defendant corporation

is liable for any infringing acts committed by its predecessor in interest, Cora L. Harris." Such proof was not required. In defendant's answer (par. "Tenth") it is specifically alleged that the said Cora L. Harris "individually and or doing business under the name Charles K. Harris" assigned, transferred and set over to defendant "all the assets of the business then being conducted by her, together with each and every musical work, published and unpublished, and the copyright thereof,—and that since that time the defendant has been conducting said business and is the owner of said rights." In the Agreed Statement (par. 17) it is stipulated that such transfer was made by "Cora L. Harris, doing business as Chas. K. Harris-Music Publisher" (instead of "Charles K. Harris") to defendant "Charles K. Harris Music Publishing Co. Inc." Under the authorities, such transfer of "all the assets" to defendant corporation of practically the same name, and the continuation by defendant of the conduct of the business theretofore conducted by its predecessor, would make defendant liable to plaintiff for such prior acts of its said predecessor. Accordingly, the judgment should be amended to conform in every particular to paragraph "8" of plaintiff's proposed judgment.

4. The motion for further relief based on said declaratory judgment as may be necessary or proper, after reasonable notice and hearing pursuant to Section 2202, is made upon the following grounds:

(1) The present Section 2202, is based upon the second paragraph of former Section 400, Title 28 U.S.C., 1940 ed. (in effect when this action was instituted) which then read as follows:

> "Further relief based on a declaratory judgment or decree may be granted whenever necessary or proper. The application shall be by petition to a court having jurisdiction to grant the relief. If the appli-

cation be deemed sufficient, the court shall, on reasonable notice, require any adverse party, whose rights have been adjudicated by the declaration, to show cause why further relief should not be granted forthwith."

For the express purpose of obtaining such further relief, under the then Section 400, based upon the declaratory judgment, the following was incorporated in the prayer for relief in the complaint:

"4. That upon application therefor, plaintiff be granted such further relief based upon said declaratory judgment as may be necessary or proper."

Furthermore, in the Agreed Statement it was stipulated and agreed (par. 2):

"The prayer for relief of each of the parties is that said party be declared the sole owner and proprietor of such interest, that the other party be enjoined and restrained from claiming or exercising any rights thereunder or thereto, *and for such further relief as may be necessary or proper.*"

(2) In its memorandum (p. 8) defendant says as to the repeated adjournments of the trial of the action over a period of approximately eleven years "This long delay, in and of itself, should bar the right to recovery of money damages in this action." The defendant failed to inform the Court that all of such adjournments were by stipulation of the attorneys for the respective parties. Such stipulations, on file in the Clerk's office, will be proffered to the Court upon the hearing of this motion. Furthermore, in most instances the adjournment was had upon the request of defendant's counsel, or because of the adjournment at defendant's counsel's request of preliminary proceedings. In every instance when plaintiff's counsel, be-

cause of prior engagements, the press of other matters, or illness, was required to apply for the adjournment, defendant's counsel joined in the request. Accordingly, defendant more than acquiesced in the delay. To say the least it was a principal party to the delay. Under the authorities, none of the essential elements of laches and estoppel are present in the instant case.

(3) The Court has found (a) that there was no possible basis for the claim asserted by defendant's predecessor and defendant, to the renewal copyrights of the litigated compositions, under the agreement of December 2, 1916 between Howard and defendant, and (b) that defendant's predecessor was informed of the execution of the June 6, 1933 agreement (between Howard and plaintiff) within a couple of weeks after it was signed. Under the authorities defendant is in the same position as its assignor.

The said agreement of December 2, 1916 on its face is no more than a release by Howard of all obligations of the publisher for future royalty payments. Under this agreement for the paltry sum of $150.00 Howard, one of the outstanding writers of all time, was induced to make an outright sale of his life's work for the balance of the respective original copyright terms (of from 17 to 28 years). If defendant had succeeded in this action, there likewise would have been no obligation for any payment by it to Howard for the respective renewal terms of 28 years.

As alleged in the complaint, defendant's assertion to the trade that it is the sole owner of said renewals and has the sole right and authority to exercise and license all rights thereunder, has seriously hampered and interfered with plaintiff in the exercising and licensing of such rights, and has prevented plaintiff from exercising and licensing such rights and from realizing substantial returns, which have thereby inured to defendant instead of to plaintiff.

Affidavit in Support of Plaintiff's Motion.

The correspondence between plaintiff and licensing agencies of such rights, shows that defendant has continuously licensed such rights and obviously realized substantial returns therefrom. Under the agreements between plaintiff and Howard, plaintiff is obligated for the payment of the customary writer's royalties to Howard. Under the aforementioned agreement of December 2, 1916, Howard has released defendant from the payment of all such royalties. Unless plaintiff has such further relief, as prayed for in the complaint and set forth in the foregoing motion, both plaintiff and Howard will be deprived of the revenue from such rights to which they are lawfully entitled, and defendant will have profited by its unlawful acts. The very purpose of Section 2202 was to give redress against the party who has wrongfully asserted ownership, and thereby prevent the wrongdoer from profiting by such acts.

By reason of the representation by my firm of various interests in the music industry, including one of the two principal licensing agencies, I know of my own personal knowledge that because of extraordinary uses of certain of such compositions subsequent to the expiration of the respective original copyright terms, the revenue therefrom during said period has been far above the average; and that for a time during said period one of such compositions "I Wonder Who's Kissing Her Now" was number one on the so-called "Hit Parade" of the most outstanding songs of the day.

(4) It is essential that a Special Master be appointed to ascertain the extent of the infringement of said renewal copyrights by defendant's predecessor and defendant, and to compute and ascertain the amount of damages sustained by plaintiff, and the gains, profits and advantages derived by defendant's said predecessor and defendant, by reason of the infringement of plaintiff's said renewal copyrights.

(Sworn to September 28, 1955.)

Affidavit in Opposition to Plaintiff's Motion.

(Record pages 208-218.)

ARTHUR L. FISHBEIN, being duly sworn, deposes and says:

1. I am the attorney for the defendant.

2. I submit this affidavit in opposition to plaintiff's motion (a) to alter and amend the judgment entered herein on September 23, 1955, and (b) for the appointment of a Special Master with respect only to the renewal copyrights of plaintiff in the musical compositions listed in "Group 2" and "Group 3" of the said judgment.

3. On September 23, 1955, Judge Sylvester J. Ryan signed a final judgment in this action, which was entered on that day by the Clerk of the Court. Prior thereto, plaintiff submitted a proposed judgment together with a memorandum in support thereof, and defendant submitted its proposed judgment together with a memorandum in support thereof. The defendant's proposed judgment differed substantially from the one proposed by the plaintiff. Judge Ryan, after considering both judgments and the memoranda submitted, signed the judgment proposed by the defendant.

4. Plaintiff's motion does not present any new matters which were not considered and determined by Judge Ryan when he signed the judgment entered in this action. Plaintiff, by this motion, seeks to alter and amend the said judgment so as to make it conform to plaintiff's proposed judgment, which the Court refused to sign in the first instance. In effect, plaintiff now requests the Court to reverse its determination made on September 23, 1955, when it signed the judgment entered in this action.

Affidavit in Opposition to Plaintiff's Motion.

5. Plaintiff's motion to alter and amend the judgment and for the appointment of a Special Master, should be denied for the following reasons:

A. Judge Ryan properly signed the judgment entered herein, which awards to defendant affirmative relief with respect to the musical compositions listed in "Group 1" of said judgment, and which does *not* provide for a dismissal of defendant's defenses and counterclaims on the merits, as requested by plaintiff. The award of such affirmative relief was in accordance with the Court's decision, which directed judgment in favor of the defendant as to the twenty-eight (28) compositions listed in "Group 1" (Pages 1 and 2 of Decision). This was the relief which defendant requested in its answer, which pleaded defenses and counterclaims, and is the same relief which the judgment entered herein awards to plaintiff with respect to the compositions listed in "Group 3".

Pursuant to paragraph "4" of the Agreed Statement of Facts dated May 20, 1954, plaintiff amended its complaint to include additional compositions listed in Schedules "6", "7" and "8" annexed to said Statement, and as to said additional compositions, asserted the same claim and demanded the same relief as it asserted and demanded with respect to all other compositions referred to in the original complaint. By stipulation dated June 9, 1954, the said paragraph "4" of the Agreed Statement of Facts was amended, so that the first and second separate and distinct defenses pleaded in the answer were designated "counterclaims" as well as "defenses", and defendant was given leave to serve a separate answer as to said additional compositions. Such separate answer, dated June 25, 1954, was served and filed by the defendant. Such Separate answer recites that it "is the defendant's Separate Answer to the amendment of the complaint provided for in said paragraph '4' of said stipulation" (the amendment which

included the additional compositions), and such Separate Answer incorporated therein by reference, the defenses and counterclaims contained in the original answer, as amended. Thus, by the terms of the aforesaid stipulations and Separate Answer, the defendant's counterclaims were made applicable to all of the compositions listed in Schedules "1" through "8", inclusive. When plaintiff, prior to trial, by stipulation dated November 3, 1954 (after the service of the aforesaid Separate Answer) withdrew all claim to ownership of the renewal copyrights in the twenty-eight (28) compositions listed in "Group 1" (5 of which were included in the schedules annexed to the original complaint), defendant became entitled to judgment on its counterclaims and such judgment was awarded to it by this Court in its Decision and properly incorporated in the final judgment entered herein.

The stipulation dated November 3, 1954, quoted at length on pages 2 and 3 of the moving affidavit, contains no withdrawal by defendant of its counterclaims theretofore asserted with respect to the musical compositions referred to in said stipulation. Since there was no withdrawal by defendant of its counterclaims, such counterclaims continued in being and were the basis for the Court's decision awarding defendant affirmative relief with respect to the compositions listed in "Group 1". The Court, therefore, properly refused to include in the judgment a provision for the dismissal on the merits of the defenses and counterclaims pleaded by the defendant.

In paragraph "(c)" on page 3 of the moving affidavit, plaintiff's attorney quotes part of defendant's Separate Answer. That quotation is incorrect, in that it omits the word "herein", omits a comma, adds the word "in", and omits an entire concluding phrase. These omissions and addition are most misleading and completely change the

meaning of the defendant's Separate Answer to suit plaintiff's purposes. The moving affidavit emphasizes this distortion by underlining the word "in", which does not appear in the defendant's Separate Answer. I feel it necessary, therefore, to set forth in full the relevant portion of the defendant's Separate Answer, which has been misquoted:

> "PLEASE TAKE NOTICE, that pursuant to paragraph '4' of the Agreed Statement of Facts and Stipulation dated May 20, 1954, the following is the defendant's Separate Answer to the amendment of the complaint provided for in said paragraph '4' of said stipulation:
> "1. The defendant hereby incorporates by reference, as though herein fully set forth, its present answer, including the denials, defenses and counterclaims, as amended by paragraph '4' of said stipulation."

B. Judge Ryan properly signed the judgment entered herein, which provides that defendant has no right, title or interest through Joseph E. Howard in the renewal copyrights of the musical compositions listed in "Group 2". With respect to those compositions listed in "Group 2" as to which Charles K. Harris was not the original publisher, defendant never made any claim thereto (Page 2 of Decision) and obviously, defendant has no right, title or interest through Joseph E. Howard in the renewal copyrights thereof. Since defendant never made any claim to such compositions not originally published by Charles K. Harris, the judgment entered herein properly does not award to plaintiff affirmative relief with respect thereto. I may point out to the Court that, with respect to the compositions listed in "Group 2", the judgment entered herein follows the identical language contained in paragraph "3" of the judgment proposed by the plaintiff. In other words, the judgment entered herein awards to

plaintiff, with respect to the compositions listed in "Group 2", the very relief which it sought in its own proposed judgment.

Prior to the commencement of this action, plaintiff knew that defendant's predecessor, as well as defendant, claimed only the renewal rights in the musical compositions published by Charles K. Harris. The agreement dated December 2, 1916 between Howard and Harris expressly relates only to musical compositions published by Harris, and plaintiff knew of that agreement before the commencement of this action. There remained the problem of identifying which of Howard's compositions were published by Harris, and this was done by the Agreed Statement of Facts. The majority of the compositions listed in "Group 2", are listed in Schedules "6" and "8," and were added to this action for the first time by the Agreed Statement of Facts dated May 20, 1954 (Paragraph "4"). It was in this very same Agreed Statement of Facts (Paragraph "7") that defendant made clear that its claim was only as to those compositions listed in the schedules as having been published by defendant's predecessor, Charles K. Harris.

On the bottom of page 6 and the top of page 7 of the moving affidavit, plaintiff's attorney refers to three (3) compositions included in "Group 2", with respect to which the Court said in its Decision defendant had not received an assignment. Plaintiff, in its proposed judgment, listed the said three (3) compositions in "Group 2", and the judgment entered herein awards to plaintiff the relief which it requested with respect thereto.

C. Judge Ryan properly signed the judgment entered herein which omitted paragraph "8" and modified paragraph "9" of plaintiff's proposed judgment, thereby limiting the relief awarded in this action to a declaration of the rights of plaintiff and defendant, respectively, and an

injunction protecting those rights in the future. The Court properly determined, when it signed the judgment entered herein, that the plaintiff (as well as defendant) was barred from recovering any money damages in this action. Therefore, there is no need whatsoever for the appointment of a Special Master to take evidence, as now requested by plaintiff.

(1) Plaintiff sought, by paragraph "8" of its proposed judgment, to obtain relief against this defendant based upon this Court's decree "for the infringement by defendant's said predecessor . . . .". This relief was properly denied by Judge Ryan in the judgment entered herein on September 23, 1955. Nowhere in the compaint did plaintiff allege, nor did it prove at the trial, any facts upon which this Court could predicate an adjudication that the defendant corporation is liable for any infringing acts committed by its predecessor in interest, Cora L. Harris. This Court's Decision necessarily and rightfully made no reference whatsoever to any issues of fact or law to establish such responsibility on the part of the defendant. The defendant never had any notice that any such claim would be asserted against it in this action and was never given an opportunity to defend against such claim. Now, plaintiff's attorney claims that none of this was necessary, because the defendant in its answer (Page 10) alleges that Cora L. Harris transferred to it all of the assets of the business then being conducted by her. That fact alone does not establish liability on the part of the defendant for infringing acts by Mrs. Harris. Obviously, there are many other essential factors lacking to impose such liability and many defenses may be asserted to such a claim, which the defendant has never had an opportunity to do. Although plaintiff's attorney makes the foregoing assertion "under the authorities" (Page 10 of his affidavit), he served no brief with the motion papers, and even now,

the defendant is not aware of the legal basis on which plaintiff predicates this wholly improper and clearly unwarranted claim. In the second branch of plaintiff's motion for the appointment of a Special Master, plaintiff again makes the same unwarranted claim, seeking to impose upon the defendant liability for infringing acts, if any, of its predecessor in interest. There is no foundation whatsoever for the award of such relief and it should be denied completely.

(2) In my memorandum submitted on the settlement of the judgment, I pointed out to the Court that this action for declaratory judgment was commenced on August 31, 1944 and was finally brought to trial approximately *eleven* (11) years thereafter. I called the Court's attention to the fact that this was not just an ordinary lapse of time, but that it was such a long lapse of time as to warrant this Court to limit the relief which it will award to a declaration of rights and an injunction protecting those rights in the future. I also cited authorities, which hold that this long delay, in and of itself, should bar the right to the recovery of money dantages in this action.

Plaintiff's attorney in his affidavit (Pages 11 and 12) fails completely to offer a satisfactory explanation for the eleven years' delay. Nothing that he says in that affidavit explains or justifies such a long lapse of time. The reference to adjournments in the moving affidavit is irrelevant, though, as a matter of fact, most of said adjournments were not made at my request, but rather at the request of plaintiff's counsel. Obviously, plaintiff could have brought this action to trial long before the lapse of eleven (11) years. The evils which flow from such a long delay become evident by plaintiff's tactic of moving now for the appointment of a Special Master to take evidence of infringing acts which may have occurred many years in the past.

Affidavit in Opposition to Plaintiff's Motion.

I may point out to the Court that many of the renewal copyrights in the compositions listed in "Group 3" came into being in or before the year 1937, at which time plaintiff recorded in the United States Copyright Office separate assignments thereof executed by Howard. On or about March 11, 1938, plaintiff knew that defendant's predecessor in interest made claim to said renewal copyrights under the December 2, 1916 agreement between Joseph E. Howard and Charles K. Harris (plaintiff's answers to interrogatories numbered "VI"-"XII" inclusive). Nevertheless, prior to the commencement of this action on August 31, 1944, no action was instituted by plaintiff against defendant's predecessor with respect to the compositions listed in "Group 3", except for an action commenced on June 4, 1941, involving only the one musical composition entitled "I Wonder Who's Kissing Her Now", and said action was discontinued on the merits against defendant's predecessor (See Paragraph "D" of this affidavit).

(3) The complaint in this action contains no allegations of any infringing acts on the part of this defendant. The complaint alleges merely that an actual controversy exists with respect to which plaintiff needs a declaration of its rights, because defendant represented that it is the owner of the interest through Joseph E. Howard in the renewal copyrights in question (Paragraphs "2" and "9" of complaint). Plaintiff, at the trial, did not prove nor establish any acts of infringement by the defendant. Plaintiff, at the trial, proved only the controversy relating to ownership. Thus, plaintiff laid no basis for any relief in this action for damages or an accounting under the Copyright Act. Both the complaint and the answer were amended by an Agreed Statement of Facts, which was executed as late as May 20, 1954, and said Agreed Statement of Facts was further amended by stipulations ex-

ecuted on June 9, 1954, November 3, 1954 and March 11, 1955. In the last stipulation, the plaintiff asserted its reply to the counterclaims pleaded in the defendant's answer, as amended, and demanded affirmative judgment as prayed for in the complaint, as amended. Such prayer for relief in the complaint, as amended, contains no specific request for relief against infringing acts of the defendant, or any one else, under the provisions of the Copyright Act. It is obvious from the foregoing, that the plaintiff never intended to assert, and waived, any right to damages that may have accrued before the commencement of this action or while it was pending.

D. The defendant asserted its claims in this action in good faith. In 1916, Howard executed and delivered to Charles K. Harris the December 2, 1916 agreement. In 1936, Howard executed and delivered to Mrs. Harris the separate assignments involved in this action (Paragraph "7" of Agreed Statement of Facts dated May 20, 1954): Cora L. Harris transferred her interest in the renewal copyrights to the defendant in 1943 (Paragraphs "17", "18" and "19" of Agreed Statement). Prior thereto, this plaintiff brought an action in this Court (Civil No. 14-341) against Cora L. Harris, which involved the musical composition "I Wonder Who's Kissing Her Now" ("Group 3") and the interpretation of the 1916 Howard agreement with respect thereto. In that action, this plaintiff was denied summary judgment, the Court holding that there was an issue of fact to be tried before the 1916 Howard agreement and could be interpreted properly. (*Marks* v. *Jerry Vogel Music Co., Inc. and Cora L. Harris,* 42 F. Supp. 859, 865). That action went to trial before Judge Knox and the final judgment in that action provides for a discontinuance on the merits against the defendant, Cora L. Harris. Certainly, in view of the foregoing, the defendant was justified in seeking a determination by this

Affidavit in Opposition to Plaintiff's Motion.

Court on the merits, after trial, of the meaning of the 1916 agreement upon which it relied. As a matter of fact, as a result of this action, plaintiff withdrew its claim to twenty-eight (28) compositions, as to which judgment was awarded to defendant by this Court.

The moving affidavit (Pages 12 and 13) contains many unsupported and exaggerated statements which are irrelevant to the disposition of this motion, and consequently it would serve no useful purpose for me to make reply thereto.

I accordingly ask that plaintiff's motion be denied in all respects.

(Sworn to October 5, 1955.)

Affidavit for Adjournment of Trial Upon Consent.

(Record, pages 245, 246)

LEOPOLD BLEICH, being duly sworn, deposes and says:

I am associated with Julian T. Abeles, attorney for the plaintiff in the above entitled matter.

This affidavit is being made in support of an application to adjourn the trial of this action from the Reserve Non-Jury Calendar, where it now appears, to the Reserve Non-Jury Calendar for December 17, 1945. This adjournment is asked for because Mr. Abeles is unable to adequately prepare this case for trial at this time due to the fact that he has been engaged in the preparation and trial of two copyright infringement cases brought by Harold Lloyd Corporation v. Universal Pictures Company, Inc., now pending in the United States District Court, Los Angeles, California, and which necessitate the presence of Mr. Abeles in California as one of trial counsel in said action; that one of said actions was recently partially tried and has been adjourned to November 16th. Mr. Abeles is required to procure the depositions of certain witnesses to be taken in respect to said adjourned trial, and his presence in California will be required shortly prior to said adjourned date and during the trial thereof. Mr. Abeles is likewise engaged in the preparation for trial of the second of said actions, which is set for trial during December, 1945, at the same Court, and his presence will likewise be required in California in respect to said second action; that because of scarcity of help and the pressure of urgent legal matters, Mr. Abeles is unable at this time to make any adequate preparation in respect to this case.

It is therefore respectfully requested that this adjournment be granted. Defendant has consented to this application.

(Sworn to October 25, 1945.)

Affidavit for Adjournment of Trial at Request of Both Parties.

(Record page 241)

LEOPOLD BLEICH, being duly sworn, deposes and says:

I am associated with Julian T. Abeles, attorney for the plaintiff in the above entitled matter.

This affidavit is being made in support of an application to adjourn the trial of this action from the Reserve Non-Jury Calendar, where it now appears, to the Reserve Non-Jury Calendar for May 6, 1946.

This adjournment is requested because Mr. Abeles has recently been in the preparation and trial of numerous cases, is presently preparing for trial the case of Jerome v. Twentieth Century-Fox Film Corp., appearing at the head of the Day Calendar of this Court for January 28, 1946.

It is respectfully requested that this case be set over to the Reserve Non-Jury Calendar for May 6, 1946, in which request the defendant joins.

(Sworn to January 9, 1946.)

Affidavit for Adjournment of Trial Upon Consent.

(Record page 242)

BENJAMIN G. WEIL, being duly sworn, deposes and says:

I am an attorney associated with Julian T. Abeles, the attorney for the plaintiff in the above entitled matter.

I make this affidavit in support of an application to adjourn the trial of this action from the Reserve Non-Jury Calendar where it now appears to the Reserve Non-Jury Calendar for January 9, 1947.

This adjournment is asked for because the plaintiff has not yet been able to secure the depositions of certain witnesses whose testimony is absolutely necessary to the trial of the case. I am of the opinion that it will be possible to procure such depositions within the period of the adjournment prayed for.

The defendant consents to this application.

(Sworn to October 7, 1946.)

Affidavit for Adjournment of Trial Upon Consent.

(Record page 243)

LEOPOLD BLEICH, being duly sworn, deposes and says:

I am an attorney associated with Julian T. Abeles, the attorney for the plaintiff in the above entitled matter.

I make this affidavit in support of an application to adjourn the trial of this action from the Reserve Non-Jury Calendar where it now appears to the Reserve Non-Jury Calendar for May 19, 1947.

This adjournment is asked for because the plaintiff has not yet been able to secure the depositions of certain witnesses whose testimony is absolutely necessary to the trial of the case. I am of the opinion that it will be possible to procure such depositions within the period of the adjournment prayed for.

The defendant consents to this application.

(Sworn to January 21, 1947.)

Affidavit for Adjournment of Trial Upon Consent.

(Record page 244)

BENJAMIN G. WEIL, being duly sworn, deposes and says:

I am an attorney associated with Julian T. Abeles, the attorney for the plaintiff in the above entitled matter.

I make this affidavit in support of an application to adjourn the trial of this action from the Non-Jury Day Calendar, where it now appears, to the Non-Jury Day Calendar for the June 1949 Term.

This adjournment is asked for because plaintiff has ascertained in the course of preparation for trial, that it is essential that certain additional data be secured. This data is absolutely necessary for use by plaintiff on the trial of this action. I am of the opinion that it will be possible to procure said data within the period of adjournment prayed for.

The defendant consents to this application.

(Sworn to April 11, 1949.)

Affidavit for Adjournment of Trial at Request of Both Parties.

(Record page 60)

BENJAMIN G. WEIL, being duly sworn, deposes and says

I am an attorney associated with Julian T. Abeles, the attorney for the plaintiff in the above entitled matter.

I make this affidavit in support of an application to adjourn the trial of this action from the Non-Jury Day Calendar, where it now appears, to the Non-Jury Day Calendar for the January 1951 Term.

This adjournment is asked for because it has been ascertained by plaintiff in the course of preparation for trial that further data, essential to establish plaintiff's cause of action, be secured for use upon the trial of this action. Plaintiff is presently proceeding to obtain said data and it is expected that it will be procured within the near future.

Defendant joins in this request for this adjournment.

(Sworn to October 17, 1950.)

Affidavit for Adjournment of Trial at Request of Both Parties.

(Record page 61)

BENJAMIN G. WEIL, being duly sworn, deposes and says:

I am an attorney associated with Julian T. Abeles, the attorney for the plaintiff in the above entitled matter.

I make this affidavit in support of an application to adjourn the trial of this action from the Non-Jury Day Calendar, where it now appears, to the Non-Jury Day Calendar for the April 1951 Term.

This adjournment is asked for because it has been ascertained by plaintiff in the course of preparation for trial that further data, essential to establish plaintiff's cause of action, be secured for use upon the trial of this action. Plaintiff is presently proceeding to obtain said data and it is expected that it will be procured within the near future.

Defendant joins in this request for this adjournment.

(Sworn to January 3, 1951.)

Affidavit for Adjournment of Pre-trial Hearing Upon Consent.

(Record pages 142, 143)

JULIAN T. ABELES, being duly sworn, deposes and says:

I am the attorney for the plaintiff in the above entitled action.

Plaintiff seeks judgment in the action declaring that it is the sole owner and proprietor of the interest of Joseph E. Howard in the renewal copyrights of approximately two hundred (200) musical compositions, and enjoining and restraining defendant from asserting that it is possessed of such rights and from exercising the same.

For the past two (2) months, I have suffered from a severe eye infection. I have been under the treatment of the well-known eye specialist, Dr. Daniel B. Kirby of 780 Park Avenue, New York City, and after a number of examinations, on November 7th, he furnished a report to my physician, Dr. Jane Lockwood of Greenwich, Connecticut, for the purpose of her giving me regular injections as a part of my treatment. A copy of this report is annexed hereto as Exhibit "A" and made a part hereof. Likewise, as appears from this report, I must continue this treatment for a period of eight (8) weeks, in addition to other treatment which Dr. Kirby prescribed.

The trial of the action, which would otherwise be protracted, can be greatly curtailed and simplified by the pre-trial conference. For this purpose, it is essential that I prepare extensive outlines and schedules and a comprehensive memorandum for the Court. In view of the condition of my eyes, it has been impossible for me to undertake such preparation, and I would be in no condition to give this matter my attention until subsequent to the eight-week period mentioned in Dr. Kirby's annexed report.

The defendant's attorney has consented to an adjournment to any day commencing with the week of January 21st, 1952 that will met with the Court's approval.

I therefore respectfully ask that the pre-trial conference be adjourned accordingly.

Exhibit "A".

DANIEL B. KIRBY, M. D.
780 Park Avenue
New York 21, N. Y.

November 7, 1951

Dr. Jane Lockwood

Putman Avenue

Greenwich, Conn.

Dear Dr. Lockwood:

Please give me a report on the general condition of Mr. Julian Abeles. He has evidence of staphylococcus infection of the conjunctiva and sinus membranes. Will you kindly arrange for him to have injections of Staphylococcus Toxoid Lederle # 1 (100 Units to 1 cc) dose of 0.1 to 0.3 intracutaneously, twice a week for about 8 weeks. I will appreciate your courtesy and cooperation.

Very sincerely,

DR. DANIEL B. KIRBY

DBK:S

Stipulation Extending Defendant's Time to Appear for Examinations Before Trial.

(Record page 248)

IT IS HEREBY STIPULATED, that the taking of the testimony of the defendant, by Ralph Peer, its President, by deposition upon oral examination, pursuant to plaintiff's notice dated December 17, 1951, be and the same hereby is adjourned to April 18, 1952, at the office of Julian T. Abeles, Esq., 745 Fifth Avenue, New York 22, New York.

Dated, New York, December 20, 1951.

/s/ JULIAN T. ABELES,
Attorney for Plaintiff.

/s/ ARTHUR L. FISHBEIN,
Attorney for Defendant.

Affidavit for Adjournment of Pre-trial Hearing at Request of Both Parties.

(Record pages 145, 146)

MAXWELL OKUN, being duly sworn, deposes and says:

I am associated with Arthur L. Fishbein, the attorney for the defendant herein, and have been preparing this case in behalf of said defendant for the pre-trial hearing scheduled for January 24, 1952 at 2:15 P. M.

In connection with this preparation, I discussed today the various issues involved herein with Mr. Julian T. Abeles, the attorney for the plaintiff.

This action involves the ownership of the renewal copyrights to approximately 156 songs. Both the plaintiff and the defendant rely on many documents, consisting of agreements and assignments executed by Joseph E. Howard, the composer of the songs in question, to establish their respective titles to the renewal copyrights. Most of these documents have been recorded in the Copyright Office in Washington, D. C. I, and I understand, plaintiff's attorney, have prepared lists of the various documents involved herein. Mr. Abeles and I intend to confer in order to list the various documents upon which each of us relies, to admit the genuineness of the signatures on these documents, where possible, and to admit the dates when the respective documents were recorded in the Office of the Register of Copyrights. To do this, will involve considerable time in checking documents, signatures, dates and certificates of registration.

I respectfully request an adjournment of this pre-trial hearing, so that the foregoing matters can be disposed of by agreement between counsel before the adjourned date, and thus, considerable time of the Court will be saved.

I accordingly ask for an adjournment of this pre-trial hearing to the first or second week in March, 1952, and Mr. Julian T. Abeles, the attorney for the plaintiff herein, joins in this request.

(Sworn to January 23, 1952.)

Affidavit for Adjournment of Trial at Request of Both Parties.

(Record pages 64, 65)

ARNOLD J. BERNSTEIN, being duly sworn, deposes and says:

I am an attorney associated with Julian T. Abeles the attorney for the plaintiff in the above-entitled matter.

This affidavit is submitted in support of an application to adjourn the trial of this action from the Non-Jury Day Calendar, where it now appears, to the head of the Non-Jury Day Calendar for the May, 1952 term.

A pre-trial conference in this case has been set for March 14th. The action is an extremely complicated one involving, as it does, the respective claims of the plaintiff and defendant in the renewal copyrights in approximately two hundred separate and distinct musical compositions. It is expected that the pre-trial conference will curtail and simplify the trial of the action and enable the parties to be prepared for trial by May of this year.

Defendant's attorney joins in the instant request.

(Sworn to February 27, 1952)

Stipulation Extending Defendant's Time to Appear for Examination Before Trial.

(Record page 248)

IT IS HEREBY STIPULATED, that the taking of the testimony of the defendant, by Ralph Peer, its President, by deposition upon oral examination, pursuant to plaintiff's notice dated December 17, 1951, be and the same hereby is adjourned to May 8, 1952, at the office of Julian T. Abeles, Esq., 745 Fifth Avenue, New York 22, New York.

Dated, New York, April 16, 1952.

/s/ JULIAN T. ABELES,
Attorney for Plaintiff.

/s/ ARTHUR L. FISHBEIN,
Attorney for Defendant.

Stipulation for Adjournment of Pre-trial Hearing Upon Consent.

(Record page 65a)

IT IS HEREBY STIPULATED AND AGREED by and between the attorneys for the respective parties hereto that the pre-trial hearing now set for October 22, 1952, at 2:15 P. M. be and the same hereby is adjourned to November 25, 1952, at 2:15 P. M.

Dated, New York, New York, October 2, 1952.

JULIAN T. ABELES, by W. L.,
Attorney for Plaintiff.

ARTHUR L. FISHBEIN, by W. L.,
Attorney for Defendant.

Affidavit for Adjournment of Trial at Request of Both Parties.

(Record page 95)

ARNOLD J. BERNSTEIN, being duly sworn, deposes and says:

I am associated in the practice of law with Julian T. Abeles, attorney for the plaintiff in this action.

Judgment is sought by plaintiff in the action declaring that it is the sole owner and proprietor of the interest of Joseph E. Howard in the renewal copyrights of approximately two hundred (200) musical compositions, and enjoining and restraining defendant from asserting that it is possessed of such rights and from exercising the same.

Julian T. Abeles is at present in England in connection with the affairs of a client, and is not expected to return for at least several weeks. Since the case is to be tried by Mr. Abeles, it is respectfully requested that the trial of the action be adjourned from the October 21st Day Calendar No. 4 to December 21, 1953 at the head of Day Calendar No. 4. The attorney for the defendant concurs in this request.

(Sworn to October 20, 1953.)

Affidavit for Adjournment of Trial at Request of Both Parties.

(Record pages 132-133)

JULIAN T. ABELES, being duly sworn, deposes and says:

I am the attorney for the plaintiff in this action.

The judgment sought by plaintiff is for a declaration that plaintiff is the sole owner and proprietor of the interest of Joseph E. Howard in the renewal copyrights of approximately two hundred (200) musical compositions, and enjoining and restraining defendant from asserting that it is possessed of such rights and from exercising the same.

The defendant seeks judgment declaring that defendant is the sole owner and proprietor of such interest in said compositions, and enjoining and restraining plaintiff from asserting that it is possessed of such right and from exercising the same.

While the proof of the parties to sustain their respective claims to the renewal rights in approximately two hundred (200) musical compositions, alleged to have been acquired under various agreements and assignments, would normally take an extended period of time, the parties have endeavored by agreement to eliminate a part of the required proof and are hopeful of further eliminating an additional part thereof.

It is therefore respectfully requested, by the attorneys for the respective parties, that the trial of the action be adjourned from the October 18th Day Calendar No. 4 to November 12, 1954 at the head of the Day Calendar No. 4. This will enable the attorneys for the respective parties, in preparing for trial, to further stipulate the required proof.

(Sworn to October 18, 1954.)

Affidavit for Adjournment of Trial at Request of Defendant.

(Record page 134)

MAXWELL OKUN, being duly sworn, deposes and says:

I am trial counsel for the defendants in this action.

I respectfully request that this case which is now set for head of Day Calendar for November 10, 1954 be adjourned to November 29, 1954 head of Day Calendar, for the following reasons:

1. On November 15, 1954, I will be engaged in the trial of an action entitled "Witmark v. Remington" in Special Term, Part 3 of the Supreme Court, New York County.

2. This action involves the ownership of the renewal copyrights in several hundred musical compositions and the preparation of the documentary evidence for the trial requires a great deal of time. As a matter of fact, I am now considering a stipulation which will eliminate a number of the musical compositions from the claims asserted by the plaintiff and thus further limit the issues to be tried.

(Sworn to November 9, 1954.)

Affidavit for Adjournment of Trial at Request of Both Parties.

(Record page 135)

MAXWELL OKUN, being duly sworn, deposes and says:

I am trial counsel for the defendants in this action.

Mr. Abeles, trial counsel for the plaintiff, and I respectfully request that this case be adjourned to the head of the day calendar for December 15, 1954 for the following reasons:

1. We are both working on stipulations to eliminate a number of the musical compositions from the claims involved in this lawsuit and thereby limit considerably the issues to be tried herein. These issues are extremely complicated inasmuch as they involve the ownership of renewal copyrights in several hundred musical compositions.

2. Mr. Abeles and I are both working intensively on the preparation of this case for trial but will be unable to complete that preparation before the 15th of December, 1954. My own preparation of this case has been interferred with by the preparation of an intricate brief for the Circuit Court of Appeals which must go to the printers this week.

(Sworn to December 1, 1954.)

Affidavit for Adjournment of Trial at Request of Defendant.

(Record page 137)

MAXWELL OKUN, being duly sworn, deposes and ~~says~~:

I am trial counsel for the defendant in this action.

I respectfully request that this case, which is now set for ~~head of Day Calendar~~ for February 1st, 1955, be adjourned to March 1st, 1955 head of Day Calendar, for the following reason:

I have just learned that Isabelle B. Monroe, who will be an important witness for the defendant, is ill and unable to attend the trial of this action. I will know definitely within two weeks whether or not she will be able to attend such a trial and if it is determined that she will be unable to do so, it is the defendant's intention to take her deposition so that the same can be read at the trial of this action on or after March 1st, 1955.

(Sworn to January 31, 1955.)

Affidavit for Adjournment of Trial at Request of Defendant.

(Record page 139)

MAXWELL OKUN, being duly sworn, deposes and says:

I am trial counsel for the defendants in this action.

I respectfully request that this case, which is now set for head of Day Calendar for March 1st, 1955, be adjourned to March 15th, 1955 head of Day Calendar for the following reason:

ISABELLE B. MONROE, an important witness for the defendant, became ill and is unable to attend the trial of this action. The defendant thereupon served a notice for the taking of the deposition of that witness on February 24th, 1955, so that same could be read at the trial of the action. On February 23rd, 1955, I was informed by the witness' husband that the witness had just suffered a sudden attack and her doctor forbade witness from testifying on Thursday, February 24th, 1955. I am making immediate arrangements to ascertain the witness' condition and to take the deposition as soon as possible so that it will be available before the adjourned date.

(Sworn to February 24, 1955.)

Affidavit for Adjournment of Trial Upon Consent.

(Record page 136)

JULIAN T. ABELES, being duly sworn, deposes and says:

I am the attorney for the plaintiff herein.

This action will appear at the head of Day Calendar No. 4 for December 15th.

On that day I am entering Lenox Hill Hospital to be operated on by Dr. John Kernan. Dr. Kernan advised me that I will be confined to the hospital for from seven to ten days and that I will be convalescing and not able to try a case for about three weeks thereafter.

I therefore respectfully request that the trial of this action be adjourned to February 1, 1955 at the head of Day Calendar No. 4.

The attorney for defendant has agreed to this adjournment.

(Sworn to December 14, 1955.)

Opinion Upon Plaintiff's Motion

(Record pages 147-153)

Plaintiff is entitled to similar affirmative relief with respect to the compositions listed in Group 2 as was granted defendant with respect to those in Group 1. Accordingly the judgment will be amended as follows:

Paragraph 3 of the judgment which was entered is stricken and the following recital substituted:

"3 Plaintiff has at all times been, and now is, the sole owner and proprietor of the interest through Joseph E. Howard in the renewal copyright of each of the musical compositions listed in Group 2".

Paragraph 6 is amended to include injunctive relief with respect to the compositions in Group 2 as well as those in Group 3; Paragraph 8 is amended to include a declaration of invalidity, etc. with respect to Group 2 as well as Group 3.

A provision for further relief based on this judgment under Section 2202, 28 U.S.C.A., and the appointment thereunder of a master to assess damages and profits is not warranted in this suit. Plaintiff has not sought a declaration of infringement or an accounting. As early as March, 1938 it had knowledge that defendant's predecessor made claim to the litigated renewal copyright, and particularly with respect to the one composition singled out by plaintiff (on this motion) as a source of revenue far above the average ("I Wonder Who's Kissing Her Now"), it had such knowledge as October, 1937. Moreover, a suit started by plaintiff against defendant's predecessor involving this song was in 1943 discontinued on the merits; not until 1944 did plaintiff file the instant action and for 11 years delayed prosecution of it. This

unreasonable delay on the part of plaintiff in asserting its rights amounts to such laches as to estop it from claiming damages and profits. *Haynes* v. *Druggist's Circular,* 32 F. 2d 215; *Johnston* v. *Mining Co.,* 148 U. S. 760; *Pollitzer* v. *Foster,* 59 F. 2d 901. The difficulty in assessing damages for acts committed so many years ago and the manifest prejudice to defendant precludes the granting of additional relief at this late date.

Motion granted with respect to paragraphs 3, 6 and 8 of the judgment; denied in all other respects. Submit amended judgment on notice.

12/6/55

SYLVESTER J. RYAN,
U.S.D.J.

Amended Judgment.

(Record pages 219-232)

Plaintiff having moved, pursuant to Rule 59(e), to alter and amend the judgment entered herein on September 23, 1955, and pursuant to Section 2202 of Title 28, for further relief based on said judgment, and for the appointment thereunder of a Special Master to assess damages and profits, and reserving for the Court upon the coming in of the report of such Special Master, the award to plaintiff of other and further relief, including the amount of attorneys' fees as part of the costs of plaintiff, and said motion having duly come on before me to be heard, and the Court having duly considered the affidavit of Julian T. Abeles, sworn to September 28, 1955, in support of said motion, and the affidavit of Arthur L. Fishbein, sworn to October 5, 1955, in opposition thereto, and after hearing counsel for the plaintiff in support of said motion, and counsel for the defendant in opposition thereto, and the Court having rendered its decision, granting said motion with respect to paragraphs "3", "6" and "8" of said judgment, as hereinafter set forth; denying said motion in all other respects; and directing the submission of an amended judgment on notice; it is hereby

ORDERED, ADJUDGED and DECREED, that the judgment entered herein on September 23, 1955, be and the same hereby is amended to read as follows:

This cause having come on to be tried before the Court, without a jury, on April 18, 1955, and the evidence adduced by the parties having been heard and having been argued by counsel, and the Court having rendered and filed its decision on July 25, 1955, and having made its findings of fact and conclusions of law, which are embodied in said decision, it is hereby

Amended Judgment.

ORDERED, ADJUDGED AND DECREED:

(a) The following musical compositions are hereinafter referred to as "Group 1."

(Listing the titles of 28 musical compositions, with original copyrighted dates and entry numbers, and renewal copyright dates and entry numbers)

(b) The following musical compositions are hereinafter referred to as "Group 2":

(Listing the titles of 21 musical compositions with original copyright dates and entry numbers, and renewal copyright dates and entry numbers.)

(c) The following musical compositions are hereinafter referred to as "Group 3":

(Listing the titles of 154 musical compositions, with original copyright dates and entry numbers, and renewal copyright dates and entry numbers)

2. That defendant has at all times been, and now is, the sole owner and proprietor of the interest through Joseph E. Howard in the renewal copyright of each of the musical compositions listed in "Group 1".

3. That plaintiff has at all times been, and now is, the sole owner and proprietor of the interest through Joseph E. Howard in the renewal copyright of each of the musical compositions listed in "Group 2".

4. That plaintiff has at all times been, and now is, the sole owner and proprietor of the interest through Joseph E. Howard, in the renewal copyright of each of the musical compositions listed in "Group 3".

5. That plaintiff, its officers, agents, servants and employees, and all those acting or claiming or purporting to act through or on behalf of, in concert with, or under the direction, authorization, permission or license of, plaintiff, be and hereby are permanently restrained and enjoined from representing, claiming or asserting that plaintiff ever acquired or became possessed of, or has, any right, title or interest whatsoever in or to, or any right, power or authority to exercise or license any rights or interests in or to, any of the musical compositions listed in "Group 1", through or by virtue of the interest of Joseph E. Howard in the renewal copyrights therein; and from directly and indirectly printing, reprinting, publishing, copying, exploiting, distributing, vending, selling, offering for sale, translating, making versions of, dramatizing, representing, arranging, adapting, performing, recording, producing, reproducing, or otherwise using or exercising, or authorizing, sanctioning, permitting or licensing any use of, or the exercising of any right or interest in or to, any of the musical compositions listed in "Group 1", through or by virtue of the interest of the said Joseph E. Howard in the renewal copyrights therein; and from otherwise infringing the renewal copyright of the defendant in each of the musical compositions listed in "Group 1".

6. That defendant, its officers, agents, servants and employees, and all those acting or claiming or purporting to act through or on behalf of, in concert with, or under the direction, authorization, permission or license of, defendant, be and hereby are permanently restrained and enjoined from representing, claiming or asserting that defendant ever acquired or became possessed of, or has, any right, title or interest whatsoever in or to, or any right, power or authority to exercise or license any rights

or interests in or to, any of the musical compositions listed in "Group 2" and "Group 3", through or by virtue of the interest of Joseph E. Howard in the renewal copyrights therein; and from directly and indirectly printing, reprinting, publishing, copying, exploiting, distributing, vending, selling, offering for sale, translating, making versions of, dramatizing, representing, arranging, adapting, performing, recording, producing, reproducing, or otherwise using or exercising, or authorizing, sanctioning, permitting or licensing any use of, or the exercising of any right or interest in or to, any of the musical compositions listed in "Group 2" and "Group 3", through or by virtue of the interest of the said Joseph E. Howard in the renewal copyrights therein; and from otherwise infringing the renewal copyright of the plaintiff in each of the musical compositions listed in "Group 2" and "Group 3".

7. That all purported assignments made by the said Joseph E. Howard to plaintiff corporation of the interest of the said Joseph E. Howard in the renewal copyrights of the musical compositions listed in "Group 1", and each and every recording and entry thereof in the Copyright Office, and all certificates of every such record and all certified copies thereof, are invalid, null and void, and the Register of Copyrights is hereby directed to revoke and cancel the same and to make appropriate notations of such revocation and cancellation upon the records of the Copyright Office.

8. That all purported assignments made by the said Joseph E. Howard to defendant's assignor, Cora L. Harris doing business as Chas. K. Harris Music Publisher, and thereafter further assigned to defendant, of the interest of the said Joseph E. Howard in the renewal copyrights

of the musical compositions listed in "Group 2" and "Group 3", and each and every recording and entry thereof in the Copyright Office, and all certificates of every such record, and all certified copies thereof, are invalid, null and void, and the Register of Copyrights is hereby directed to revoke and cancel the same and to make appropriate notations of such revocation and cancellation upon the records of the Copyright Office.

9. That jurisdiction of this cause is hereby retained by the Court in all respects for the purpose of enforcing the provisions of this decree and for the purpose of issuing such further orders and directions upon application of either party as may be necessary or appropriate to make this decree effective in the future; and that either party may at any time hereafter, upon reasonable notice to the other party, apply at the foot of this decree for such relief.

Dated, New York, N. Y., September 23, 1955.

SYLVESTER J. RYAN,
United States District Judge.

Judgment Entered:

September 23, 1955.

WILLIAM V. CONNELL,
Clerk.

and it is further

ORDERED, ADJUDGED and DECREED, that plaintiff's aforesaid motion, be and the same hereby is denied in all other respects.

Dated, New York, N. Y., February 2, 1956.

SYLVESTER J. RYAN,
United States District Judge.

Amended Judgment Entered:

Feb. 3, 1956.

WILLIAM V. CONNELL,
Clerk.

Plaintiff's Notice of Appeal.

(Record page 233)

NOTICE is hereby given that Edward B. Marks Music Corporation, plaintiff above named, appeals to the United States Court of Appeals for the Second Circuit from so much of the amended declaratory judgment entered in this action on February 3, 1956, as denies plaintiff's application pursuant to Section 2202, Title 28, for further necessary and proper relief against Charles K. Harris Music Publishing Co., Inc., defendant above named, based on said amended declaratory judgment.

Dated, New York, N. Y., February 24, 1956.

No. 220

Office Supreme Court, U.S.
FILED
JUL 25 1958
JOHN T. FEY, Clerk

United States Court of Appeals

FOR THE SECOND CIRCUIT

EDWARD B. MARKS MUSIC CORPORATION,
Plaintiff-Appellant-Appellee,

—against—

CHARLES K. HARRIS MUSIC PUBLISHING CO., INC.,
Defendant-Appellee-Appellant.

ON APPEAL FROM THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF NEW YORK

DEFENDANT-APPELLEE-APPELLANT'S APPENDIX

ARTHUR L. FISHBEIN,
Attorney for Defendant-Appellee-Appellant,
No. 67 West 44th Street,
New York 36, N. Y.,

INDEX

	PAGE
Affidavit to Restore to Calendar for November, 1948	83a
Plaintiff's Notice Dated December 17, 1951 to Take Defendant's Deposition	83a
Stipulation Restoring Case to Calendar for October, 1954 Term	84a
Stipulation Dated March 11, 1955 Amending Agreed Statement of Facts	85a
Excerpts from Testimony	86a
Plaintiff's Answers to Interrogatories	87a
December 2, 1916 Agreement Between Howard and Harris (Plaintiff's Exhibit 1-A) (Photoprint)	89a
Separate Assignment from Howard to Harris (Defendant's Exhibit A-1)	90a
June 6, 1933 Agreement Between Howard and Plaintiff (Part of Plaintiff's Exhibit 1)	91a
Deposition of Isabelle B. Monroe (Defendant's Exhibit B)	97a
Deposition of Edward B. Marks (Defendant's Exhibit C)	121a
Defendant's Notice of Appeal	134a

Affidavit to Restore to Calendar for November, 1948

(59)

State of New York,
County of New York—ss.:

BENJAMIN G. WEIL, being duly sworn, deposes and says:

I am an attorney associated with Julian T. Abeles, attorney for the plaintiff in the above-entitled action.

I make this affidavit in support of plaintiff's application to have this action restored to the calendar and placed on the Non-Jury Reserve Calendar for November, 1948.

On January 24, 1947, the case was marked off the calendar with leave to restore when ready for trial.

The defendant Chas. K. Harris Music Publishing Co., Inc., concurs in this application.

BENJAMIN G. WEIL

(Sworn to May 27, 1948.)

Plaintiff's Notice Dated December 17, 1951 to Take Defendant's Deposition

(62)

Sir:

PLEASE TAKE NOTICE that pursuant to Rule 26 et seq. of the Rules of Civil Procedure for the District Courts of the United States, the testimony of defendant Chas. K. Harris Music Publishing Co., Inc., by Ralph Peer, its President, whose address is 1619 Broadway, Borough of Manhattan, New York City, New York, will be taken by deposition upon oral examination before Yale Wilner, Esq., a notary public, at his office, 10 East 43rd Street, in the

Plaintiff's Notice Dated December 17, 1951 to Take Defendant's Deposition

Borough of Manhattan, City, County and State of New York, on the 26th day of December, 1951, commencing at 10:30 o'clock in the forenoon of said day, regarding those matters, not privileged, which are relevant to the subject matter involved in the pending action, including the existence, description, nature, custody, condition and location of any books, documents or other tangible things and the identity and location of persons having knowledge of relevant facts, and that such examination will continue from day to day until completed.

Dated, New York, N. Y., December 17, 1951.

Signed by plaintiff's attorney.

(63)

Addressed to defendant's attorney.

Stipulation Restoring Case to Calendar for October, 1954 Term

(96)

IT IS HEREBY STIPULATED, CONSENTED TO, AND AGREED, by and between the attorneys for the respective parties hereto, that the above entitled action marked off the (4) Non-Jury Day Calendar on October 21, 1953 be and the same hereby is restored to the (4) Non-Jury Day Calendar for the October 4th, 1954 term.

Dated: New York, N. Y.
April 12, 1954.

JULIAN T. ABELES
Attorney for Plaintiff

ARTHUR L. FISHBEIN (MO)
Attorney for Defendant

Stipulation Dated March 11, 1955 Amending Agreed Statement of Facts

(140)

The Agreed Statement of Facts and Stipulation, dated May 20, 1954, is hereby further amended by adding the following to the end of paragraph "4" thereof:

> "The plaintiff shall be deemed to have denied the material allegations of the First and Second Counterclaims pleaded in the answer of defendant as hereby amended, with the same force and effect as if a reply were served thereto to such effect and demanding affirmative judgment as prayed for in the complaint as amended."

Dated: New York, N. Y.
March 11, 1955.

JULIAN T. ABELES
Attorney for Plaintiff

ARTHUR L. FISHBEIN MO.
Attorney for Defendant

Excerpts from Testimony

(1)

UNITED STATES DISTRICT COURT

SOUTHERN DISTRICT OF NEW YORK

Civ. 27-179

EDWARD B. MARKS MUSIC CORP.,

Plaintiff,

v.

CHARLES K. HARRIS MUSIC PUBLISHING COMPANY,

Defendant.

Before:

HON. SYLVESTER J. RYAN,

District Judge.

New York, April 18, 1955,
10:30 o'clock a.m.

APPEARANCES:

JULIAN T. ABELES, Esq.,
Attorney for Plaintiff.

ARTHUR L. FISHBEIN, Esq.,
Attorney for Defendant;
Maxwell Okun, Esq., of Counsel.

(23) • • •

The Court: You are now reading into evidence answers made by the plaintiff to interrogatories propounded by the defendant.

Mr. Okun: Yes, sir.

Plaintiff's Answers to Interrogatories

The Court: All right.

Mr. Okun: This is the answer to interrogatories 6, 7, 8, 9, 10 and 11:

> "The first notice or knowledge plaintiff had that defendant or its predecessors in interest made any claim to the renewal copyright in the musical composition entitled 'I Wonder Who's Kissing Her Now' was in or about the month of October, 1937 through correspondence with the American Society of Composers, Authors and Publishers. The first notice or knowledge plaintiff had that the defendant or its predecessors in interest (24) made any claim to the renewal copyrights in the other musical compositions referred to in the complaint was on or about March 11, 1938, through a communication received from John G. Paine of the American Society of Composers, Authors and Publishers."

Answer to interrogatory 12:

> "On or about March 11, 1938, plaintiff was advised in a communication received from John G. Paine of the American Society of Composers, Authors and Publishers of the alleged claim asserted under a purported document dated December 2nd, 1916 but plaintiff first acquired knowledge of the context of said document in the action heretofore instituted in this Court by plaintiff against her and Jerry Vogel."

• • • •

KNOW ALL MEN BY THESE PRESENTS

THAT I. Joseph E. Howard ....hereinafter designated as the party of the first part, for and in consideration of the sum of $150 one ....dollars lawful money of the United States to me ....in hand paid, at or before the ensealing and delivery of these presents, by CHAS. K. HARRIS, of the Borough of Manhattan, City and County of New York, party of the second part, the receipt whereof is hereby acknowledged, has bargained and sold, and by these presents does grant and convey unto the said party of the second part, his executors, administrators and assigns, all the right, title and interest by way of copyright or otherwise the party of the first part has in and to ~~a certain~~ all my musical composition ~~known as~~ published by Chas K. Harris of New York City .....

TO HAVE AND TO HOLD the same unto the said party of the second part, his executors, administrators and assigns forever. And the party of the first part does, for himself, his heirs, executors and administrators, covenant and agree to and with the said party of the second part to warrant and defend the sale of the said interest hereby sold unto the said party of the second part, his executors, administrators and assigns, against all and every person and persons whomsoever. And the party of the first part hereby releases the party of the second part from payment of royalties or otherwise by reason of any contract or understanding had between the parties concerning said musical compositions. The within agreement is made and money paid upon the representation that the party of the first part has the right and full power to make the same and has not in any manner sold, transferred, hypothecated or mortgaged his said interest.

IN WITNESS WHEREOF, we have hereunto set our hands and seals this 2nd day of December one thousand nine hundred and 16 .....

Sealed and delivered

in the Presence of:

Isabell B. Howard L.S. Joseph E. Howard L.S.

Chas K. Harris L.S.

Separate Assignment from Howard to Harris

(Defendant's Exhibit A-1, Record pages 9, 10.)

Know All Men By These Presents that the undersigned Joseph E. Howard, residing at 76 East 54th St., New York, N. Y., For and in consideration of the sum of One ($1.00) Dollar and other valuable considerations paid to the undersigned by Cora L. Harris, widow of Charles K. Harris, having an office at 701 Seventh Ave. in the Borough of Manhattan, City and State of New York, the receipt whereof the undersigned hereby acknowledges, does hereby sell, assign, transfer and set over unto said Cora L. Harris, her assigns, executors, administrators and distributees, the undersigned's entire right, title, and interest in the copyrights secured by Joseph E. Howard in the following, duly registered for copyright in the United States copyright office.

Title	Registration No.	Renewal Reg.
Brownies	C-90563	R-22684
My Uncle Sam	C-102019	R-22687
My Illinois	C-90562	R-22683
Heap Love	C-90693	R-22685
Oh the Deuce What's the Use	C-91434	R-22686
I'm So Lonesome for You	C-91158	R-22688
Ask the Man	C-90560	R-22682
Diplomacy	C-90559	R-25013
Dear Heart	C-96703	R-24652
When You Grow Tired Just Let Me Know	C-99341	R-22691
The Girl You Dream About	C-96702	R-24650
Just a Paper Doll	C-96699	R-25302
The Belle of Bald-head Row	C-96700	R-24649
Same Old Moon	C-96705	R-22689
Cinderella	C-96704	R-22690
Julie Dooley	C-86692	R-22681

Separate Assignment from Howard to Harris

To have and to hold the same unto said Cora L. Harris, her executors, administrators, assigns and distributees, during the full and entire term for which the said copyrights have been secured and any renewal or extension thereof. In Witness Whereof, the undersigned has caused this assignment to be duly executed this 27th day of April 1936.

JOSEPH E. HOWARD

I. B. Monroe, L.S.
Wm. Suffes, L.S.

[SEAL]

June 6, 1933 Agreement Between Howard and Plaintiff

(Part of Plaintiff's Exhibit 1, Record pages 2, 3, 97-107.)

THIS AGREEMENT, made this 6th day of June, 1933, by and between Edward B. Marks Music Corporation, a Corporation organized and existing under the laws of the State of New York and having its principal place of business at #223-225 West 46th Street, in the Borough of Manhattan, in the City, County and State of New York, hereinafter called the "Publisher", party of the first part and Joseph E. Howard, of New York, N. Y., hereinafter called the "Owner", party of the second part,

Whereas, the party of the second part is the composer of the musical compositions listed herewith, marked "Exhibit A" and Whereas the parties hereto desire to provide for the renewal of the copyright of and upon each of said musical compositions upon its expiration and to

make provision for the continued publication during the renewal copyright term of said musical compositions by the Publisher.

NOW, THEREFORE, in consideration of the premises and of the mutual agreements of the parties hereto, and of the sum of One Dollar ($1.00) lawful money of the United States, to each of the parties in hand paid, the receipt whereof is hereby acknowledged, it is mutually covenanted and agreed as follows:

FIRST: The party of the second part hereby sells, assigns, sets over, transfers, conveys and releases to the party of the first part, all his right, title and interest in and to each of the musical compositions listed herewith marked "Exhibit A" together with every right or license of whatever kind, without limitation whatsoever, in any wise relating or appertaining to the said musical compositions, together with the right to copyright the same as sole owner and proprietor in the United States and elsewhere throughout the world, and also together with every right of whatever kind to sell, contract for, let for hire or authorize in any manner whatsoever the reproduction or performance of the said musical compositions, or any part thereof, in any manner whatever, by any Band, or Orchestra, or musical instrument or instruments, by the human voice, or by any device, contrivance or appliance without limitation of any kind as to character adapted in any way whatsoever to represent or reproduce the whole or any part of any of the said musical compositions to the ear.

The party of the second part for himself, his executors, administrators and or other legal representatives and or, so far as permitted by law, for his children and or next of kin, hereby sells, assigns, sets over, transfers, conveys and releases to the Publisher the renewal and or extension and or the sole and exclusive right to secure and

effect upon its expiration the renewal and or extension of each and every copyright of and upon each of the aforesaid musical compositions in the United States and or elsewhere throughout the world, in the name of the owner and or the publisher and or all of any of the persons aforesaid on whose behalf this agreement is made, as may be required by law, effectually to secure to the Publisher the full benefit and enjoyment of the renewal and extension of each of the aforesaid copyrights throughout the renewal and extension period. To that end the Owner covenants and agrees that he and or his executors, administrators and or other legal representatives and, so far as he may lawfully bind them so to do, each and every person on whose behalf this agreement is made, will make and execute in the form and manner required by law, any and all renewals and or extension applications and or other instruments of whatever kind effectually to secure the valid renewal and extension of each and every of the aforesaid copyrights, and effectually and duly to vest in the Publisher such extension and, or renewal and the full right to all the benefits and enjoyments of each and every such renewal and or extension throughout the period thereof. To that end the Owner for himself, his executors, administrators and or other legal representatives, and, so far as may be permitted by law, for each and every other person on whose behalf this agreement is made, constitutes the Publisher his and or their attorney to make and execute on his and or their behalf, in the name of the Publisher and or in the name of the Owner and or in the name of any and all such other person or persons, any and all applications for renewal and or extension of any and all such copyrights, and any and all other instruments of whatever kind required by law effectually to vest in the Publisher the renewal and or extension of each and every of the aforesaid copyrights and the full enjoyment thereof throughout the period of the term of each and

every such renewal and or extension. The owner hereby declares that this power is coupled with an interest and is and shall at all times be irrevocable. The Publisher, on his part agrees that he will, so far as he may lawfully do so, take all the steps to secure the valid renewal and or extension of each and every of the aforesaid copyrights.

SECOND: The Publisher hereby agrees to pay to the Owner a royalty of five cents (5¢) per copy for each and every copy sold of compositions written and composed by him and five cents (5¢) jointly per copy for each and every copy sold of compositions collaborated in by him, such payments to be made at the Publisher's New York place of business semi-annually, as soon after the 25th day of January and the 25th day of July in each year, during the term of the said copyright, as the proper statements can be prepared.

It is agreed between the parties hereto that no royalties shall be paid or claimed upon copies sent to customers on consignment and not sold, professional copies (copies furnished to musicians and indicating their specific use on the face), and on "New Issues" (wrapper or sample copies sent out to the trade at five (5¢) cents per copy) and complimentary copies. It is also agreed that the Publisher shall have the right to print for advertising purposes and distribute copies of the said musical compositions or any of them without being required to pay any royalty upon the same, and shall also have the right to have the said musical compositions, or any of them, arranged at his own expense for Orchestra, Band or other instruments, without being required to pay any royalty upon the same. It is expressly agreed that royalties shall be payable only in cases herein provided and not otherwise.

It is further understood and agreed between the parties that if any copies for which royalties have been paid in any half year are returned to the Publisher, the royalties

so paid shall be credited and allowed to him upon the next semi-annual statement.

THIRD: The Publisher hereby agrees to pay to the Owner a royalty of Fifty Percent (50%) of all amounts received from Mechanical Instrument Royalties, Sound Film Royalties, and other Royalties earned by compositions written and composed by him, and Fifty Percent (50%) jointly of all such Royalties earned by compositions collaborated in by him.

FOURTH: It is expressly understood and agreed that neither this agreement, nor any right or interest of the Owner hereunder, shall be assignable or transferrable by the Owner in whole or in part, directly or indirectly, in any manner whatsoever, without the consent in writing of the party of the first part.

FIFTH: It is further covenanted and agreed that except as herein otherwise provided, this contract and each and every term, covenant and agreement therein contained shall be binding upon the legal representatives, and assigns of the parties hereto.

The party of the second part hereby acknowledges the receipt of the sum of Two Hundred Dollars ($200.00) paid as an advance on account of Royalties.

IN WITNESS WHEREOF, the parties hereto have executed this agreement in duplicate, in the Borough of Manhattan, in the City, County and State of New York, the day and year hereinbefore first written.

EDWARD B. MARKS MUSIC CORPORATION

MAX B. MARKS, Vice-President

JOSEPH E. HOWARD

In the presence of:

SYLVIA GOLDMAN

SYLVIA GOLDMAN

June 6, 1933 Agreement Between Howard and Plaintiff

State of New York,
County of New York—ss.:

On this 6th day of June, 1933, before me personally came MAX B. MARKS, to me known, who being by me duly sworn did depose and say that he resides in Brooklyn, N. Y., that he is the Vice-President of EDWARD B. MARKS MUSIC CORPORATION, the Corporation described in and which executed the above instrument; that he knows the seal of said corporation; that the seal affixed to said instrument is such corporate seal; that it was so affixed by order of the board of directors of said corporation, and that he signed his name thereto by like order.

SEYMOUR SHEFFLAN
Notary Public, Kings County No. 603
Kings County Register No. 4723
New York County Clerk's No. 1764
New York County Reg. No. 481112
Certificate Filed in New York County
Term Expires March 30, 1934

State of New York,
County of New York—ss.:

On the 6th day of June, 1933, before me personally came JOSEPH E. HOWARD, to me known and known to me to be one of the individuals described in and who executed the foregoing instrument and he duly acknowledged to me that he executed the same.

SEYMOUR SHEFFLAN
Notary Public, Kings County No. 603
Kings County Register No. 4723
New York County Clerk's No. 1764
New York County Reg. No. 481112
Certificate Filed in New York County
Term Expires March 30, 1934

[Exhibit A—schedule of musical compositions—not printed.]

Deposition of Isabelle B. Monroe

(Defendant's Exhibit B, Record pages 10-17.)

UNITED STATES DISTRICT COURT

SOUTHERN DISTRICT OF NEW YORK

Civil Action File No. 27-179

EDWARD B. MARKS MUSIC CORPORATION,

Plaintiff,

—against—

CHARLES K. HARRIS MUSIC PUBLISHING CO., INC.,

Defendant.

Washington Drive
Mastic Beach, L. I.
March 9, 1955
2:00 o'clock p. m.

Examination before trial of Isabelle B. Monroe, taken by Defendant, pursuant to Notice dated February 16, 1955, and subsequent adjournment.

APPEARANCES:

JULIAN T. ABELES, Esq.
Attorney for Plaintiff
745 Fifth Avenue
New York, New York

BY: ARNOLD J. BERNSTEIN, Esq., of Counsel

Deposition of Isabelle B. Monroe

ARTHUR L. FISHBEIN, Esq.
Attorney for Defendant
25 West 44th Street
New York, New York

BY: MAXWELL OKUN, Esq., of Counsel

IT IS HEREBY STIPULATED AND AGREED by and between the parties hereto, through their respective counsel, that sealing, certification and filing shall be and the same are hereby waived;

IT IS FURTHER STIPULATED AND AGREED by and between the parties hereto, through their respective counsel, that all objections shall be reserved to the time of the trial;

IT IS FURTHER STIPULATED AND AGREED that the within deposition may be signed before any notary public with the same force and effect as if signed and sworn to before the Court;

IT IS FURTHER STIPULATED AND AGREED that a copy of the within deposition shall be furnished to the attorney for the plaintiff, without charge.

JULIAN T. ABELES.
MAXWELL OKUN

ISABELLE B. MONROE, having first been duly sworn by a notary public of the State of New York, testified as follows:

Direct examination by Mr. Okun:

Q. What is your full name? A. You want the "B"?
Q. Please. A. Isabelle Becker, B-e-c-k-e-r, Monroe.

Q. Where do you reside? A. Now?

Q. Now. A. Mastic Beach, Long Island, Washington Drive, Mastic Beach, Long Island.

Q. Did you know Charles K. Harris? A. Very well.

Q. Did you ever work for Charles K. Harris? A. For forty years.

Q. What business was Charles K. Harris in? A. Music publishing.

Q. Where was the place of business when you first went to work for Mr. Harris? A. Down on 32nd Street.

Mr. Okun: Off the record.

(Discussion off the record.)

A. 32nd Street near Broadway.

Q. New York City? A. Right.

Q. What year did you first go to work for Mr. Harris? Was it 1903, or approximately 1903? A. 1903.

Q. Did you work continuously for Mr. Harris from 1903 until Mr. Harris died? A. No. I worked from 1903 to 1943. Mr. Harris died in 1930.

Q. And, after Mr. Harris died, whom did you work for? A. Mrs. Harris. Cora L. Harris.

Q. Did Mrs. Harris continue the music publishing business which was formerly operated by her husband? A. Yes, she did.

Q. Did you continue to perform the same duties for Mrs. Harris as you had performed for Mr. Harris? A. Yes, I did, and, perhaps, a little more.

Q. What duties did you perform while you were working for Mr. Harris? A. Well, first, I went in as a bookkeeper. Then I went in and I had charge of the royalty statements and several other little things I had to do.

Q. Do you recall a person by the name of Joseph E. Howard? A. I certainly do.

Q. Did you know him personally? A. Very well.

Deposition of Isabelle R. Monroe

Q. In relationship to the time when you first went to work for Mr. Harris in 1903, can you tell us approximately when you first got to know Mr. Howard? A. Perhaps 1905, 1906, may have been even earlier.

Q. Did you ever see Mr. Howard at Mr. Harris' office? A. Oh, often.

Q. Did you speak to him often? A. Very often. May I say that I also worked for Mr. Howard.

Q. When? A. Oh, I should imagine from 1910 to 1913, but only in my spare time.

Q. At the same time between 1910— A. At the same time I was employed by Charles K. Harris. Charles K. Harris gave me permission to work for Joseph E. Howard.

Q. Now, to your own knowledge, did Mr. Harris publish songs which had been composed by Joseph E. Howard? A. Absolutely.

Q. Were you familiar with those songs? A. Yes, I was, at the time, very familiar.

Q. Were you familiar with the bookkeeping records concerning Mr. Howard? A. What?

Q. Were you familiar with the bookkeeping records in Mr. Harris' office which concerned themselves with Howard's songs? A. Yes, very much so.

Q. Did you have any dealings with Howard concerning the songs which Harris published for Howard? A. Well,——

Q. Generally. A. Well, the only dealings I would have is I made up the royalty statements.

Mr. Bernstein: Off the record.
(Discussion off the record.)

Q. I show you a document dated December 2, 1916, which was previously marked Exhibit A for identification on the examination of Ralph S. Peer, taken by plaintiff,

on May 12, 1952, and ask you if your signature appears on that document?

Mr. Bernstein: Off the record.
(Discussion off the record.)

A. Yes, right here. It's the same day.

Mr. Okun: The witness pointed to her signature appearing under the printed words "in the presence of".

Q. Did you see Joseph E. Howard sign the document which is marked Exhibit A as aforesaid? A. Do I have to take it again? Yes, I did. I was in the office at the time.

Mr. Okun: Off the record.
(Discussion off the record.)

Q. Were you familiar with the account between Mr. Harris and Mr. Howard and whether Mr. Howard or Mr. Harris owed each other money as of December 2, 1916? Do you recall that situation? A. Yes, I do.

Q. Can you tell us what the situation was between Mr. Howard and Mr. Harris as you recall it just prior to and on December 2, 1916? A. Well, Mr. Howard—I shouldn't get the names mixed—but Mr. Howard came in a great many times and used to borrow money, so, at the time that this agreement was made, he really was indebted to Charles K. Harris for quite a sum of money.

Q. Can you say approximately how much that indebtedness was as of December 2, 1916? A. It was way over a thousand dollars.

Q. Do you recall in connection with what some of this money was loaned to Mr. Howard? A. Well,——

Mr. Bernstein: Excuse me. What is the relevancy?

Mr. Okun: This is the consideration for the agreement.

Mr. Bernstein: Will you read the last question to me?

(The reporter read the question.)

Mr. Okun: Question withdrawn.

Q. You referred to the indebtedness from Mr. Howard to Mr. Harris. Did that arise from money which Mr. Harris loaned to Mr. Howard? A. Yes.

Q. Were you personally familiar with those loans? A. Yes, I kept records of them.

Q. Can you tell us, in connection with what matters, some of those loans had been made by Mr. Harris to Mr. Howard? A. Well,—

Q. If you recall.

Q. Well, I would recall, of course, a great many times he'd be short of money and be down and out, and Mr. Harris just simply would advance him on what we considered the royalty account.

Q. Was there a real estate deal at about that time in which Mr. Howard was involved? A. Yes. I think—I don't know if you'd call it a real estate deal, but it was a deal whereby Joe Howard had taken a garage up in through—oh, beyond New Rochelle somewhere, and he telephoned to me, and he said he'd have to have a thousand dollars, but—I don't know, now—he was to get this thousand dollars, and—well, so I went in and I pursuaded Mr. Harris to give him the thousand dollars, and I told Mr. Harris that he'd get it back again, and we would get the thousand dollars. And, as time went on, say about two or three weeks, perhaps two, I telephoned the garage up there, and they said that they had paid Joe Howard this thousand dollars, which he never reimbursed us.

Q. But, you do know, do you not, that Mr. Harris loaned Mr. Howard a thousand dollars at about this time, or just prior thereto— A. Prior. It would be prior.

Q. Prior? A. Yes.

Q. In connection with a garage? A. That's right.

Q. Now, can you tell me where Mr. Howard and Mr. Harris met on December 2, 1916? A. In Mr. Harris' office.

Q. Where were you, at that time? A. I was in my office.

Q. Where was your office in connection with Mr. Harris' office? A. Oh, I imagine, about three offices down, but we had that telephone system, you know, going from office to office, and Mr. Harris would just telephone me and tell me what to do. So, this particular day, he told me to make a check out.

Q. To whom? A. Joe Howard.

Q. For how much? A. I think it was $150.

Q. Did you make out such a check? A. Yes.

Q. What did you do with the check after you made it out? A. I brought it into Mr. Harris' office.

Q. And, when you went into Mr. Harris' office, who was in the office? A. Joe Howard and Mr. Harris.

Q. At that time, was this paper, which is marked Exhibit A, dated December 2, 1916, already signed by Mr. Howard, or was it signed after you came into the room? A. It was after we had given the check to Mr. Howard.

Q. And, while you were in the room? A. That's right.

Q. Did you hand the check to Mr. Howard? A. I did.

Q. Before you handed the check to Mr. Howard— A. Wait a minute. I think I would have to hand it to Mr. Harris first because he would have to sign the check.

Q. Did Mr. Harris say anything to you at that time in the presence of Mr. Howard? A. Well, everything was hunky donky, if you know what I mean, and they shook hands, and now the property was ours, and so forth and so on.

Q. Now, Mrs. Monroe, what did Mr. Harris say to you as the reason he was paying the $150 to Howard, and what do you mean when he said, "Now, the property is ours."

Mr. Bernstein: I object to this question, as a matter of fact, to the form of the question. You started to lead the witness. And, I object on the ground it's irrelevant. If you want an interpretation of the agreement, the agreement speaks for itself.

Mr. Okun: The testimony can be taken. The objection can be brought up at the time of reading.

Mr. Bernstein: Not when it's objection as to the form.

Mr. Okun: Then, I'll rephrase the question.

Q. Mrs. Monroe, will you please tell us the complete conversation which was then had between Mr. Harris and Mr. Howard and yourself, everything that Mr. Harris said while you were in the room— A. As I said, everything was very jovial, and Mr. Howard was very happy about the whole thing. So was Mr. Harris and I, that all the—the property was ours.

Mr. Bernstein: Well, that's——

Mr. Okun: Let her finish the answer.

A. The property was ours with all the lease——

Mr. Bernstein: I object.

Mr. Okun: Let her finish the answer.

Mr. Bernstein: I don't mind your asking. She said what was said. Now, she is telling us why they were happy at the time. If it is your question, state it, and I'll object to it.

Q. Tell us what was said by Mr. Harris or by Mr. Howard at that time, and who said it. A. I don't think

Mr. Howard said much except he was happy, and Mr. Harris said all the property was ours and all the renewals became part of our catalogue.

Q. Did Mr. Harris say anything to you about the money which was then owing from Mr. Howard, the indebtedness about which you spoke before? A. At the time the $150 was given to him, I was given to understand the part that he owed us was to be canceled.

Q. Who said that? A. Mr. Harris said that.

Q. Mr. Harris said what to you? A. At the time that we gave him the $150, that the amount that Mr. Howard owed on our books at the time, that amount was to be canceled.

Q. Who said that to you? A. Mr. Harris.

Q. Mr. Harris said to you that you were to cancel——

> Mr. Bernstein: Look. I repeat my objection. I object to any conversation between Mr. Harris and the witness alone.

Q. Was Mr. Howard present? A. Yes, of course. Naturally.

Q. Was this all part of the same conversation? A. Absolutely. I left Mr. Howard in the office when I left.

Q. Did you ever make an entry in Mr. Harris' books in accordance with that instruction, canceling Mr. Howard's indebtedness? A. Yes, of course.

Q. Mrs. Monroe, were you familiar with the practice and customs which prevailed in the music industry generally while you were working for Mr. Harris? A. Yes, I was.

Q. Was there, to your knowledge, a practice and custom in the music publishing industry whereby publishers often bought renewals from their composers and writers during the original period of copyright? A. Yes, there was.

Mr. Bernstein: I object to the question.
(Discussion off the record.)
Mr. Bernstein: Will you repeat the answer?
(The reporter read the answer.)
Mr. Bernstein: May I have the question?
(The reporter read the question.)
(Discussion off the record.)

Q. From your experience and to your personal knowledge, did other publishers often check with you as original publishers of musical compositions whether or not you had obtained from your own composers renewals during the original term of copyright?

Mr. Bernstein: I object to the question as leading.

Mr. Okun: Will you give your answer, Mrs. Monroe?

A. In a few instances, yes.

Q. Do you know, or did you know Mr. Edward B. Marks of the Edward B. Marks Music Corporation? A. I certainly did.

Q. Did you know him during the period while you were working for Mr. Harris? A. Yes, surely.

Q. Did Edward B. Marks ever come to the office of the Harris Music Publishing Company in 1933? A. Yes, he did.

Q. In what part of the year did he come? A. It must have been the fall because he had on a tweed overcoat.

Q. Who was present when he came to Mr. Harris' office? A. Mrs. Harris and I.

Q. And Mr. Edward B. Marks? A. And Mr. Marks.

Q. Did he come pursuant to any phone call or any other communication from you? A. Yes, we called him up, and it took us a long while to get him besides.

Deposition of Isabelle B. Monroe

Q. Will you tell us the entire conversation that took place between you, Mr. Marks and Mr. Harris? A. Mrs. Harris.

Q. And Mrs. Harris. What was the conversation that took place when Mr. Marks came to Harris' office? A. I don't know if I could tell you the whole conversation. It was very long, and Mr. Marks was very erratic at the time, and he yelled and screamed, and so forth and so on. But, we told him we owned all the renewal rights, and so forth and so on.

Q. Whose renewal rights, to what songs? A. Joe Howard.

Q. What else did you tell him? A. What else?

Q. Yes. A. You don't want me to go into personal affairs between Mr. Harris and Mr. Marks. Mr. Marks said these awful things about Mr. Harris, and they were supposed to be this way.

Q. What did Mr. Marks say when you told him that Harris owned the renewal rights? A. Well, he disagreed.

Q. Did he say anything else, and, if so, what did he say? A. As I told you, the conversation was so long, I don't remember just what he said, but, anyway, Mrs. Harris and I had very little time to say anything. Mr. Marks said everything, and he screamed and yelled at the same time.

Q. What was the main subject of conversation on this occasion? A. About renewals.

Mr. Bernstein: I object to your continued examination along this line. The witness has said she doesn't remember except that he screamed and yelled.

The Witness: I remember the source of the conversation. It was about renewals.

Q. Whose renewals? A. Joe Howard's

Q. Mrs. Monroe, I show you here seventeen documents which have been marked Exhibits B to R inclusive for identification at the examination of Mr. Peer before trial, held by the plaintiff on May 12, 1952——

Mr. Bernstein: May I see that?

Q. —and I ask you whether you recall preparing these seventeen different papers? A. Do I have to look at all of them?

Mr. Okun: Well, they are there for you to look at.

A. Yes.

Q. I show you this canceled check and ask you if you remember preparing the same? A. Yes, I do.

Mr. Okun: Can I have this check marked as Exhibit 1 on this examination?

(Check No. 6292 of Charles K. Harris, dated April 28, 1936, made payable to Joseph E. Howard in the amount of $300.00, signed by C. L. Harris, drawn on the Irving Trust Company, marked Defendant's Exhibit 1 for identification.)

Q. Mrs. Monroe, were all of these documents, previously referred to as Exhibits B to R inclusive, signed by Mr. Howard? A. Yes, they were.

Q. Did you see him sign them? A. Yes, I did.

Q. Were they—all of these documents referred to as Exhibits B to R inclusive—executed and signed by Mr. Howard at the same time; at one time? A. Yes, they were.

Deposition of Isabelle B. Monroe

Q. Were all of these documents referred to as Exhibits B to R inclusive signed by Mr. Howard and left with you on April 28, 1936, the date of the check which has been marked Defendant's Exhibit 1 on this examination? A. Yes, they were.

Q. Now, in preparing these documents, Mrs. Monroe, in those instances where the renewal of the composition referred to in the document did not occur until later, did you leave a blank space under the column designated "Renewal Registration Number"? A. Yes, I did.

Q. And, in those instances where the renewal had been obtained prior to April 28, 1936— A. The numbers, the renewal numbers were put in.

Q. Were put in by you? A. That's right.

Q. Did Mr. Howard authorize you to fill in these blanks as the renewals were obtained? A. Yes, he did.

Q. What did he say to you about that when he gave you these papers? A. Well, it was understood that when the papers were made out and he signed them that, naturally, we couldn't put in the renewal dates until we received them from Washington, so he knew that we were leaving them blank.

Q. In each of these exhibits, B to R inclusive, was the title of the song and the original copyright registration number filled in before Howard signed the document? A. Yes, they were.

Q. What was the relationship between the check for $300.00, marked Defendant's Exhibit 1 for identification, and these documents from B to R inclusive? A. Well, it was understood that, if he would sign all these renewal rights for us and so forth and so on—although we really claim we owned them—Mrs. Harris thought it was best to compensate him for signing all these papers. So we gave him the $300.00.

Mr. Okun: Would you read the answer back?

(The reporter read the answer.)

Deposition of Isabelle B. Monroe

Q. Did you tell that to Mr. Howard before you gave him the check? A. Yes, surely. He was the one that suggested it.

Q. And, when you say "suggested it", what did he suggest? A. He felt he needed a little extra money, you know, and so forth and so on, so he told us to prepare the papers, and, if Mrs. Harris would give him the extra compensation, why he would sign them.

Q. And, the papers which you refer to— A. That's right.

Q. —are the documents which have been marked B to R inclusive? A. You said there are seventeen.

Q. Yes. A. Yes.

Q. Now, did you, from time to time, file applications for renewal of Howard's copyrights? A. Yes, we did.

Q. Did you do that personally? A. Yes, I did.

Q. And, did you file them for Howard in the name of the Harris firm? A. That's right.

Q. Did you prepare these renewal applications in connection with Howard's compositions for many years, Mrs. Monroe, as you recall? A. Well, after Mr. Harris had passed on, I did.

Q. You did? A. Yes.

Q. And, what did you do with these applications after you prepared them? A. After we paid for them?

Q. After you paid for them, did you send them to Washington? A. Yes, and they came back with a number.

Q. To the Harris firm? A. Yes.

Q. And did you pay the fee? A. The Harris firm paid the fee.

Q. And, after Mr. Harris died, Mrs. Harris was the one who ran the firm? A. Yes, she did.

Q. May I ask you what your age is? Do you have any objection to telling us? A. Not at all. I'm seventy-two.

Q. Can you give me the name and address of your

doctor, under whose care you are now? A. Yes, that is, medical doctor. We have given up the orthopedic. The medical doctor is Louis Foster, Ocean Avenue, Center Moriches, Long Island.

Q. Can you give us the name and address of your orthopedic surgeon, for the sake of the record? A. We had two. Do you want the last one?

Q. The last one, please. A. I don't know—oh, yes, his name is Norman Weber.

Q. W-e-b-e-r? A. W-e-b-e-r. Seatucket, Long Island, and he was able to get me into St. Charles Hospital as a daily patient. When we came out here, we had an idea that I'd be able to improve by going into the hospital. It's a polio hospital, but they also have cerebral palsy and all that.

Mr. Okun: No further questions.

(A short recess was taken.)

Cross examination by Mr. Bernstein:

Q. Mrs. Monroe, you have testified that you were present when this Exhibit A was signed by Joseph Howard on December 2, 1916? A. I was.

Q. Were any other papers signed at that time? A. No, that's all.

Q. Was the real estate loan to Howard that you testified to ever repaid— A. No.

Q. —by Howard? A. No. To Harris? No. Would you call it a real estate loan? He was buying a garage, not the building, but, as far as I can recall, the good will of the garage.

Q. When did he buy the good will of that garage? A. Well, I can't really remember the day, but I know that he hadn't repaid it. As I told you, why he was to repay it within a very short time, and I imagine it was about three

weeks after that he had got the loan. Mr. Harris asked me when we were going to get the thousand dollars back again, and so I said I'd take it on myself to call up the garage because I know where it was. It was up in the direction of New Rochelle somewhere. So, I called them up. They were very much surprised to think that Mr. Howard had collected it and said that he hadn't.

Q. Can you give me an idea of how long before the signing of this Exhibit A, that is, how long before December 2, 1916, Howard went into the real estate or garage venture? A. Oh, I don't know. It may have been two or three years.

Q. And, then, you have told us that two or three weeks after the loan was made, you tried unsuccessfully to get it back from Mr. Howard? A. Yes, I called up the garage, and they claimed they had given the thousand dollars to Howard.

Q. Then, what other efforts did Mr. Harris make to secure the repayment of that thousand dollar loan? A. We didn't make any others. It was just simply left open on the books as sort of an advance royalty on the statements that would be due.

Q. Do you know where those books are now that you refer to? A. No.

Q. If we found those books, that item would still be open? A. That's right. Well, it wouldn't be open because, after all, when we gave him this $150, why everything was canceled that he owed.

Q. But, no paper was given to him at the time besides Exhibit A? A. Howard?

Q. Yes. A. No.

Q. In 1916, how long had you been working in the music business? A. Thirteen years. Now, we weren't down at 32nd Street when this paper was signed. We were in the Columbia Theatre Building at the time. It's now the Mayfair.

Q. You said before, Mrs. Monroe, that Mr. Marks came to Mr. Harris' office in the fall. You were referring to the fall of 1936, were you not? A. That's right. Mr. Harris had passed on six years before that.

Mr. Okun: 1936 or 1933?

The Witness: I don't know.

Mr. Okun: Just a minute. That isn't what she said.

Q. What's the date? A. 1933, the fall of 1933. Was it 1933?

Mr. Okun: Yes, the fall of 1933.

The Witness: It must have been because we were still in the Astor Building. We weren't there so long after he died.

Q. Mrs. Monroe, do you remember making and signing an affidavit in the case of Edward B. Marks Music Corporation against Jerry Vogel Music Company, Inc. and Cora L. Harris? A. I remember there was something, yes.

Q. I want to read to you from that affidavit.

Mr. Okun: Can you tell me where you are reading from?

Mr. Bernstein: Page 6.

Q. You speak of the plaintiff, that is the Edward B. Marks Music Corporation, "on the 6th day of June, 1933, entered into the aforesaid agreement with Joseph E. Howard—" A. This is Vogel?

Q. No, this is Marks. A. Oh, Marks.

Q. "—which required Howard to assign to plaintiff the renewal copyright of the musical composition, 'I Wonder

Who's Kissing Her Now' upon the accrual of the same, two and a half or three years later", and then you say that "within a couple of weeks after that agreement was entered into, the said Joseph Howard came to the office of defendant Cora L. Harris and advised said defendant of the agreement which he had made with plaintiff"? A. Yes.

Q. Is that a correct statement? A. That's correct. Wait a minute. Repeat your question.

Mr. Okun: He'll read it to you.

(The reporter read the question.)

The Witness: Now, will you explain the details of it.

Mr. Okun: Do it off the record.

(Discussion off the record.)

A. Yes, that is a correct statement of the facts.

Mr. Okun: Is that right?

The Witness: Yes, that's a correct statement of the facts.

Q. Further on in that affidavit, you said that you were present at a conference in September or October of 1933 between that Mr. Marks and Mrs. Harris. A. You want me to answer, yes?

Q. No, let me finish. And, at that time, Mr. Marks was given full and complete notice of the prior assignment executed by Howard to Mr. Harris in 1916? A. That's right.

Q. Is that correct? A. Correct.

Q. When Mrs. Harris, at that time informed Mr. Marks of the prior assignment she claimed to have to the Howard compositions, what did Mr. Marks say? A. Well, it would be very hard to say just what he said because

Q. Do you remember——

Mr. Okun: The substance only.

Mr. Bernstein: No.

Q. Do you remember what he said? A. No, I couldn't remember everything because he just simply bellowed, and he claims that we didn't own the assignment, the renewal rights.

Q. Mrs. Monroe, you referred to a custom of music publishers sometimes to acquire renewals during the original term of the copyright? A. Well, that's very true, but I didn't say 1916.

Q. I didn't say it either. A. I'm sorry.

Q. Did you mean to imply that that was the custom in 1916? A. Yes.

Q. Did your firm, at that time, acquire the renewals of any compositions in accordance with that custom? A. Yes.

Q. Can you tell me which ones? A. No, I couldn't.

Q. Can you tell me what authors? A. No, I couldn't. I know that we had, because, after all, we wouldn't have that blank printed up as we had, so it came previous to 1916.

Q. You don't remember which songs or which authors, but you do remember that renewals were acquired at that time? A. That's right, because, as I said before, that paper was printed before that, so, if it wasn't necessary, Mr. Harris wouldn't have had that paper printed. Right?

Q. When renewals were acquired, were you the one who prepared the contracts? A. No, not while Mr. Harris lived.

Q. Did you see any such contracts? A. If there was any money paid, which there usually was, it would be sent back to my office, but, sometimes they would be filed in his office because this Joe Howard paper—for a long while, we weren't able to find it, until at last, I looked in the old

files belonging to Mr. Harris, and it had been filed in there, but I knew the paper existed, but, where it was, I don't know, but then we did find it.

Q. Did you prepare the agreement, Exhibit A? A. Which is A? No, I only signed it and witnessed Mr. Harris' and Joe Howard's signatures.

Q. You've said that you prepared seventeen short forms of assignment, exhibits B through R? A. Yes, I did.

Q. Did you mean to testify that you did the actual typing of them? A. Well, I did have some assistance, but I did most of them, yes.

Q. And, I understood you to say that you typed them completely before they were signed except only for the renewal registration numbers— A. That's right.

Q. —when that was unknown. A. That's right. Correct.

Q. Will you look at Exhibit R and tell me if you typed that exactly as it is before it was signed? A. As far as I recall, yes.

Q. Will you look at Exhibit R closely, Mrs. Monroe, and see if it doesn't appear to you that the names of the compositions were typed on a different typewriter than was used to type the rest of the assignment? A. I don't know how.

Q. Just look. A. I'd say no, because we only had the one typewriter, and they were all done in the office.

Q. Now, you've testified that all of these exhibits, B through R, were executed by Joseph E. Howard in your presence on April 28, 1936, is that right? A. That's correct.

Q. And that nothing was added to them since, except the renewal registration number when necessary? A. That's right.

Q. Would you look at the next one I have, Exhibit Q, and tell me if it doesn't appear that the names of the

compositions were typed in on a different typewriter and at a different time, and that the last two or three lines and the date were typed in at a different time? A. Well, I'll have to say the same as before. We only had one typewriter, and they were all prepared at the same time.

Mr. Okun: Well, look at the date.

The Witness: Well, the date doesn't mean much to me.

Mr. Okun: That's at the bottom.

The Witness: Maybe the ribbon was a little lighter in places. I don't know. I'll say they were all done on the same machine.

Q. Will you also say that you typed in the date, October 19, 1940, as the date that Mr. Howard executed this agreement, Q? A. I still say they were all done at the same time.

Q. And, you mean you still say that you typed the whole agreement except for the renewal registration number? A. Renewal rights, that's right. Renewal registration, I should say.

Q. I show you Exhibit P and ask you if you testify the same as to that document? A. They were all done at the same time.

Q. You are telling me that you typed Exhibit P as it is now, completely, except only for the renewal registration number? A. Now, it may be possible that we typed them and then, afterwards, we looked up the dates of the renewals, and we filled those in so that, may be possible that the ribbon was getting different, I don't know. But, I know they were all typed at the same time, but, whether the renewal date was filled in at the time we typed them or not, I don't know, but it was filled in at the time that Mr. Howard signed them.

Q. Completely filled in, including the last lines which I have shown you? A. That's right, with the exception of the——

Q. Renewal registration? A. Renewal, that's right. Now, it may have taken a day or two to do them, I don't know. We couldn't do them all in one day. It may be possible we didn't, but, if it wasn't done the same day, it was done the next day on the same typewriter. We only had one typewriter there.

Q. When did you last see these seventeen exhibits? A. Oh, that's a long while ago. I think that's the time that we sold out to the Southern; and we handed it over to them.

Q. Do you mean, Mrs. Monroe, you have never seen these seventeen assignments—— A. No, I haven't.

Q. —— since the firm was sold to Southern? A. No.

Q. In what year? A. What was it? 1943.

Q. Didn't counsel for the defendant show you these assignments, these exhibits, when he visited you last month? A. I don't recall. I don't think he did.

Q. You would remember if he had shown them to you last month —— A. I feel quite sure I would, but I don't think he did.

Q. You have a pretty good memory, haven't you? A. Darn right I have.

Q. Can you state definitely that counsel for the defendant did not show you these assignments —— A. I can.

Q. One month ago? A. That's right.

Q. You can? A. I didn't see them.

Q. You have never seen them since you saw them in 1936? A. 1933, wasn't it?

Mr. Okun: April 28, 1936.

Q. Then, it's your testimony that you have never seen Exhibits B to R inclusive since you typed them in the

year 1936? A. I wouldn't say that. I saw them in 1943 when we turned them over to the Southern Music Company, but I haven't seen them since.

Q. I think, then, you'd better look at each one and tell me if it's exactly the same as you typed it. A. O. K.

Q. I show you Exhibit P— A. But you'll have to explain that a little more, exactly as I typed it.

Q. Always with the exception of the renewal registration number.

Mr. Okun: She filled that in, too.

The Witness: Yes.

Q. Who told you what to type in these assignments, Mrs. Monroe? A. Nobody told me. We just simply went to work and we got the—we had a copyright card, and we also had the music, and we just simply went from there on.

Q. Who told you what dates to put on each one? A. The copyright card would say the time of the renewal.

Q. Then, after looking at all of these assignments, B through R, today, you testify that you prepared them all— A. No, I said I had —

Q. —yourself or with assistance? A. That's right.

Q. On the same typewriter? A. That's right.

Q. And that they were complete as they now are at the time they were signed A. That's right.

Q. By Joseph E. Howard? A. That's right.

Q. Except for the renewal registration number A. That's right.

Q. —which you yourself added thereafter? A. That's right.

Mr. Bernstein: I think that's all.

Mr. Okun: May I ask you just one question?

The Witness: Yes.

Deposition of Isabelle B. Monroe

Re-direct examination by Mr. Okun:

Q. When Mr. Marks was at the Harris office in the fall of 1933, did Mrs. Harris offer to reimburse Marks for any moneys which he may have advanced to Howard? A. Yes, she did.

Q. She made that offer? A. Yes.

Q. In your presence? A. Yes. I was right there.

Q. You heard her say that? A. Absolutely.

Q. What did Mr. Marks say to that? A. He wouldn't agree to anything.

Mr. Okun: No further questions.

(Whereupon, at 3:40 o'clock p. m., the examination was closed.)

ISABELLE B. MONROE

Subscribed and sworn to before me this
17 day of March 1955.

Joseph Fortuna

JOSEPH FORTUNA
Notary Public, State of N. Y.
Residing in Suffolk County
Suffolk Co. Clerk's No. 52-1281500
Com. Expires Mar. 30, 1955

Deposition of Edward B. Marks

(Defendant's Exhibit C, Record pages 17-20.)

UNITED STATES DISTRICT COURT

FOR THE SOUTHERN DISTRICT OF NEW YORK

Civil Action No. 14-341

EDWARD B. MARKS MUSIC CORPORATION,

Plaintiff,

—against—

JERRY VOGEL MUSIC CO. INC. and CORA L. HARRIS, conducting or transacting business under the name of Charles K. Harris, successor in interest,

Defendants.

Examination before trial of plaintiff EDWARD B. MARKS MUSIC CORPORATION by EDWARD B. MARKS, its President, taken on behalf of defendant Cora L. Harris on the 13th day of November, 1941 at 2:30 o'clock in the afternoon of that day at the offices of Edward B. Marks Music Corporation, No. 1250 Sixth Avenue, Borough of Manhattan, City, County and State of New York, in the Southern District of New York, pursuant to stipulation dated November 13, 1941.

There were present: The plaintiff, Edward B. Marks Music Corporation by its President, Edward B. Marks; Arthur E. Garmaize, Esq., attorney for plaintiff; Arthur F. Driscoll, Esq., of Messrs. O'Brien, Driscoll & Raftery, attorneys for defendant Jerry Vogel Music Co. Inc.; and Sidney Wm. Wattenberg, Esq., of Messrs. Wattenberg & Wattenberg, attorneys for defendant Cora L. Harris.

Deposition of Edward B. Marks

State of New York,
County of New York—ss.:

EDWARD B. MARKS MUSIC CORPORATION, by Edward B. Marks, President of the plaintiff herein, first having been duly sworn by Seymour Sheffler, the above named notary public, deposes and says:

(By Mr. Wattenberg)

Q. Will you please give me your full name? A. Edward B. Marks.

Q. And your residence, please? A. 215 Lakeville Road, Great Neck, Long Island.

Q. And what is your present occupation, Mr. Marks? A. Publishing.

Q. Are you an officer of Edward B. Marks Music Corporation? A. Yes, I am President.

Q. How long have you been engaged in the publishing business? A. Since 1894—47 years.

Q. Were you acquainted with Charles K. Harris? A. Yes I was.

Q. Can you tell me how long you knew Mr. Harris before he died? A. I would say about—Mr. Harris came to New York from Milwaukee. I think that was about 10 years after we went into business, and he established here and asked me for some pointers and so on.

Q. And you were in more or less close contact with him from that time until the time of his death? A. Yes. He died early in 1931 or 1932. I really couldn't tell you, but it was about then.

Q. Did you know of your own knowledge that Charles K. Harris was the publisher and copyright owner of the musical composition "I Wonder Who's Kissing Her Now"? A. Yes.

Deposition of Edward B. Marks

Q. Did you know whether that was the fact on June 6, 1933? A. June 6, 1933. Yes.

Q. I show you an agreement dated the 6th day of June, 1933 and I ask you whether that is the genuine signature of Max Marks? A. Yes.

Q. Was he an officer of the corporation? A. Yes.

Q. At that time? A. Yes.

Q. Do you remember the circumstances under which this agreement was made? A. I do.

Q. Did you solicit this agreement from Mr. Howard? A. No sir.

Q. Then he came to you, and asked you to enter into a deal with him? A. He came in here with his books of all his songs. He had been very ill and still looked it; and he said "Ed, you have got to take care of my copyrights because that is all I've got in the world for Mary and Junior." I didn't know who Junior was at that time, but he pointed to some inscription on the 6 or 7 books that he came in here with, and he said "Junior is my boy." And then we had a further conversation. He said at the same time that a good deal of his music was out of print and that had to revise some of it. He was in a bad way. It was before his success in The Gay Nineties. Vaudeville had broken him down.

Q. Was there any specific mention made of the musical composition "I Wonder Who's Kissing Her Now"? A. No. That was in the books.

Q. Did he inform you at that time that he had any agreement with the widow of Charles K. Harris or that he had made an agreement with Charles K. Harris concerning the renewal of "I Wonder Who's Kissing Her Now"? A. He did not, and I asked him specifically "Have you made any renewals on any of these numbers in these books" and he positively said "No."

Q. When you asked whether he had many any renewals, do you remember whether you referred to compositions the renewals of which already had accrued, or merely compositions where the renewals would not accrue for some time? A. Naturally, I referred only to any which might have been in the renewal stage or close to it.

Q. So that you didn't make any inquiries as to whether he had made any arrangements for the renewal copyright of compositions not yet due for renewal? A. I asked him particularly whether he had made any arrangements anywhere for any of the renewals with any of the publishers.

Q. But didn't I understand you to say that you only referred to musical compositions which were already in the renewal period? A. That is true. I didn't know what they were.

Q. Then you didn't ask him if he had made any arrangements with respect to musical compositions in their original term? A. I referred particularly to renewals because that was on his mind. He knew that he could not give me anything that was not in the renewal period.

Q. Mr. Marks, you have just testified that you could not have any dealings with respect to musical compositions in their original terms. What do you mean by that? A. I mean to say that I was not interested in it. I can't talk about it. It got to be a custom in the trade.

Q. When you say it got to be the custom in the trade, you mean that at that time it was customary to take assignments of the right to renew a copyright prior to the date of the accrual of that copyright—that is, prior to the 28th year? A. Well, they made preliminary contracts with the understanding that at the proper time there would be a further contract.

Q. You knew that on that day, June 6, 1933, the composition "I Wonder Who's Kissing Her Now" was still in its original term? A. No I didn't. I couldn't tell.

Q. Then it was included in this agreement even though you didn't know definitely that it was in the original term? A. I didn't make the agreement. My brother probably had further conversations with him and made the agreement. He makes all agreements. I adjust the matter beforehand and pass it on to him.

Q. So that all of the negotiations were conducted by you, and your brother's task was to reduce the understanding to writing? A. No. That isn't so. My brother has just as much authority, as he is the copyright authority in the firm.

Q. Then you want it to appear in the record that on June 6, 1933, when your company, Edward B. Marks Music Corporation entered into this agreement which I have shown you, you did not know definitely that this musical composition "I Wonder Who's Kissing Her Now" was still in its original term. A. No, I didn't.

Q. Did you endeavor to communicate with Mrs. Harris or anybody at the office of Charles K. Harris to ascertain whether they had any agreements with respect to the renewal rights in this musical composition? A. No, I didn't.

Q. But you did testify, did you not, that you knew it was the custom at that time to take the so-called preliminary agreements with respect to renewals—agreements to assign, when the renewal copyrights accrued? A. It was the custom in the trade, unfortunately.

Q. As a matter of fact, this agreement which you entered into with Howard on June 6, 1933 was entered into pursuant or in accordance with that custom? A. No. It was entered into pursuant to his desire to get something out of his music, and to help. The same thing was happening not only with our firm, but with most of the firms. It was an accepted fact that somehow or other, when people came to you and they asked you to make an arrangement for a re-copyright, you talked it over with them,

Sometimes it was within the year. You didn't exactly look into every single thing.

Q. I note that in your answer you mentioned the word "recopyright". Do you mean "renewal copyright"? A. Renewal. Yes.

Q. Did you ask your brother or anybody connected with Edward B. Marks Music Corporation to contact the Charles K. Harris office in an effort to ascertain whether they had made any preliminary agreement? A. No, because Howard said he was absolutely through with Harris.

Q. Speaking of this custom which you said was prevalent at that time, didn't it occur to you that it was possible that Mrs. Harris had obtained a preliminary agreement from Howard? A. I pinned Joe Howard down to that. I asked him whether he had ever considered any renewals with anybody else, and that if he had, I couldn't touch it.

Q. At or about that time—that is, June, 1933, and even prior to that time, you used a standard form, didn't you? I don't refer to this musical composition. I mean in your general business dealings with composers? A. Yes. We had a form of agreement done up by Julius Henry Cohen—now attorney for the Port of New York.

Q. Those agreements were ordinary publication agreements, were they not? A. They were our royalty contracts, but we were very careful to see that they protected us as well as the writers.

Q. And in that general form of agreement you covered the first 28 years of copyright, didn't you?

(Mr. Garmaize) If you are talking about any particular agreement, show it to Mr. Marks and he will be able to tell you. How can he remember?

(Mr. Wattenberg withdraws question)

Q. I show you a photostatic copy of an agreement dated the 18th day of April, 1932 between Edward B. Marks,

composing the Edward B. Marks Music Co. and Frank Abbott, author; and J. Rosemond Johnson, composer, covering two musical compositions entitled "You're Welcome" and "Mississippi River"——

(Mr. Garmaize) I object to this. What relevancy has it got to the matter here? Unless you really show me the relevancy, I am going to tell Mr. Marks not to answer.

(Mr. Wattenberg withdraws question)

Q. Mr. Marks, will you tell us whether or not it was your custom in acquiring musical compositions to acquire the renewal rights to as great an extent as possible? A. No it was not. Just to the contrary, as few as possible, and our record carries it out. We keep away from it and I can prove it by men in the industry. They have taken away 20 times as many from us as we have ever taken, and we only take them when they bring them to us.

(Mr. Garmaize) I must object to this. It does not specify to any particular time. These compositions were published in 1909. We are now in 1941.

Q. In or about the year 1933 or 1932, were you soliciting renewal copyrights of the musical compositions which you were then publishing in their original term? A. We always speak to our writers in time, yes—our own writers. We consider Joe Howard one of our own writers. We published for him in 1897. The records show that, and he always published with us practically exclusively until the Harris regime. We never worried about that and it was all right.

Q. Isn't it a fact, Mr. Marks, that Charles K. Harris was the publisher of several hundred musical compositions the music of which was composed by Joseph E. Howard? A. It is, yes.

Q. From the time that he started in music? A. From the time that he started in musical shows.

Q. And that would be in approximately what year? A. I couldn't exactly say. Long after we had him as a writer.

Q. But this agreement between your company and Joseph Howard dated June 6, 1933 includes several hundred musical compositions? A. I am telling you that he had 7 books full. I don't know whether the names were all written down or not. I don't remember looking at this agreement in a long time. They were copied right from the books as I told you.

Q. I would like to ask you to look at those schedules annexed to that agreement and tell us whether you know what proportion of those musical compositions were published by Charles K. Harris—in their original term of copyright, of course. A. I couldn't tell you the proportion, but I would say, to be fair, the greater proportion.

Q. And you knew, did you not, at the time you entered into this agreement, that the greater proportion of these musical compositions were published by Harris? A. I had the books in my hands with all the copies in there.

Q. How long after your company executed this agreement of June 6, 1933, did you see Mr. Howard? A. He constantly came in. He came in to see what progress we were making. We had promised him new arrangements of certain numbers. We had gone through them with him, and when they were ready we showed them to him. Then he got his engagement some time after that in the Gay Nineties, and from then on, he went sailing.

Q. Mr. Marks, did Mr. Howard ever tell you that he had made an agreement with Harris with respect to renewal copyrights? A. No he didn't. He denied ever having made a renewal with anybody. I wouldn't have touched it at all if he had not positively assured me. It all reverted to him, he said.

Q. When did you first find out that Mrs. Harris had in her possession an agreement executed by Joseph Howard with respect to the renewal copyright? A. I haven't found that out yet. Nobody has ever told me that. I can't believe it.

Q. Did Mr. Howard ever come to your office and tell you that he had made a prior deal with Mrs. Harris or with Charles K. Harris and that he had forgotten all about it? A. He didn't tell me that he had made any deal. He said she claimed something, but that was recently, and she had no right to his numbers.

Q. Last week Mr. Howard testified that within a couple of weeks after he entered into an agreement with you on June 6, 1933, he came to you and told you that he had found out that he had made a prior agreement with Mrs. Harris— A. He said that Mrs. Harris claimed she had a contract of some sort and I said "Get a copy of our contract and take it to her and let her produce hers."

Q. Would you say Mr. Howard was correct insofar as the time was concerned—that this occurred a couple of weeks after he entered into this agreement of June 6? A. No, I would say it was quite a little while after that.

Q. Would you say it was 6 months or a year or 2 months after? Just give me some idea, if you can. A. I couldn't really give you an idea. I can't remember whether that was the '33 contract or the subsequent contract. It may have been the subsequent contract, and then he came in and told me about some paper that she claimed—whichever contract it was, the '33 or the '36 contract.

Q. Did you ever have any conversations with Mrs. Harris during the years 1934 or '35 in connection with the Howard compositions? A. No sir.

Q. Did you have any conversations with Mrs. Harris or Miss Monroe prior to 1936? A. I had a conversation with

Mrs. Harris and Miss Monroe right after Mr. Harris died. I would say about 6 months after. My reason for that was that we were handling Charles K. Harris publications on the road as he had no salesmen, and at his suggestion and from what I heard at ASCAP and elsewhere, they weren't getting anywhere with their business after Mr. Harris died, so I suggested, and I believe I suggested it through our sales manager, that if she made us her general sales agent instead of only part of the catalog that we were carrying, that we thought we could be useful to her in getting mechanicals—records, that is, and in better sales. We still sell for her to this day, in a small way.

Q. And that was approximately 6 months after Mr. Harris had passed away? A. Yes, and she was very receptive, but apparently Miss Monroe did not like the idea, so I dropped it.

Q. And you had no conversations with Mrs. Harris or Miss Monroe after that time and prior to March of 1936? A. I had only the talk with Mrs. Harris and Miss Monroe in John Paine's office. There were present Mrs. Harris, Miss Monroe, John Paine, Jerry Vogel and myself, and Mr. Wattenberg, Sr. in an endeavor to straighten this matter out.

Q. Can you fix the approximate date of that meeting? A. Oh, it is not so long ago. Several years ago—2 or 3 years.

Q. I show you a document marked Assignment of Copyright, mentioning a musical composition called "I Wonder Who's Kissing Her Now" and dated March 3, 1936, and I ask you whether you recognize that document as the assignment which your company obtained from Mr. Howard. A. Why I expect so. That looks like the proper signature. That looks like the signature of Mr. Sheffler.

Q. Do you remember the circumstances under which this assignment was executed and delivered to you? A. I don't

remember the circumstances, but I expect they were the usual procedure.

Q. At the time this assignment was executed and delivered to you, did you know that Mrs. Harris made any claim to the renewal copyright of this musical composition? A. No, I didn't.

Q. So that the question of renewal copyright in the musical composition "I Wonder Who's Kissing Her Now" was never discussed and never brought up prior to 1936? A. I discussed it with Joe Howard.

Q. And at no time during those discussions did he disclose the fact that Mrs. Harris made a claim to the renewal? A. Not to any renewal right.

Q. Did he tell you that Mrs. Harris made any claim to this musical composition? A. He told me that she had some paper that she made a claim on, and I asked that she produce it. I don't believe he saw it himself. He said he couldn't get it from her.

Q. So that prior to the delivery of this assignment on March 3, 1936, Mr. Howard did tell you that Mrs. Harris made some claim.

(Mr. Garmaize) I object to the words "some claim." That is too broad.

(Mr. Wattenberg withdraws question.)

Q. So that at some time prior to the execution and delivery to your company of the assignment dated March 3, 1936, Mr. Howard did inform you that Mrs. Harris claimed to have some paper with respect to the renewal copyright? A. That can only be determined by my answer to him, which was "Here is our contract, or get yourself a copy of our contract and take it to her and ask her to produce the contract she has". She still has it. She never gave it back to him. That is the only way we can determine it. I don't know whether it was the first

or the second. The moment I heard she claimed to have any paper, I sent her our contract, and she never returned it, and that is the contract I asked she give me in return, which she never did.

Q. So that at the time you gave Mr. Howard a copy of your agreement with him to give to Mrs. Harris, you had been informed and did know that she claimed to have a prior agreement with Howard? A. She had some paper. Some claim. I didn't know what her claim was.

Q. You knew that she was making some claim. A. I said so.

(Mr. Garmaize) I object to the form of the question. I don't like the word "some".

Question withdrawn.

Q. You received two documents from Mr. Howard, did you not? One dated June 6, 1933 and the other dated March 3, 1936. A. That is right.

Q. And you state that you were unable to recall whether it was prior to the first agreement or the second agreement that Mr. Howard advised you that Mrs. Harris claimed to have a prior paper? A. It was not prior. It was after we had our agreement, because otherwise, I could not have sent her a copy of ours.

Q. Do you mean this agreement dated June 6, 1933? A. Our agreement—one or the other.

Q. Do you refer to the assignment of copyright dated March 3, 1936 as an agreement? A. I do. I consider one a preliminary agreement and the other the perfection of the agreement.

Q. Aren't you able to state when Mr. Howard came to you and told you? A. No. When he told me I immediately sent him in to get a copy of our agreement and asked him to take it to Mrs. Harris and ask them to please show us theirs.

Q. But you don't remember what agreement of yours you referred to? A. I wouldn't want to state unless I am sure.

Q. Isn't it possible that this conversation with Howard came after the agreement of June 6, 1933, but before the assignment of March 3, 1936? A. It might have been. Yes.

Q. You can't state definitely? A. I can't. I couldn't.

Q. Did you ever visit the office of Charles K. Harris, Music Publisher, with respect to the question of renewal copyright in the Howard numbers? A. I didn't.

Q. You never had any conference about the question of renewal with Mrs. Harris other than the one in Mr. Paine's office? A. Only in Mr. Paine's office.

EDWARD B. MARKS

(Duly sworn)

Defendant's Notice of Appeal

(236)

UNITED STATES DISTRICT COURT

SOUTHERN DISTRICT OF NEW YORK

Civil Action File No. 27-179

EDWARD B. MARKS MUSIC CORPORATION,

Plaintiff,

—against—

CHARLES K. HARRIS MUSIC PUBLISHING CO., INC.,

Defendant.

Notice is hereby given that, Charles K. Harris Music Publishing Co., Inc., defendant above named, hereby appeals to the United States Court of Appeals for the Second Circuit, from so much of the Amended Judgment entered in this action on February 3, 1956 as orders, adjudges and decrees that plaintiff has at all times been, and now is, the sole owner and proprietor of the interest through Joseph E. Howard in the renewal copyright of each of the musical compositions listed in "Group 3", subdivision "(c)" of paragraph "1" of said Amended Judgment, and awards plaintiff injunctive relief with respect to said musical compositions, and adjudges that all purported assignments made by Joseph E. Howard to defendant's assignor, Cora L. Harris, doing business as Chas. K. Harris Music Publisher, and the further assignments thereof to the defendant of the interest of Joseph E. Howard in the renewal copyrights of said musical compositions, and each and every recording and entry thereof in the Copyright Office, and all certificates of every such record and all certified copies thereof, are invalid,

null and void, and directs the Register of Copyrights to revoke and cancel the same and make appropriate notations of such revocation and cancellation upon the records of the Copyright Office, as more particularly set forth and provided in paragraphs numbered "4", "6" and "8" of said Amended Judgment, and from each and every part of said paragraphs of said Amended Judgment which relate to the musical compositions listed in "Group 3" of subdivision "(c)" of paragraph "1" of said Amended Judgment.

Dated, New York, New York,
February 24th, 1956.

s ARTHUR L. FISHBEIN
Arthur L. Fishbein
Attorney for Defendant
67 West 44th Street
New York 36, N. Y.

To:

Clerk of United States District Court
Southern District of New York

Julian T. Abeles, Esq.
Attorney for Plaintiff
745 Fifth Avenue
New York City

No. 220

Argued by
JULIAN T. ABELES

Office - Supreme Court, U.S.
FILED
JUL 25 1958
JOHN T. FEY, Clerk

United States Court of Appeals
FOR THE SECOND CIRCUIT

EDWARD B. MARKS MUSIC CORPORATION,
Plaintiff-Appellant-Appellee,

against

CHARLES K. HARRIS MUSIC PUBLISHING CO., INC.,
Defendant-Appellee-Appellant.

PLAINTIFF-APPELLANT-APPELLEE'S SUPPLEMENTAL APPENDIX

JULIAN T. ABELES,
Attorney for Appellant

INDEX

PAGE

Excerpts From Testimony 136a

Form of Separate Assignments From Howard to Plaintiff 140a

Answer 141a

Agreed Statement of Facts 148a

Separate Answer Served Pursuant to Agreed Statement 158a

Excerpts From Testimony.

(Record, pages 3-8.)

Mr. Abeles: If it please the Court, the original agreement between the plaintiff and Joseph P. Howard, dated June 6, 1933, is annexed to the agreed statement of facts. I don't have to re-offer that. However, I will offer the separate assignment subsequently executed after the respective renewals accrued. The first one, sir, is dated March 3, 1936, and I offer that together with certificate of a notary affixed, showing recording on March 4, 1936.

Mr. Okun: Just a moment.

Mr. Abeles: These are filed in order. The one date will follow the other. I have picked up the earliest dates first. Then—

Mr. Okun: The first one was March 3, 1936?

Mr. Abeles: Yes; they will be taken in order and we will have no trouble.

(Marked Plaintiff's Exhibit 5.)

Mr. Abeles: I would like to point out the assignments refer to the agreement dated June 6, 1933; state they were executed pursuant to that agreement.

I now offer in evidence assignment dated November 3, 1937, together with Register's certificate affixed, showing recording on November 4, 1937.

Mr. Okun: No objection.

(Marked Plaintiff's Exhibit 6.)

Mr. Abeles: I will now offer assignment dated May 9, 1944, together with Register's certificate affixed, showing recording on May 10, 1944.

(Marked Plaintiff's Exhibit 7.)

Excerpts From Testimony.

Mr. Abeles: I now offer assignment dated June 15, 1944, together with Register's certificate affixed, showing recording June 16, 1944.

Mr. Okun: No objection.

(Marked Plaintiff's Exhibit 8.)

Mr. Abeles: I now offer assignment dated February 20, 1945, together with Register's certificate, showing recording on February 21, 1945.

Mr. Okun: No objection.

(Marked Plaintiff's Exhibit 9.)

Mr. Abeles: I offer assignment dated May 10, 1946, together with Register's certificate affixed, showing recording on May 13, 1946.

Mr. Okun: No objection.

(Marked Plaintiff's Exhibit 10.)

Mr. Abeles: I respectfully offer in evidence a communication from defendant to plaintiff dated June 11, 1943, together with copy of the response of June 18, 1943. I assume we can put the copy in?

Mr. Okun: Yes, no objection to that.

(A pause.)

Mr. Okun: No objection.

(Marked Plaintiff's Exhibit 11.)

Mr. Abeles: A witness was to be present; is not. The only purpose of the witness is to show payment of $3,000 to Joseph P. Howard, the writer in question, pursuant to the particular agreements and assignments as an advance against royalties.

The Court: Is that in dispute in this case?

Mr. Okun: I don't know how—I would like to know how much they paid and in connection with which songs this was paid.

Mr. Abeles: In connection with all the songs.

Mr. Okun: I would like to know whether they have it broken down as to one song or three songs or four songs.

Mr. Abeles: It is not broken down. It was as to all the songs.

Mr. Okun: Were they royalties or advances?

Mr. Abeles: Advances.

Mr. Okun: May we suspend that, in case the witness comes. We can get the man while I am offering the documents.

Mr. Abeles: Here are the figures, if you want them, and the dates paid.

(Discussion between counsel off the record.)

Mr. Okun: I will take Mr. Abeles' statement that the witness wouldn't be able to testify differently.

Mr. Abeles: That is right.

The Court: Put your statement on the record. It is agreed that if he was called—what is his name?—he would testify—

Mr. Abeles: Lawrence Fishbein.

The Court: —of what company?

Mr. Abeles: He is with the plaintiff. He is the accountant. I imagine that is what he is, accountant for the plaintiff.

The Court: He would testify that there was paid to?

Mr. Abeles: Joseph P. Howard, the writer, who executed these various documents that I have offered in evidence, and also the document of June 6th, 1933. The witness would testify that this sum of $3,000 was paid as an advance, total sum of $3,000 was paid as an advance

against royalties in respect of all the compositions comprehended by the various documents.

Mr. Okun: And that he would not be able to testify as to which particular songs?

Mr. Abeles: How can we reach an agreement? It refers to dozens of songs, and I am sure any particular ones—

Mr. Okun: Would it also appear that these payments ran from the date of the agreement to July 21, 1952?

Mr. Abeles: There is no particular agreement.

Mr. Okun: No, but payments were made during the period—

Mr. Abeles: That is right.

Mr. Okun: (Continuing)—June 6, 1933, to July 21, 1952.

Mr. Abeles: That is right, sir.

The Court: Are you willing to make that concession?

Mr. Okun: Yes, sir.

Mr. Abeles: Yes.

Mr. Okun: I will accept the statement.

Form of Separate Assignments From Howard to Plaintiff.

(Plaintiff's Exhibits 5-10, Record Pages 3-5.).

KNOW ALL MEN BY THESES PRESENTS, that for and in consideration of the sum of One Dollar ($1.00) lawful money of the United States of America to me in hand paid at or before the signing and sealing of these presents, receipt of which is hereby acknowledged and for other valuable consideration, I, JOSEPH E. HOWARD, residing at 40 Monroe St., in the Borough of Manhattan, in the City, County and State of New York, have sold, assigned, set over, transferred, conveyed and released and by these presents do hereby sell, assign, set over, transfer, convey and release to and unto the EDWARD B. MARKS MUSIC CORPORATION, a Corporation organized and existing under the laws of the State of New York and having its principal office and place of business in the R.C.A. Building, #1250 Sixth Ave., in the Borough of Manhattan, City, County and State of New York, its successors and legal assigns, the renewal copyrights of the musical compositions entitled,

(compositions listed)

to have and to hold the same to and unto the said EDWARD B. MARKS MUSIC CORPORATION, Its successors and legal assigns, together with any and all other rights of any kind, character and description pertaining in and to the said musical composition now known or which may hereafter come into existence.

It is further understood and agreed that this assignment is made subject to the terms, conditions and covenants in the agreement dated June 6, 1933, between said EDWARD B. MARKS MUSIC CORPORATION and myself.

Answer.

(Record, pages 52-57)

UNITED STATES DISTRICT COURT,

SOUTHERN DISTRICT OF NEW YORK.

EDWARD B. MARKS MUSIC CORPORATION,

Plaintiff,

against

CHAS. K. HARRIS MUSIC PUBLISHING CO., INC.,

Defendant.

The defendant, answering plaintiff's complaint herein, by Arthur L. Fishbein, its attorney:

FIRST: Denies each and every allegation contained in Paragraphs numbered "2", "8", "10", "11" "12", "19", "21", "22", "23", "30", "32", "33", "34", "41", "43", "44", "45", "52", "54", "55" and "56" of the complaint.

SECOND: Denies each and every allegation contained in Paragraph numbered "1" of the complaint, except that defendant admits that it is a corporation incorporated under the laws of the State of New Jersey.

THIRD: Denies each and every allegation contained in Paragraphs numbered "3", "14", "25", "36" and "47" of the complaint, except that the defendant admits that one, Joseph E. Howard, either alone or in collaboration with one or more other writers, created and wrote certain original musical compositions, as described in the bill of complaint.

Answer.

FOURTH: Denies each and every allegation contained in Paragraphs numbered "4", "15", "26", "37" and "48" of the complaint, except that defendant admits that its predecessors in interest duly copyrighted said musical compositions by duly complying in all respects with the United States Copyright Law and all other laws governing copyright, and secured copyright and the exclusive rights and privileges in and to the copyrights of said musical compositions, and received from the Register of Copyrights a certificate of the registration of the claim to each of said copyrights.

FIFTH: Denies each and every allegation contained in Paragraphs numbered "5", "16", "27", "38" and "49" of the complaint, except that defendant admits that during the year prior to the expiration of each said copyright, said Joseph E. Howard caused the said copyrights to be renewed and such renewals registered in his name in accordance with the Copyright Act of March 4th, 1909.

SIXTH: Denies each and every allegation contained in Paragraphs numbered "6", "17", "28", "39" and "50" of the complaint, except that defendant admits that on or about the 6th day of June, 1933, the said Joseph E. Howard entered into an agreement with plaintiff.

SEVENTH: Denies each and every allegation contained in Paragraphs numbered "7", "18", "29", "40" and "51" of the complaint, except that defendant admits that on or about the 3rd day of March, 1936, the said Joseph E. Howard executed a document purporting to be an assignment of the renewal copyrights in said compositions, to plaintiff.

EIGHTH: Denies each and every allegation contained in Paragraphs numbered "9", "20", "31", "42" and "53"

of the complaint except that the defendant admits that it acquired, by assignment from said Joseph E. Howard, his interest in the renewal copyrights in the said musical compositions, so that plaintiff has no right or interest therein or thereto.

AS AND FOR A FIRST, SEPARATE AND DISTINCT DEFENSE, UPON INFORMATION AND BELIEF, DEFENDANT ALLEGES:

NINTH: That at all times hereinafter mentioned, prior to his death in the year 1930, Charles K. Harris was engaged in the business of music publishing; that during the year 1932, after the death of said Charles K. Harris, Cora L. Harris being his widow, carried on and continued the music publishing business of said decedent, and in accordance with law, caused to be filed in the office of the Clerk of the County of New York, a certificate certifying to her doing business under the name Charles K. Harris, successor in interest; and that from the 30th day of June, 1932, to the 20th day of May, 1943, Cora L. Harris has conducted said business under said name, in the City, County and State of New York.

TENTH: That on or about the 20th day of May, 1943, the said Cora L. Harris, individually and as doing business under the name Charles K. Harris, successor in interest, assigned, transferred and set over unto the defendant all of the assets of the business then being conducted by her, together with each and every musical work, published and unpublished, and the copyright thereof, and all of her right, title and interest in and to the said musical works, of whatsoever kind and nature, which assignment and transfer included each and every musical work composed by Joseph E. Howard, and mentioned and described in the bill of complaint; and that since that time the defend-

ant has been conducting said business and is the owner of said rights.

ELEVENTH: That prior to the year 1917, Joseph E. Howard, who then was and ever since has been a citizen of the United States, either alone or in collaboration with one or more other writers, who then were and ever since have been citizens of the United States, created and wrote certain original musical compositions, as described and listed in Exhibits "A", "B", "C" and "D", annexed to the bill of complaint.

TWELFTH: That prior to the year 1917, the said Joseph E. Howard, together with his collaborator or collaborators, duly assigned such musical compositions to Charles K. Harris, predecessor in interest of the defendant, together with the right to secure copyright therein and all rights therein and thereto.

THIRTEENTH: That thereafter the said Charles K. Harris, predecessor in interest of the defendant, duly copyrighted said musical compositions by duly complying in all respects with the United States Copyright Act then in force, and all other laws governing copyright and secured the copyrights and all the exclusive rights and privileges therein of said musical compositions, and received from the Register of Copyrights certificates of the registration of the claim to each of said copyrights.

FOURTEENTH: That on or about the 2nd day of December, 1916, the said Joseph E. Howard, for a valuable consideration, did execute and deliver a written document in which he specifically bargained, sold, granted and conveyed unto the aforesaid Charles K. Harris, deceased, and his successors, administrators and assigns, all his right, title and interest in and to the aforesaid musical compositions

and in the copyrights and renewal copyrights thereof. That the defendant begs leave to refer to said document on the trial of this action.

FIFTEENTH: That plaintiff had full and complete knowledge that the predecessors in interest of the defendant had acquired all the right, title and interest of said Joseph E. Howard in and to the renewal copyrights of the aforesaid musical compositions prior to the alleged agreement between plaintiff and said Joseph E. Howard dated the 6th day of June, 1933.

SIXTEENTH: That thereafter and within the required time, Joseph E. Howard, as composer of said compositions, and pursuant to the provisions of the United States Copyright Act, made application to the United States Copyright Office for the renewal of the copyrights in the aforesaid musical compositions, for a further term of twenty-eight (28) years, and pursuant to the said applications, the said copyright renewals with respect to the aforesaid musical compositions, were entered in the United States Copyright Office in the name of Joseph E. Howard.

SEVENTEENTH: That from time to time, and pursuant to the aforementioned document dated December 2nd, 1916, the said Joseph E. Howard, for a valuable consideration, did execute and deliver to Cora L. Harris, predecessor in interest of the defendant, divers assignments of many of such renewal copyrights, as well as assignments in blank, with authority and permission to insert titles therein of such renewal copyrights for the purpose of recording same, and that thereafter, from time to time, said Cora L. Harris, defendant's predecessor in interest, and defendant caused certain of such assignments to be recorded in the office of the Register of Copyrights.

EIGHTEENTH: That by reason of the foregoing, defendant has been since the date of the accrual of said renewal copyrights, and now is the lawful owner of all right, title and interest of the said Joseph E. Howard in and to renewal copyrights of the aforesaid musical compositions and all rights therein, thereto and thereunder, including but not limited to the exclusive right to print, reprint, publish, copy, vend and perform the aforesaid musical compositions.

AS AND FOR A SECOND, SEPARATE AND DISTINCT DEFENSE, DEFENDANT ALLEGES:

NINETEENTH: Repeats and realleges each and every allegation contained in paragraphs of this answer designated "NINTH" to "EIGHTEENTH", both inclusive, with the same force and effect as if here set forth.

TWENTIETH: Upon information and belief, that notwithstanding the foregoing, plaintiff with full knowledge that the predecessors in interest of the defendant, for a valuable consideration, had acquired from Joseph E. Howard, all his right, title and interest in and to the aforementioned musical compositions, and in and to the copyrights and renewal copyrights thereof, and with full knowledge of the rights of defendant's predecessors in interest, and in wilfull disregard of such rights, did during the year 1933 and thereafter wilfully induce the said Joseph E. Howard to enter into certain written agreements purporting to assign the interest of said Joseph E. Howard in and to the said renewal copyrights to plaintiff, and that having unlawfully obtained such instruments from said Joseph E. Howard in such manner, plaintiff thereafter and with full knowledge of the rights of defendant's predecessors in interest and defendant, and in violation thereof, and

without the consent, permission or authority of the defendant or its predecessors in interest, did print, publish and sell certain of the aforesaid musical compositions and did license the use thereof by various methods and in various forms and places, and threatens to continue so to do.

TWENTY-FIRST: By reason thereof, plaintiff has seriously hampered and interfered with defendant in the exercising and licensing of its rights under the interest of Joseph E. Howard, to said renewal copyrights in the aforesaid musical compositions, and has prevented defendant from exercising and licensing such rights, and from realizing benefits which would otherwise inure to defendant therefrom.

TWENTY-SECOND: That by reason thereof, defendant has been and will continue to be irreparably damaged.

TWENTY-THIRD: That the defendant has no adequate remedy at law.

WHEREFORE, defendant demands judgment against the plaintiff:

1. That the complaint be dismissed.

2. That this Court declare that defendant is the sole owner and proprietor of the interest of Joseph E. Howard in the renewal copyrights in and to the aforesaid musical compositions, and that the plaintiff never acquired and has no right or interest therein.

3. That this Court, during the pendency of this action and permanently, enjoin and restrain plaintiff, its officers, agents, servants and employees, and all those acting through them or any of them, from exercising any rights

under the interest of Joseph E. Howard in the renewal copyrights of the aforesaid musical compositions, and from representing or asserting that plaintiff is possessed of any rights thereunder.

4. That defendant recover its costs.

5. That upon application therefor, defendant be granted such other and further relief as to the Court may seem necessary or proper.

Agreed Statement of Facts.

(Record pages 97-129)

The parties hereto, for the purpose of this action only, hereby stipulate and agree to the following facts, and that a pre-trial order may be made and entered herein to such effect:

1. Jurisdiction is founded on diversity of citizenship and amount, plaintiff being a corporation incorporated under the laws of the State of New York, defendant being a corporation incorporated under the laws of the State of New Jersey, and the matter in controversy exceeding, exclusive of interest and costs, the sum of three thousand dollars.

2. The plaintiff and defendant are both music publishers. Both parties claim the proprietorship, through one Joseph E. Howard of his interest as co-writer, in the United States renewal copyrights in certain musical compositions. The prayer for relief of each of the parties is that said party be declared the sole owner and proprietor of such interest, that the other party be enjoined and restrained from claiming or exercising any rights thereunder

or thereto, and for such further relief as may be necessary or proper.

3. The five causes of actions in the complaint involve the compositions listed on the respective schedules annexed thereto, viz:

First cause of action—"Exhibit A" ("Schedule 1" annexed hereto)

Second cause of action—"Exhibit B" ("Schedule 2" annexed hereto)

Third cause of action—"Exhibit C" ("Schedule 3" annexed hereto)

Fourth cause of action—"Exhibit D" ("Schedule 4" annexed hereto)

Fifth cause of action—"Exhibit E" ("Schedule 5" annexed hereto)

4. The date "November 4, 1944" in paragraph "18" of the complaint shall be deemed corrected to read "November 4, 1937." The complaint shall be deemed amended to comprehend the additional compositions listed on "Schedule 6", "Schedule 7" and "Schedule 8" annexed, with the same claim asserted and the same prayer for relief demanded by the plaintiff, in respect to the compositions listed in the schedules annexed to the complaint. Paragraph "Eleventh" of the answer shall be deemed amended to include the letter "E" in the last line thereof, and defendant shall have fifteen (15) days from the date hereof to serve a separate answer as to the amendment of the complaint comprehended in the preceding sentence.

5. Plaintiff's claim to the compositions listed on "Schedule 1", "Schedule 2", "Schedule 3", "Schedule 6" and "Schedule 7" annexed is asserted under a purported

agreement (annexed hereto as "Exhibit 1") between plaintiff and said Joseph E. Howard, dated and executed on or about June 6, 1933 and recorded in the Copyright Office on April 30, 1934 (said compositions being listed in "Exhibit A" annexed to said agreement), and under purported separate instruments of assignments executed by said Joseph E. Howard on or about and recorded in the Copyright Office on the respective dates indicated in said annexed schedules; each such purported separate assignment having been allegedly made pursuant to said purported agreement dated June 6, 1933.

6. Plaintiff's claim to the compositions listed on "Schedule 4", "Schedule 5" and "Schedule 8" annexed is asserted under purported instruments of assignment executed by said Joseph E. Howard on or about and recorded in the Copyright Office on the respective dates indicated in said annexed schedules; each such purported separate assignment reciting that it is "made subject to all the terms, conditions and covenants in the agreement dated June 6, 1933."

7. Defendant makes claim only to those of the compositions listed on the annexed schedules as to which defendant is indicated as being the "Original Publisher". Defendant's claim is asserted under a purported document (annexed hereto as "Exhibit 2") dated and executed by said Joseph E. Howard on or about December 2, 1916, and unrecorded, and (except as indicated on the annexed schedules by the word "None") under purported separate instruments of assignment executed by said Joseph E. Howard on or about April 28, 1936 (allegedly made pursuant to the said purported document dated December 2, 1916) and recorded in the Copyright Office on the respective dates indicated in the annexed schedules; a number of such purported separate instruments of assignment having been executed by said Joseph E. Howard in blank, with the

alleged authority and permission of defendant to insert the titles thereon for the purpose of subsequently recording the same.

8. In respect to the compositions listed in "Schedule 1" annexed:

(a) Each of said compositions was duly copyrighted on the "Original Copyright Date" indicated therein.

(b) The claim to copyright in each of said compositions was duly registered in the Copyright Office under the "Entry Number" indicated therein.

(c) The application for the renewal and extension of the United States copyright in each of said compositions was duly made and registered in the United States Copyright Office on the "Renewal Copyright Date" and under the "Entry Number" indicated therein.

(d) Each of said compositions is listed in "Exhibit 1" annexed and in the purported separate instruments of assignment to plaintiff indicated therein.

(e) Each of said compositions is listed in the purported separate instruments of assignment to defendant indicated therein.

(f) Each of said compositions was published during the original copyright term by the "Original Publisher" indicated therein.

9. In respect to the compositions listed in "Schedule 2" annexed:

(a) Each of said compositions was duly copyrighted on the "Original Copyright Date" indicated therein.

(b) The claim to copyright in each of said compositions was duly registered in the Copyright Office under the "Entry Number" indicated therein.

(c) The application for the renewal and extension of the United States copyright in each of said compositions was duly made and registered in the United States Copyright Office on the "Renewal Copyright Date" and under the "Entry Number" indicated therein.

(d) Each of said compositions is listed in "Exhibit 1" annexed and in the purported separate instruments of assignment to plaintiff indicated therein.

(e) Each of said compositions is listed in the purported separate instruments of assignment to defendant indicated therein.

(f) Each of said compositions was published during the original copyright term by the "Original Publisher" indicated therein.

10. In respect to the compositions listed in "Schedule 3" annexed:

(a) Each of said compositions was duly copyrighted on the "Original Copyright Date" indicated therein.

(b) The claim to copyright in each of said compositions was duly registered in the Copyright Office under the "Entry Number" indicated therein.

(c) The application for the renewal and extension of the United States copyright in each of said compositions was duly made and registered in the United States Copyright Office on the "Renewal Copyright Date," and under the "Entry Number" indicated therein.

(d) Each of said compositions is listed in "Exhibit 1" annexed and in the purported separate instruments of assignment to plaintiff indicated therein.

(e) Each of said compositions is listed in the purported separate instruments of assignment to defendant indicated

therein; except where otherwise indicated by the word "None".

(f) Each of said compositions was published during the original copyright term by the "Original Publisher" indicated therein.

11. In respect to the compositions listed in "Schedule 4" annexed:

(a) Each of said compositions was duly copyrighted on the "Original Copyright Date" indicated therein.

(b) The claim to copyright in each of said compositions was duly registered in the Copyright Office under the "Entry Number" indicated therein.

(c) The application for the renewal and extension of the U. S. copyright in each of said compositions was duly made and registered in the United States Copyright Office on the "Renewal Copyright Date" and under the "Entry Number" indicated therein.

(d) Each of said compositions is listed in the purported instrument of assignment to plaintiff indicated therein.

(e) Each of said compositions is listed in the purported separate instruments of assignment to defendant indicated therein; except where otherwise indicated by the word "None".

(f) Each of said compositions was published during the original copyright term by the "Original Publisher" indicated therein.

12. In respect to the compositions listed in "Schedule 5" annexed:

(a) Each of said compositions was duly copyrighted on the "Original Copyright Date" indicated therein.

(b). The claim to copyright in each of said compositions was duly registered in the Copyright Office under the "Entry Number" indicated therein.

(c) The application for the renewal and extension of the United States copyright in each of said compositions was duly made and registered in the United States Copyright Office on the "Renewal Copyright Date" and under the "Entry Number".

(d) Each of said compositions is listed in the purported instrument of assignment to plaintiff indicated therein.

(e) Each of said compositions is listed in the purported separate instruments of assignment to defendant indicated therein.

(f) Each of said compositions was published during the original copyright term by the "Original Publisher" indicated therein.

13. In respect to the compositions listed in "Schedule C" annexed:

(a) Each of said compositions was duly copyrighted on the "Original Copyright Date" indicated therein.

(b) The claim to copyright in each of said compositions was duly registered in the Copyright Office under the "Entry Number" indicated therein.

(c) The application for the renewal and extension of the United States Copyright in each of said compositions was duly made and registered in the United States Copyright Office on the "Renewal Copyright Date" and under the "Entry Number" indicated therein.

(d) Each of said compositions is listed in "Exhibit 1" annexed and in the purported separate instruments of assignment to plaintiff indicated therein.

(e) Each of said compositions is listed in the purported separate instruments of assignment to defendant, except where otherwise indicated by the word "None".

(f) Each of said compositions was published during the original copyright term by the "Original Publisher" indicated therein.

14. In respect to the compositions listed in "Schedule 7" annexed:

(a) Each of said compositions was duly copyrighted on the "Original Copyright Date" indicated therein.

(b) The claim to copyright in each of said compositions was duly registered in the Copyright Office under the "Entry Number" indicated therein.

(c) The application for the renewal and extension of the United States copyright in each of said compositions was duly made and registered in the United States Copyright Office on the "Renewal Copyright Date" and under the "Entry Number" indicated therein.

(d) Each of said compositions is listed in "Exhibit 1" annexed and in the purported separate instruments of assignment to plaintiff indicated therein.

(e) Each of said compositions is listed in the purported separate instruments of assignment to defendant indicated therein.

(f) Each of said compositions was published during the original copyright term by the "Original Publisher" indicated therein.

15. In respect to the compositions listed in "Schedule 8" annexed:

(a) Each of said compositions was duly copyrighted on the "Original Copyright Date" indicated therein.

(b) The claim to copyright in each of said compositions was duly registered in the Copyright Office under the "Entry Number" indicated therein.

(c) The application for the renewal and extension of the United States copyright in each of said compositions was duly made and registered in the United States Copyright Office on the "Renewal Copyright Date" and under the "Entry Number" indicated therein.

(d) Each of said compositions is listed in the purported instrument of assignment to plaintiff indicated therein.

(e) Each of said compositions is listed in the purported separate instruments of assignment to defendant, except where otherwise indicated by the word "None".

(f) Each of said compositions was published during the original copyright term by the "Original Publisher" indicated therein.

16. Cora L. Harris is the widow of Charles K. Harris and is sole distributee under his last will and testament admitted to probate January 14, 1931.

17. Cora L. Harris, doing business as Chas. K. Harris—Music Publisher, executed a document dated May 20, 1943, which was recorded in the Copyright Office on May 22, 1943, in Book 510, at pages 154-161, whereby Cora L. Harris, individually and doing business as Chas. K. Harris—Music Publisher, purported to assign and transfer to Chas. K. Harris Music Publishing Co., Inc. whatever interest Mrs. Harris may have in the copyrights, and renewals therein, in and to the compositions listed in the schedules annexed to this stipulation, except the compositions entitled:

(20 titles listed.)

18. Cora L. Harris, doing business as Chas. K. Harris—Music Publisher and Cora L. Harris executed a

document dated May 20, 1943 which was recorded in the Copyright Office on May 22, 1943, in Book 510, at pages 162-170, whereby Cora L. Harris individually and doing business as Chas. K. Harris—Music Publisher purported to assign and transfer to Charles K. Harris Music Publishing Co., Inc. Mrs. Harris' interest in the copyrights and renewals therein, in and to the composition entitled "ON A LITTLE SIDE STREET".

19. Cora L. Harris, doing business as Chas. K. Harris—Music Publisher and Cora L. Harris executed a document dated April 27, 1943 whereby Cora L. Harris individually and doing business as Chas. K. Harris—Music Publisher purported to assign and transfer to Charles K. Harris Music Publishing Co., Inc. Mrs. Harris' interest in the copyrights and renewals in and to the musical compositions listed in Schedule 1 of Exhibit A annexed thereto, together with all renewal rights therein, and the interest of Mrs. Harris in any and all copyrights and renewals, both in unpublished and published musical compositions, whether registered in the Library of Congress, Washington, D. C., or not.

20. With respect to each composition listed in the schedules hereto annexed as to which Defendant is indicated as "original publisher", the claim to copyright for the original term was registered in the name of Chas. K. Harris.

21. The signatures of Joseph E. Howard and Cora L. Harris on the documents referred to in this stipulation are conceded to be genuine.

Dated, New York, N. Y., May 20, 1954.

JULIAN T. ABELES,
Attorney for Plaintiff.

ARTHUR L. FISHBEIN,
Attorney for Defendant.

(Schedules and exhibits annexed, record pages 108-129.)

Separate Answer Served Pursuant to Agreed Statement.

(Record pages 130, 131)

PLEASE TAKE NOTICE, that pursuant to paragraph "4" of the Agreed Statement of Facts and Stipulation dated May 20, 1954, the following is the defendant's Separate Answer to the amendment of the complaint provided for in said paragraph "4" of said stipulation:

1. The defendant hereby incorporates by reference, as though herein fully set forth, its present answer, including the denials, defenses and counterclaims, as amended by paragraph "4" of said stipulation.

FOR A THIRD SEPARATE AND DISTINCT DEFENSE, THE DEFENDANT ALLEGES:

2. That as to so much of the amendment of the complaint as is predicated upon any alleged acts of the defendant which occurred prior to May 20, 1951, the cause of action thereon did not accrue within three (3) years next preceding the commencement of this action with respect thereto, and by reason thereof, plaintiff is barred from recovering thereon.

FOR A FOURTH SEPARATE AND DISTINCT DEFENSE, THE DEFENDANT ALLEGES:

3. That for many years prior to the amendment of the said complaint as provided for in paragraph "4" of said stipulation, the plaintiff knew of the defendant's claims and of the claims of the defendant's predecessor in interest to the additional compositions included in said amendment of the complaint, and plaintiff delayed for

many years in bringing this suit with respect thereto, and such unreasonable delay has prejudiced the defendant herein as well as its predecessor in interest, and plaintiff by reason thereof has been guilty of laches and is barred from maintaining this suit.

WHEREFORE, the defendant demands the same judgment and the same relief with respect to the additional compositions included by the said amendment of the complaint, as it demanded in its original answer with respect to the original complaint.

Dated, New York, June 25, 1954.

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1958

No. 220

CHARLES K. HARRIS MUSIC PUBLISHING CO., INC.,

Petitioner,

—against—

EDWARD B. MARKS MUSIC CORPORATION,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

MAXWELL OKUN,
Attorney for Petitioner,
67 West 44th Street,
New York City.

MAXWELL OKUN,
ARTHUR L. FISHBEIN,
Of Counsel.

INDEX

	PAGE
Opinions Below	2
Jurisdiction	2
Question Presented	2
Statutes and Rules Involved	3
Statement	3
Basis for Federal Jurisdiction	5
Reasons for Granting the Writ	6
The Decision Sought to Be Reviewed Is in Conflict With Decisions of Other Courts of Appeals as Well as With a Prior Decision of the Same Court of Appeals and Is in Conflict With Applicable Decisions of This Court on the Same Federal Question	6
Conclusion	11
Appendix I:	
Opinion of District Court Denying Plaintiff's Motion for Appointment of a Special Master to Assess Damages and Profits,	App. I-1
Opinion of the Court Below in Reversing on Plaintiff's Appeal	App. I-3
Appendix II:	
Judgment of Affirmance on Defendant's Appeal and Reversal on Plaintiff's Appeal,	App. II-1

Table of Cases Cited

Bankers Trust Co. v. *Virginia Railway & Power Co.*, 4 Cir., 273 Fed. 999	6
Brown v. *County of Buena Vista*, 95 U. S. 157	8
Greenbie v. *Noble*, D. C. S. D. N. Y., 151 F. Supp. 45	8

PAGE

Hammond v. *Hopkins*, 143 U. S. 224 8
Haynes & Co. v. *Druggists' Circular*, 2 Cir., 32 F. 2d 215 ..... 6, 7, 8, 9
Hicks v. *Bekins Moving & Storage Co.*, 9 Cir., 115 F. 2d 406 ..... 8, 10
Johnston v. *Standard Mining Co.*, 148 U. S. 360 8
Kermit, The, 9 Cir., 76 F. 2d 363 6
McGrath v. *Panama Railway Co.*, 5 Cir., 298 F. 303 8
Morales v. *Moore-McCormack Lines*, 5 Cir., 208 F. 2d 218 8
Pollitzer v. *Foster*, 6 Cir., 59 F. 2d 901 ..... 6, 7
Reconstruction Finance Corp. v. *Harrisons & Crosfield*, 2 Cir., 204 F. 2d 366 8
Redman v. *United States*, 2 Cir., 176 F. 2d 713 8
Shell v. *Strong*, 10 Cir., 151 F. 2d 909 8
Sweeny v. *Anderson*, 10 Cir., 129 F. 2d 756 10
Westfal-Larson v. *Allman-Hubble, etc.*, 9 Cir., 73 F. 2d 200 8
Willard v. *Wood*, 164 U. S. 502 6

Other Authorities Cited

Copyright Act of 1909, Chap. 320, 35 Stat. 1075 5
Federal Rules of Civil Procedure, Rule 54(c) 3
17 U. S. C. (3a) 5
28 U. S. C.:
Section 1254(1) 2
Section 1338 ..... 5, 6
Section 2202 ..... 3, 4

IN THE

Supreme Court of the United States

OCTOBER TERM, 1958

No.

CHARLES K. HARRIS MUSIC PUBLISHING CO., INC.,

Petitioner,

—against—

EDWARD B. MARKS MUSIC CORPORATION,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

To the Honorable, the Chief Justice and the Associate Justices of the Supreme Court of the United States:

Petitioner prays that a writ of certiorari issue to review so much of the judgment of the United States Court of Appeals for the Second Circuit in the within action, dated and entered May 16, 1958, as reverses the amended declaratory judgment of the United States District Court, Southern District of New York, entered on February 3, 1956, insofar as it denied plaintiff's motion for the apointment of a master to take evidence, compute, ascertain and report concerning infringements, damages, and profits, and remands this cause to the District Court for further proceedings in accordance with its opinion.

Opinions Below

The opinion of the District Court denying plaintiff's motion for the appointment of a master to assess money damages and profits (Appendix I, infra) is unreported. The opinion of the Court of Appeals reversing the amended declaratory judgment of the District Court insofar as it denied plaintiff's aforesaid motion (Appendix I, infra) is reported in 117 U. S. P. Q. 308.

Jurisdiction

The judgment of the Court of Appeals (Appendix II, infra) is dated and was entered on May 16, 1958. Jurisdiction is conferred on this Court by 28 U. S. C. Section 1254(1) which reads as follows:

> "28 U. S. C. Section 1254. Court of Appeals: CERTIORARI; etcetera.
>
> Cases in the courts of appeals may be reviewed by the Supreme Court by the following method:
>
> (1) By writ of certiorari granted upon the petition of any party to any civil or criminal case, before or after the rendition of judgment or decree."

Question Presented

Is a plaintiff who has delayed for eleven years in bringing an action for declaratory judgment to trial guilty of such laches as to estop it from claiming damages and profits in addition to the declaratory and injunctive relief awarded it?

Statutes and Rules Involved

The only statute involved is 28 U. S. C. Sec. 2202, which reads as follows:

> "Further necessary or proper relief based on a declaratory judgment or decree may be granted after reasonable notice and hearing against any adverse party whose rights have been determined by such judgment."

The only rule involved is F. R. Civ., Proc. rule 54(c), which reads as follows:

> "Except as to a party against whom a judgment is entered by default, every final judgment shall grant the relief to which the party in whose favor it is rendered is entitled even if the party has not demanded such relief in his pleadings."

Statement

Plaintiff and defendant, both music publishers, sought a declaratory judgment establishing their respective owership through Joseph E. Howard of his interest in the United States renewal copyrights in certain musical compositions composed by Howard as co-writer (148a).*

The District Court's amended judgment declared defendant to be the sole owner of Howard's interest in some of the renewal copyrights and plaintiff to be the sole owner of Howard's interest in the remainder

* All references to pages followed by "a", are references to appendices printed in the Court of Appeals and presented herewith. Pages 1a-81a are part of plaintiff's appendix. Pages 82a-135a are part of defendant's appendix. Pages 136a-159a are part of plaintiff's supplemental appendix.

of said renewal copyrights (76a); and awarded injunctive and incidental relief accordingly (77a-79a).

A motion by plaintiff (28a) pursuant to 28 U. S. C. Sec. 2202 for the appointment of a master to take evidence, compute, ascertain and report concerning infringements by defendant of plaintiff's renewal copyrights and to assess damages and profits in connection therewith, was denied by the District Court (73a, Appendix I, infra).

On plaintiff's appeal from this denial, the Court of Appeals reversed and remanded for further proceedings in accordance with its opinion (Appendix I and II, infra). On defendant's appeal, the Court of Appeals affirmed.

This action was instituted in 1944 and was tried in 1955, eleven years later (1a). More than seven years elapsed after the action was started before plaintiff took its first step towards prosecuting the same by serving on December 17, 1951, a notice to take defendant's deposition (84a). During the eleven years that the action was pending in the District Court, it was marked off the trial calendar twice and remained off the calendar for two years and 10 months (83a and 84a).

Plaintiff admittedly knew, as far back as October, 1937, that defendant's predecessor in interest, Cora L. Harris, made a claim to the renewal copyright of the composition "I WONDER WHO'S KISSING HER NOW", one of the compositions involved in this action. Plaintiff admittedly knew, as far back as March, 1938 that defendant's predecessor made a claim to the re-

newal copyrights in all the other compositions involved in this action (41a, 73a, 87a).

The only action which plaintiff took before the institution of this suit in 1944, was to start an action against Harris with respect to only the composition, "I Wonder Who's Kissing Her Now", one of the many involved in this suit, which it discontinued on the merits in 1945 (49a, 50a, 73a).

The complaint in this action contains no allegations of any infringing acts on the part of the defendant or anyone else. It alleges merely that a controversy exists with respect to which plaintiff needs a declaration because defendant represented that it owned Howard's interest in the renewal copyrights (3a, 5a, 6a). Though the complaint was amended 10 years after this action had been pending, plaintiff did not by these amendments allege any infringing acts. At no time did plaintiff demand a declaration of infringement or an accounting (73a, Appendix I, infra). Plaintiff at the trial, did not prove any acts of infringement, but proved only the controversy relating to ownership.

Basis for Federal Jurisdiction

Federal jurisdiction in the District Court was based on diversity of citizenship and amount, and on the existence of a question arising under the Copyright Act of 1909, Chap. 320, 35 Stat. 1075 now 17 U. S. C. (3a) and 28 U. S. C. Sec. 1338, which reads as follows:

> "28 U. S. C. Sec. 1338. Patents, Copyrights, Trade Marks and Unfair Competition.
>
> (a) The district courts shall have original jurisdiction of any civil action arising under

any Act of Congress relating to patents, copyrights and trade-marks. Such jurisdiction shall be exclusive of the courts of the states in patent and copyright cases."

Reasons for Granting the Writ

The Decision Sought to Be Reviewed Is in Conflict With Decisions of Other Courts of Appeals as Well as With a Prior Decision of the Same Court of Appeals and Is in Conflict With Applicable Decisions of This Court on the Same Federal Question.

This Court held in *Johnston* v. *Standard Mining Co.*, 148 U. S. 360 and *Willard* v. *Wood*, 164 U. S. 502, 525, that the mere institution of a suit does not relieve a plaintiff from laches, and if the plaintiff fails, as this plaintiff did, to prosecute his suit diligently, the consequences are the same as if no suit had been started.

That rule has since been followed and applied in *Bankers Trust Co.* v. *Virginia Railway & Power Co.*, 4 Cir., 273 Fed. 999. *Haynes & Co.* v. *Druggists' Circular*, 2 Cir., 32 F. 2d 215, 217; *Pollitzer* v. *Foster*, 6 Cir., 59 F. 2d 901, 903 and *The Kermit*, 9 Cir., 76 F. 2d 363, 367.

In *Pollitzer* v. *Foster*, supra, the Court refused to permit a plaintiff to recover in a patent infringement suit where the plaintiff delayed eleven years in bringing the suit to trial. The Court said at p. 903:

> "Again the failure diligently to prosecute a suit may be as fatal to a claimant's right to recover as if no action had been instituted (citing

cases). This principle is applicable to the plaintiffs' claims based on the Hartford patent. Suit was brought on that patent in 1913, but was abandoned, and more than five years later another suit was instituted which was not brought to trial until nearly eleven years thereafter. There is nothing in the record to show that this latter action might not have been prosecuted with expedition. Five years elapsed between the filing of the answer and the taking of any step looking to the prosecution of the case. Six more years elapsed before it was brought to trial. The record fails to show any reason for these delays * * *. In view of their inaction as to this patent, the plaintiffs cannot be permitted at this late date to recover thereunder."

In *Haynes & Co.* v. *Druggists' Circular*, supra, a plaintiff in a copyright infringement suit who had obtained an interlocutory decree of infringement was barred from recovering money damages because of its delay for nine years in proceeding before a Special master. The Court said at p. 217:

"Merely instituting a suit does not of itself relieve a person from the operation of the rule of laches; if he fails to prosecute his suit diligently, it is the same as though no suit had been begun. (citing cases) * * *. Lapse of time is an important element of laches, and where, as here, a case has been delayed in proceeding before a master to whom the cause has been referred, and delayed beyond the operation of the longest period of a statute of limitations for tort or contract, the bar of laches is a good defense to the entry of a final decree involving a money judgment.

> Here nine years elapsed between the first hearing before the master and a continuation of the hearings before him. Long lapse of time has been held sufficient of itself to prevent relief."

Although the Court below recognized the doctrine of the foregoing decisions, it committed error when it held that only "substantial delay which causes *actual prejudice* to the adverse party, can constitute laches" (Appendix I, infra, italics ours).

Prejudice will be presumed or implied from a long and unreasonable delay in the prosecution of an action. *Hicks* v. *Bekins Moving & Storage Co.*, 9 Cir., 115 F. 2d 406; *Haynes & Co.* v. *Druggists' Circular*, supra, p. 217; *Brown* v. *County of Buena Vista*, 95 U. S. 157, 161.

Prejudice will also be presumed or implied where the delay goes beyond the analogous statute of limitation. *Haynes & Co.* v. *Druggists' Circular*, 2 Cir., 32 F. 2d 215; *Reconstruction Finance Corp.* v. *Harrisons & Crosfield*, 2 Cir., 204 F. 2d 366, 367; *Morales* v. *Moore-McCormack Lines*, 5 Cir., 208 F. 2d 218; *McGrath* v. *Panama Railway Co.*, 5 Cir., 298 F. 303; *Redman* v. *United States*, 2 Cir., 176 F. 2d 713; *Shell* v. *Strong*, 10 Cir., 151 F. 2d 909; *Hammond* v. *Hopkins*, 143 U. S. 224, 273; *Westfal-Larson* v. *Allman-Hubble, etc.*, 9 Cir., 73 F. 2d 200.

Plaintiff's delay for 11 years in prosecuting this action was long, unreasonable and for a longer period than the analogous six year statute of limitation. *Greenbie* v. *Noble*, D. C. S. D. N. Y. 151 F. Supp. 45, 62.

The District Court properly found, in the exercise of its discretion, that such delay on the part of this plaintiff amounted "to such laches as to estop it from claiming damages and profits", and recognizing "The difficulty in assessing damages for acts committed so many years ago", properly found that the prejudice to the defendant therefrom was "manifest" (Appendix I, infra).

In reversing the District Courts' finding of "manifest prejudice", and requiring a showing of actual instead of implied or presumed prejudice, the Court of Appeals made a decision which is in direct conflict with the cited decisions of this Court and of the other Circuits and in conflict with its own decisions, especially its decision in *Haynes & Co.* v. *Druggists' Circular*, supra.

The defendant did not participate in plaintiff's delay in bringing this action to trial. It must be remembered that seven years elapsed between the filing of the answer and the taking of any step by plaintiff looking to the prosecution of the case.

This action had been pending almost eight years before defendant made its first request for a postponement (62a). During the eleven years that this action was pending, defendant requested five adjournments for a total period of four months and nineteen days (62a, 68a-71a). Two of these adjournments became necessary because of the sudden illness of a witness, Monroe, who was to attend the trial in person, and whose deposition was taken by defendant and offered and received in evidence at the trial of this action (70a, 71a, 97a).

It is obvious that all the other requests for adjournments were made by plaintiff, in spite of the fact that the affidavit of its attorney or his associate may state that defendant "joins in the request" (52a-59a, 63a-67a, 72a). For example, can it be said that defendant requested the adjournment where an affidavit is submitted by plaintiff's attorney or his associate, and the reason for the adjournment is that plaintiff's attorney is preparing for another trial (53a); or that plaintiff is securing "further data" for use upon the trial (57a, 58a); or that plaintiff's attorney was in England (66a)?

In *Hicks* v. *Bekins Moving & Storage Co.* supra, the Court said at p. 409:

> "The duty rests upon the plaintiff at every stage of the proceeding to use diligence and to expedite his case to a final determination * * *".

To the same effect: *Sweeny* v. *Anderson*, 10 Cir., 129 F. 2d 756, 758.

We respectfully submit that it requires no citation of authority to establish, and this Court must be judicially aware of, the fact that it is the plaintiff and not the defendant who controls the prosecution of a law suit, and it is the plaintiff and not the defendant who can say how soon the action shall be brought to trial.

Conclusion

The granting of a writ of certiorari is necessary to correct the conflict brought about by the decision in the Court below, which permits a plaintiff, who has unreasonably delayed bringing a suit for declaratory judgment to trial, to make, 11 years after the institution of the suit, an application for the appointment of a special master to assess damages and profits.

Dated, New York, July 15th, 1958.

Respectfully submitted,

MAXWELL OKUN,
Attorney for Petitioner.

MAXWELL OKUN,
ARTHUR L. FISHBEIN,
Of Counsel.

APPENDIX I

Opinion of District Court Denying Plaintiff's Motion for Appointment of a Special Master to Assess Damages and Profits.

Plaintiff is entitled to similar affirmative relief with respect to compositions listed in Group 2 as was granted defendant with respect to those in Group 1. Accordingly the judgment will be amended as follows:

Paragraph 3 of the judgment which was entered is stricken and the following recital substituted:

"3. Plaintiff has at all times been, and now is, the sole owner and proprietor of the interest through Joseph E. Howard in the renewal copyright of each of the musical compositions listed in Group 2".

Paragraph 6 is amended to include injunctive relief with respect to the compositions in Group 2 as well as those in Group 3; paragraph 8 is amended to include a declaration of invalidity, etc. with respect to Group 2 as well as Group 3.

A provision for further relief based on this judgment under Section 2202, 28 USCA, and the appointment thereunder of a Master to assess damages and profits is not warranted in this suit. Plaintiff has not sought a declaration of infringement or an accounting. As early as March, 1938 it had knowledge that defendant's predecessor made claim to the litigated renewal copyrights, and particularly with respect to the one composition singled out by plaintiff (on this motion) as a source of revenue far above the average ("I Wonder Who's Kissing Her Now"), it had such knowledge as early as October 1937. Moreover, a suit started by plaintiff against defendant's predecessor involving this song was in 1943 discontinued on the merits;

not until 1944 did plaintiff file the instant action and for 11 years delayed prosecution of it. This unreasonable delay on the part of plaintiff in asserting its rights amounts to such laches as to estop it from claiming damages and profits. Haynes v. Druggists' Circular, 32 F. 2d 215; Johnston v. Mining Co., 148 U. S. 760; Pollitzer v. Foster, 59 F. 2d 901. The difficulty in assessing damages for acts committed so many years ago and the manifest prejudice to defendant precludes the granting of additional relief at this late date.

Motion granted with respect to paragraphs 3, 6 and 8 of the judgment; denied in all other respects. Submit amended judgment on notice.

12 6 55

SYLVESTER J. RYAN
U. S. D. J.

Opinion of the Court Below Reversing on Plaintiff's Appeal.

UNITED STATES COURT OF APPEALS

FOR THE SECOND CIRCUIT

No. 276—October Term, 1957.

(Argued March 25, 1958 Decided May 16, 1958.)

Docket No. 24042

EDWARD B. MARKS MUSIC CORPORATION,

Plaintiff-Appellant-Appellee,

—v.—

CHARLES K. HARRIS MUSIC PUBLISHING CO., INC.,

Defendant-Appellee-Appellant.

Before:

CLARK, *Chief Judge*,

LUMBARD, *Circuit Judge*, and DIMOCK, *District Judge*.

Appeals from the United States District Court for the Southern District of New York, Sylvester J. Ryan, *Judge*.

Plaintiff, Edward B. Marks Music Corporation, appeals from an order denying its motion for further relief based upon a declaratory judgment, and defendant, Charles K. Harris Music Publishing Co., Inc., appeals from a judgment declaring plaintiff the sole owner of copyrights in certain songs. Reversed in part and remanded.

JULIAN T. ABELES, New York City, *for plaintiff-appellant-appellee.*

MAXWELL OKUN, of Fishbein & Okun, New York City (Arthur L. Fishbein, of Fishbein & Okun, New York City, on the brief), *for defendant-appellee-appellant.*

CLARK, *Chief Judge:*

Plaintiff instituted this action in 1944 for a declaratory judgment that it was the sole owner of the renewed copyrights in a number of songs written by Joseph E. Howard and for an injunction restraining defendant from infringing its copyrights. Defendant asked by way of counterclaim for like relief in its favor. After numerous delays the case came to trial in 1955. The district court's judgment declared the defendant the sole owner of the renewed copyrights in 28 of the songs, and the plaintiff the sole owner of the renewed copyrights in 154 of the songs. In addition it provided appropriate injunctive relief. Thereupon plaintiff moved for an adjudication of infringement and for an accounting as further relief based on the declaratory judgment.[1] The district court denied the motion. Plaintiff appeals from this denial, and defendant appeals from that part of the judgment which declared the plaintiff to be sole owner of the renewed copyrights in the 154 songs.

We deal first with the defendant's appeal. Defendant's interest in the renewed copyrights depends on an unrecorded conveyance executed in 1916 by Howard to defendant's predecessor, Charles K. Harris, the original pub-

[1] The plaintiff also moved to alter and amend the judgment pursuant to F. R. Civ. Proc., rule 59(e), to provide that it was the sole owner of the copyrights in another group of songs in which the court found defendant had no interest and for injunctive relief with respect to these songs. This motion was granted, and defendant takes no appeal from this aspect of the case.

lisher of Howard's songs. The conveyance, which makes no mention of renewal rights, states in part that in consideration of $150 Howard conveys to Harris all his "right, title and interest by way of copyrights or otherwise * * * in and to all my musical compositions published by Chas. K. Harris of New York City." Plaintiff's claim of ownership is based on an agreement between it and Howard executed on June 6, 1933 (prior to the end of the original copyright terms), which clearly provided for the assignment of the renewal copyrights in Howard's songs. This agreement, recorded in the Copyright Office ten months after its execution, was followed by specific assignments from Howard to plaintiff of each of the litigated songs after the copyrights were renewed. Each such assignment provided that it was made pursuant and subject to the agreement of June 6, 1933, and each was duly recorded within the statutory period provided in 17 U. S. C. § 30.

In 1936, Howard executed seventeen separate assignments of the renewal rights to the songs in issue to defendant's predecessor which subsequently were recorded. But these are of no help to defendant unless the instrument executed by Howard in 1916 conveyed to Harris the renewal rights, for, prior to the 1936 assignments, plaintiff had recorded the valid agreement assigning to it the renewal rights to the songs, as we have just stated.

The cases are clear that a copyright renewal creates a separate interest distinct from the original copyright and that a general transfer by an author of the original copyright without mention of renewal rights conveys no interest in the renewal rights without proof of a contrary intention. *G. Ricordi & Co.* v. *Paramount Pictures, Inc.*, 2 Cir., 189 F. 2d 469, certiorari denied 342 U. S. 849; *Rossiter* v. *Vogel*, 2 Cir., 234 F. 2d 908. Here we have a general transfer to defendant's predecessor which makes no mention of renewal rights. But to show that Howard intended to include the renewal rights in the grant, defendant produced the deposi-

tion of Isabelle B. Monroe, who was Harris' secretary in 1916. She testified that after Howard had signed the conveyance, and in his presence, Harris stated that "all the property was ours and all the renewals became part of our catalogue." The district court rejected this deposition as determinative of Howard's intent to include the renewal rights, and we agree. It is surely tenuous at best to conclude that Howard really intended to strip himself of his separate interest in the renewals by merely saying nothing (if he heard) in response to Harris' somewhat ambiguous self-supporting statement. Actually the deposition was taken 39 years after the alleged conversation, and it is quite inconceivable that the witness remembered in detail all the relevant circumstances surrounding the event. Moreover, it is quite probable that the whole purpose of the 1916 conveyance was to extinguish Harris' liability to pay royalties to Howard pursuant to prior contracts between the principals. This is supported by one part of the conveyance which provided that Howard released Harris "from payment of royalties or otherwise by reason of any contract or understanding had between the parties concerning said musical compositions." At best, then, we have a situation where the conveyance is silent as to renewal copyrights; and the extrinsic evidence concerning intent is ambiguous. This is insufficient to support defendant's claim.

On the other hand, plaintiff's claim of ownership is based on an unambiguous agreement with Howard which clearly conveyed to it all renewal copyrights in the songs at issue and which provided that Howard would execute all necessary renewals for plaintiff's benefit. Defendant's objections to the validity of this agreement are not well taken. Most of them erroneously presume that the 1916 instrument effectively conveyed renewal rights to Charles K. Harris and that the plaintiff's alleged failure to comply with 17 U. S. C. § 30 stripped it of any rights as a bona fide pur-

chaser for value. But as we have shown, the 1916 conveyance gave defendant no interest in the renewal rights; and hence its claim of ownership must be based on the seventeen separate assignments executed by Howard in 1936. Under this analysis it is evident that plaintiff's failure to record the 1933 agreement within three months of its execution vests no rights in defendant. For defendant to prevail under §30 it had to be a subsequent purchaser without notice, and admittedly in 1936 it had notice of plaintiff's interest. Conversely, it matters little that in 1933 plaintiff might have had notice of defendant's claim, for this could have been notice only of an invalid claim. Finally, defendant says that plaintiff was not a purchaser for a valuable consideration, because the 1933 agreement provided for royalties, including an advance of $200. Although a promise to pay royalties in the future, coupled with notice of a prior claim before payment, might deprive a subsequent purchaser of the status of a bona fide purchaser under §30, *Rossiter* v. *Vogel*, *supra*, 2 Cir., 134 F. 2d 908, 911, the doctrine has no application to a prior purchaser, which is what plaintiff is here. Thus in order to upset the 1933 agreement, defendant must show the lack of any consideration, which obviously is out of the question. Plaintiff's ownership, therefore, is well supported by the record, and the district court correctly rejected defendant's claims to the songs at issue.

We come, then, to plaintiff's appeal from the denial of its motion for an adjudication of infringement and for an accounting. If plaintiff is not barred by laches this relief is proper. 28 U. S. C. §2202 specifically provides that: "Further necessary or proper relief based on a declaratory judgment or decree may be granted, after reasonable notice and hearing, against any adverse party whose rights have been determined by such judgment." We take this to mean that the further relief sought—here monetary recompense—need

not have been demanded, or even proved, in the original action for declaratory relief. The section authorizes further or new relief based on the declaratory judgment, and any additional facts which might be necessary to support such relief can be proved on the hearing provided in the section or in an ancillary proceeding if that is necessary. Cf. *Security Ins. Co. of New Haven* v. *White*, 10 Cir., 236 F. 2d 215. Here the further demand for relief is based on the declaration of plaintiff's ownership of the songs at issue and, unless otherwise barred, is proper under the statute. The real question, then, is whether the district court was correct in holding that the eleven-year delay between the institution of the suit and the trial constitutes laches which estops plaintiff from now receiving the further relief which it seeks.

Plaintiff instituted this action in 1944, some six years after it had notice of threatened infringement by defendant's predecessor. We see no basis for the application of laches concerning this six-year period, for it appears that in 1941 (some three years after notice) plaintiff commenced a suit against defendant's predecessor concerning the renewed copyright in one of Howard's songs where the question at issue was the effect of the 1916 conveyance. Although that suit was discontinued, *Edward B. Marks Music Corp.* v. *Jerry Vogel Music Co.*, D. C. S. D. N. Y., 49 F. Supp. 135, it was dropped only after defendant's predecessor withdrew her claim to the song under the conveyance, which would indicate that defendant's predecessor then believed that the 1916 conveyance did not pass renewal rights. Under the circumstances it seems clear that the plaintiff can be charged with no serious delay in instituting the suit.

Of course, as we know, failure to prosecute a suit diligently, resulting in a substantial delay which causes actual prejudice to the adverse party, can constitute laches. *D. O. Haynes & Co.* v. *Druggists' Circular*, 2 Cir., 32 F. 2d 215;

Pollitzer v. *Foster*, 6 Cir., 59 F. 2d 901. Here the delay was eleven years, and defendant contends that this should estop plaintiff from now demanding damages in addition to the awarded declaratory and injunctive relief. First, the defendant claims that plaintiff waived such additional relief by failing in its complaint to allege infringement and consequent damages. But obviously this argument is specious. If plaintiff had proved infringement on the trial it would have been entitled to damages under F. R. Civ. Proc., rule 54(c); but under the declaratory judgment statute it was not compelled to take this course. Hence defendant was not entitled to assume from the absence of a plea for damages that plaintiff would not seek them at trial. Likewise defendant was not entitled to assume that plaintiff would not seek damages after trial and entry of the declaratory judgment because plaintiff's complaint ended with the prayer "that upon application therefor, plaintiff be granted such further relief based on said declaratory judgment as may be necessary or proper"—the very procedure provided by 28 U. S. C. §2202. The course plaintiff adopted was thus not unusual.

Second, defendant contends, and the district court agreed, that the eleven-year delay prejudiced its defenses against the infringement claims. But the record shows that the defendant consented to or joined in applications for these delays. So clearly it was then unworried as to prejudice resulting from them. Moreover, its affidavits show no specific prejudice; and the court's findings of "manifest prejudice" are not supported by anything in the record. The record does show, however, commendable efforts on the part of both parties to litigate all their claims concerning ownership of Howard's songs in this proceeding. Amendments of the pleadings indicate that the claims were complex, which probably accounts to some degree for the delay.

Doubtless the parties, too, were both stimulated to renewed interest by the renaissance of old songs under the benign auspices of radio and television. Each case where laches is urged as a defense must be decided on its own facts. Under the circumstances here present it seems unfair to tax plaintiff, the rightful owner, rather than defendant, the infringing wrongdoer, with severe penalties for the delay in which they both participated.

On the defendant's appeal affirmed; on the plaintiff's appeal reversed and remanded for further proceedings in accordance with this opinion.

APPENDIX II

Judgment of Affirmance on Defendant's Appeal and Reversal on Plaintiff's Appeal.

UNITED STATES COURT OF APPEALS

FOR THE SECOND CIRCUIT

At a Stated Term of the United States Court of Appeals, in and for the Second Circuit, held at the United States Courthouse in the City of New York, on the 16th day of May one thousand nine hundred and fifty-eight.

Present:

HON. CHARLES E. CLARK,
Chief Judge.

HON. J. EDWARD LUMBARD,
Circuit Judge.

HON. EDWARD J. DIMOCK,
District Judge.

EDWARD B. MARKS MUSIC CORPORATION,
Plaintiff-Appellant,

v.

CHARLES K. HARRIS PUBLISHING COMPANY, INC.,
Defendant-Appellant.

Appeal from the United States District Court for the Southern District of New York.

This cause came on to be heard on the transcript of record from the United States District Court for the

Southern District of New York, and was argued by counsel.

On consideration whereof, it is now hereby ordered, adjudged, and decreed that on the defendant's appeal the judgment of said District Court be and it hereby is affirmed; and on the plaintiff's appeal said judgment be and it hereby is reversed and action remanded for further proceedings in accordance with the opinion of this court; with costs to the plaintiff-appellant.

A. Daniel Fusaro
Clerk

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1958

No. 220

CHARLES K. HARRIS MUSIC PUBLISHING CO., INC.,
Petitioner,

against

EDWARD B. MARKS MUSIC CORPORATION,
Respondent.

BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI

ABELES & BERNSTEIN,
Attorneys for Respondent.

JULIAN T. ABELES,
HAROLD BERKOWITZ,
Of Counsel.

PAGE

Craftint Mfg. Co. v. Baker, 94 F. 2d 369 (Cir. 9) 8

D. O. Haynes & Co. v. Druggists' Circular, 32 F. 2d 215 (Cir. 2) 11

Galliher v. Cadwell, 145 U. S. 368 7

Gardner v. Panama Railroad Co., 342 U. S. 29 .... 6, 12

Gaskins v. Bonfils, 79 F. 2d 352 (Cir. 10) 9

Hammond v. Hopkins, 143 U. S. 224 12

Hicks v. Bekins Moving & Storage Co., 115 F. 2d 406 (Cir. 9) 11

Hoehn v. Crews, 144 F. 2d 665 (Cir. 10), affd. 324 U. S. 200 8

Holmberg v. Armbrecht, 327 U. S. 392 7

Johnston v. Standard Mining Co., 148 U. S. 360 10

McGrath v. Panama Railway Co., 298 F. 303 (Cir. 5) 12

Morales v. Moore-McCormack Lines, Inc., 208 F. 2d 218 (Cir. 5) 12

Northern Pac. Ry. Co. v. Boyd, 177 Fed. 804 (Cir. 9), affd. 228 U. S. 482 9

Nortuna Shipping Company v. Isbrandtsen Company, 231 F. 2d 528 (Cir. 2), cer. den. 351 U. S. 964 7

Pendery v. Carleton, 87 Fed. 41 (Cir. 8) 8

Pollitzer v. Foster, 59 F. 2d 901 (Cir. 6) 11

Reconstruction Finance Corp. v. Harrisons & Crosfield, Ltd., 204 F. 2d 366 (Cir. 2); cer. den. 346 U. S. 854 .... 7, 12

Redman v. United States, 176 F. 2d 713 (Cir. 2) 12

PAGE

Shell v. Strong, 151 F. 2d 909 (Cir. 10) 12

Southern Pacific Co. v. Bogert, 250 U. S. 483 6

St. Louis Car Co. v. J. G. Brill Co., 25 F. Supp. 244, affd. 99 F. 2d 999 (Cir. 3) 9

The Kermit, 76 F. 2d 363 (Cir. 9) 11

Westfal-Larson v. Allman-Hubble Tug Boat Co., 73 F. 2d 200 (Cir. 9) 12

Willard v. Wood, 164 U. S. 502 10

STATUTES AND RULES

28 U.S.C. Section 2202 (former Section 400, 1940 ed.) 2

Rule 54 (c) F.R.C.P. 2

IN THE

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OCTOBER TERM, 1958

No. 220

CHARLES K. HARRIS MUSIC PUBLISHING CO., INC.,

Petitioner,

against

EDWARD B. MARKS MUSIC CORPORATION,

Respondent.

BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI

Opinions Below

The opinion of the United States Court of Appeals for the Second Circuit (Appendix I 3-10)[1] is reported in 255 F. 2d 518.

The opinion of the United States District Court for the Southern District of New York (Appendix I 1, 2) is unreported.

Jurisdiction

The judgment of the Court of Appeals was made and entered on May 16, 1958 (Appendix II).

The jurisdiction of this Court is invoked by petitioner under 28 U.S.C. Section 1254 (1).

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[1] Appendix references are to Appendices I and II of the petition.

Statute and Rule Involved

28 U.S.C. Section 2202 (former Section 400, 1940 ed.) Rule 54 (c) F.R.C.P.

Question Presented

Accurately stated the question is whether a defendant can assert as laches a delay in the prosecution of an action for declaratory judgment in which it has counterclaimed for the same relief as prayed for by plaintiff, defendant having jointly participated in the delay and no prejudice being shown, so as to estop plaintiff from recovering further relief by way of damages and profits based upon said declaratory judgment.

Statement of the Case

Both parties are music publishers. The action is for a declaratory judgment that plaintiff is the sole owner of the interest through one Joseph E. Howard, as writer, in the renewal copyrights in certain musical compositions; and as in such case provided, in the second paragraph of former Section 400, 28 U.S.C. 1940 ed. (in effect when this action was instituted),

> "That upon application therefor, plaintiff be granted such further relief based on said declaratory judgment as may be necessary or proper." (R 3a-18a)[2]

Defendant in its answer sought the same relief by counterclaim as prayed for by plaintiff (R 141a-148a).

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[2] Record references are to appendices in the Court of Appeals. Pages 1a-81a are in plaintiff's appendix. Pages 82a-135a are in defendant's appendix. Pages 136a-159a are in plaintiff's supplemental appendix.

Plaintiff's claim is under an agreement with said Joseph E. Howard, dated June 6, 1933, in which there is a specific assignment of the "renewal and/or extension" of the copyright in each of said musical compositions (R 91a-95a).

Defendant's purported claim is under an agreement between defendant's predecessor, dated December 2, 1916, in which the assignment is only of the original copyrights in said musical compositions, there being no mention of the renewal copyrights (R 89a).

This action was instituted on August 31, 1944. The five schedules annexed to the original complaint listed 154 compositions. Defendant's predecessor had previously asserted a claim to the renewal copyrights in said compositions under the 1916 agreement. Plaintiff thereupon instituted an action against defendant's predecessor (one Cora L. Harris) upon one of the compositions, "where the question at issue was the effect of the 1916 conveyance." That suit "was dropped only after defendant's predecessor withdrew her claim to the song under the conveyance, which would indicate that defendant's predecessor then believed that the 1916 conveyance did not pass the renewal rights" (Appendix I 8). While plaintiff states in its petition that the action was discontinued, it fails to mention that the discontinuance was predicated upon the concession of defendant's predecessor that she acquired no renewal rights under the 1916 agreement (p. 5).

Defendant's predecessor abided by her concession in the prior action. In 1943 defendant acquired the assets of the business theretofore conducted by her (R 156a, 157a). Thereafter, defendant represented and asserted that it had acquired such renewals from its predecessor and that plaintiff had no right thereto (R 11a). As this eventually seriously hampered and interfered with plaintiff in the exercising of its rights, on August 31, 1944 plaintiff was compelled to institute this second action, involving the same subject matter as the first action (R 1a, 31-18a).

On May 20, 1954, within a year prior to the trial on April 18, 1955, the parties entered into an extended and comprehensive Agreed Statement of Facts (R 148a-157a). Defendant, for the first time asserted a claim under the 1916 agreement to the copyright renewals of 48 additional compositions. It was therefore provided that the complaint should be amended to comprehend these additional renewals and that defendant should have leave to serve a separate answer thereto. Defendant likewise waived the claim, previously asserted by it, to a number of the renewals included in the original complaint (R 149a, 150a).

By entering into the Agreed Statement, (1) a separate action involving the 48 additional compositions was avoided, (2) 50 compositions were eliminated, (3) all of the original and renewal copyright data and the status, except for ownership, of the remaining 152 litigated compositions was stipulated, and (4) the trial was substantially curtailed (R 19a).

Between the time of the institution of this action and the time of entering into the Agreed Statement on May 20, 1954, there had been 14 adjournments of the trial and proceedings, of which 8 were upon mutual consent and 6 at the request of both parties (R 52a-66a).

There were 6 additional adjournments of the trial subsequent to the execution of the Agreed Statement. Of these 1 was by mutual consent, 2 were at the request of both parties, and the remaining 3 were at the sole request of defendant (R 67a-72a).

None of the adjournments, either before or after the execution of the Agreed Statement, were obtained at the sole instance or request of plaintiff. All of the applications for adjournment of the trial and pre-trial hearings, to which plaintiff was a party, were supported by an affidavit for good cause shown, and were found to be meritorious as evidenced by the approval of the District Court in each and every instance.

The District Court determined that, since the 1916 agreement upon which defendant's claim was predicated "is silent on the renewal period of copyright," there is no basis for the claim (R 20a-23a).

Upon the entry of judgment, plaintiff made an application "for such further relief based on said declaratory judgment as may be necessary or proper," and, to enable the Court to grant such relief, for the appointment of a master to take evidence, compute and ascertain and to report to the Court concerning the extent of any damages and profits to which plaintiff might be entitled (R 28a-41a).

The application for such "further relief based on said declaratory judgment" was made pursuant to 28 U.S.C. Section 2202 (p. 3 of petition), for which provision was made in compliance therewith for such purpose as follows:

(1) In the prayer for relief in the complaint (R 18a).

(2) In the Agreed Statement, wherein it was expressly stipulated and agreed, that "The prayer for relief of each of the parties is that said party be declared the sole owner and proprietor of such interest, that the other party be enjoined and restrained from claiming or exercising any rights thereunder or thereto, and for such further relief as may be necessary or proper" (R 39a).

The District Court denied plaintiff's said application upon the ground that mere delay, in and of itself, was of "manifest prejudice to defendant" and "amounts to such laches as to estop it from claiming damages and profits" (R 74a).

Plaintiff appealed from the denial of the said application (R 81a), and defendant appealed from the judgment declaring plaintiff to be the owner of the renewal copyrights in the litigated compositions (R 134a, 135a).

The Court of Appeals reversed and remanded for further proceedings upon plaintiff's appeal and affirmed on defendant's appeal (Appendix II 1, 2), saying "But the

record shows that the defendant consented to or joined in applications for these delays. Moreover, its affidavits show no specific prejudice; and the court's findings of 'manifest prejudice' are not supported by anything in the record. The record does show, however, commendable efforts on the part of both parties to litigate all their claims concerning ownership of Howard's songs in this proceeding. Amendments of the pleadings indicate that the claims were complex, which probably account to some degree for the delay * * *. Each case where laches is urged as a defense must be decided on its own facts. Under the circumstances here present it seems unfair to tax plaintiff, the rightful owner, rather than defendant, the infringing wrongdoer, with severe penalties for the delay in which they both participated" (Appendix I 9, 10).

ARGUMENT

A.

Mere Lapse Of Time Cannot Constitute Laches. There Must Be Inexcusable Delay, Upon Which The Adverse Party Has Relied And Thereby Been Induced To Change Its Position To Its Prejudice.

Gardner v. *Panama Railroad Co.*, 342 U. S. 29, 30, 31:

> "Where there has been no inexcusable delay in seeking a remedy and where no prejudice to the defendant has ensued from the mere passage of time, there should be no bar to relief. *The Key City*, 14 Wall. 653 (1872); *Southern Pacific Co.* v. *Bogert*, 250 U. S. 483 (1919); *Holmberg* v. *Armbrecht*, 327 U. S. 392 (1946); see *McGrath* v. *Panama R. Co.*, 298 F. 303, 304 (1924)."

Southern Pacific Co. v. *Bogert*, 250 U. S. 483, 488 (cited and followed in the *Gardner* case):

> "More than twenty-two years had thus elapsed since the wrong complained of was committed. But the essence of laches is not merely lapse of time."

Holmberg v. *Armbrecht*, 327 U. S. 392, 396 (cited and followed in the *Gardner* case):

> "Equity has acted on the principle that 'laches is not like limitation, a mere matter of time; but principally a question of the inequity of permitting the claim to be enforced—an inequity founded upon some change in the condition or relations of the property or the parties.' *Galliher* v. *Cadwell*, 145 U. S. 368, 373; see *Southern Pacific Co.* v. *Bogert*, 250 U. S. 483, 488-89."

Galliher v. *Cadwell*, 145 U. S. 368, 372 (cited and followed in the *Holmberg* case):

> "They proceed on the assumption that the party to whom laches is imputed has knowledge of his rights, and an ample opportunity to establish them in the proper forum; that by reason of his delay the adverse party has good reason to believe that the alleged rights are worthless, or have been abandoned; and that because of the change in condition or relations during this period of delay, it would be an injustice to the latter to permit him to now assert them."

Reconstruction Finance Corp. v. *Harrisons & Crosfield, Ltd.*, 204 F. 2d 366, 370 (Cir. 2), cer. den. 346 U. S. 854:

> "Judge Phillips admirably stated the rule in *Shell* v. *Strong*, 10 Cir., 151 F. 2d 909, 911: 'Lapse of time alone does not constitute laches. Delay will not bar relief where it has not worked injury, prejudice, or disadvantage to the defendant or others adversely interested.'"

Nortuna Shipping Company v. *Isbrandtsen Company*, 231 F. 2d 528, 531 (Cir. 2), cer. den. 351 U. S. 964:

> "Laches, however, may not be established by mere delay; some substantial prejudice must be shown."

Hoehn v. *Crews*, 144 F. 2d 665, 670, 671 (Cir. 10), affd. 324 U. S. 200:

> "Laches has been defined as being inexcusable delay in asserting a right; an unexcused delay in asserting rights during a period of time in which adverse rights have been acquired under circumstances that make it inequitable to displace such adverse rights for the benefit of those who are bound by the delay. It has been said that laches differs from limitations in that limitations are concerned with the fact of delay, while laches concerns itself with the effect of delay."

Craftint Mfg. Co. v. *Baker*, 94 F. 2d 369, 374 (Cir. 9):

> "When suit is brought within that time the burden is on the defendant to show that extraordinary circumstances justify the application of the doctrine of laches. *City of Roswell* v. *Mountain States Telephone & Tel. Co.*, 10 Cir., 78 F. 2d 379, 385; see *Gillons* v. *Shell Oil Co.*, 9 Cir., 86 F. 2d 600. There must be reliance on the delay resulting in a change of position by the party asserting laches. * * * Appellant, in its brief, points to no evidence in the record showing a change of position after notice of infringement by appellees that would justify this court in reversing the decree of the District Court and applying the doctrine of laches either as to the accounting or the injunctive relief."

B.

The Defendant Cannot Assert As Laches The Delay In Which It Has Participated.

In *Pendery* v. *Carleton*, 87 Fed. 41, 47 (Cir. 8), although the cause did not come to trial until approximately fourteen years after the institution of the action, the court said:

> "The litigation, since it was instituted, has progressed slowly, but we perceive no reason for holding

that the complainant is solely accountable for the delay."

In *St. Louis Car Co.* v. *J. G. Brill Co.*, 25 F. Supp. 244, 247, affd. on opinion below 99 F. 2d 999 (Cir. 3), although the cause was not brought to trial for nearly twenty years, the court said:

> "On the whole, if I were required to make a guess at the proportion in which the parties contributed to the delay, I would say that the plaintiff was responsible for about 50% of it, and the defendant for about 30%, while the remaining 20% cannot be charged to either. However it is not a question of mathematics. The fact is that the defendant is in a substantial measure responsible for the delay which it now charges as laches on the part of the plaintiff. It is true 'that the mere institution of a suit does not, of itself, relieve a person from the charge of laches, and that if he fail in the diligent prosecution of the action the consequences are the same as though no action had been begun'. *Johnson* v. *Standard Mining Company*, 148 U. S. 360, 370, 13 S. Ct. 585, 589, 37 L. Ed. 480. But it is equally true that laches, invited or participated in by the defendant, will not be available as a defense."

Northern Pac. Ry. Co. v. *Boyd*, 177 Fed. 804, 824 (Cir. 9), affd. 228 U. S. 482:

> "Where the party interposing a defense of laches has contributed to or caused the delay, he cannot take advantage of it. 5 Pomeroy's Eq. Jur. § 35."

Gaskins v. *Bonfits*, 79 F. 2d 352, 357 (Cir. 10):

> "One who contributes to delay cannot afterwards assert it as laches. *Spiller* v. *St. Louis & S. F. R. Co.* (C.C.A.), 14 F. (2d) 284, and cases there cited."

C.

The Decision Of The Court of Appeals Is In Full Accord With The Applicable Decisions Of The Said Court, Of Other Courts Of Appeals, And Of This Court.

The defendant has cited no case in which the Court sustained the defense of laches where the defendant participated in the delay. In each case cited by defendant the Court either refused to sustain the defense, or the evidence established that the defendant had relied upon the delay to its substantial prejudice.

In *Johnston* v. *Standard Mining Co.*, 148 U. S. 360, plaintiff had deliberately withheld investing money for the acquisition of an interest in and the development of mining property until he had made certain, at the other parties' expense, that it was productive.

In *Willard* v. *Wood*, 164 U. S. 502, this court refused relief because of the evidence adduced of substantial prejudice to defendants' rights, saying (pp. 525, 526) "The changes which the lapse of time had wrought in the value of the property and in the situation of the parties were such as to render it inequitable to decree the relief sought."

The determination in *Bankers' Trust Co.* v. *Virginia Railway & Power Co.*, 273 Fed. 999 (Cir. 4), is at complete variance with defendant's argument. The District Court had refused to entertain a petition to intervene on the ground of laches. The Circuit Court reversed the order of the District Court upon the ground that the alleged laches did not deprive the petitioner of such right. The Circuit Court cited and followed *Abraham* v. *Ordway*, 158 U. S. 416, in which this court said (pp. 420, 421) that relief would be denied by equity only when there is inexcusable delay upon which the adverse party has relied and thereby been induced to change its position to its prejudice.

In *D. O. Haynes & Co.* v. *Druggists' Circular*, 32 F. 2d 215 (Cir. 2), an interlocutory decree had been entered, directing an accounting before a master. The Court pointed out that, with "no excuse" being given, the plaintiff (appellee) had delayed for nine years in bringing on the first hearing "during which time no action of any kind was taken, although the master wrote appellee, asking it to proceed." As the Court said (pp. 217, 218): "Of course, delay in prosecuting a pending suit may be excused as in other cases of apparent laches. * * * At bar, no excuse is given for this long delay in proceeding with the hearing before the master."

In *Pollitzer* v. *Foster*, 59 F. 2d 901 (Cir. 6), the court recognized (pp. 902, 903) "We understand, of course, that a delay which will serve as an equitable estoppel must be of the character which justifies the belief that there is assurance of immunity from a claim of liability."

In *The Kermit*, 76 F. 2d 363 (Cir. 9), the court said (p. 367) that, in determining whether the defense of laches should be sustained, it must be considered "whether plaintiff acquiesced in the assertion or operation of the corresponding adverse claim, the character of the evidence by which plaintiff's right is sought to be established, whether during the delay the evidence of the matters in dispute has been lost or became obscured or the conditions have so changed as to render the enforcement of the right inequitable, whether third persons have acquired intervening rights."

In *Hicks* v. *Bekins Moving & Storage Co.*, 115 F. 2d 406 (Cir. 9), the action was dismissed by the Court on its own motion, pursuant to a rule of the court, no one appearing for plaintiff upon the call.

In *Brown* v. *County of Buena Vista*, 95 U. S. 157, an application to enjoin the enforcement of a judgment was denied, where seven years had elapsed since its rendition and in the interim two material witnesses had disappeared.

Reconstruction Finance Corp. v. *Harrisons & Crosfield, Ltd.*, 204 F. 2d 366 (See quotation under "Argument A *supra*).

In *Morales* v. *Moore-McCormack Lines, Inc.*, 208 F. 2d 218 (Cir. 5), the Court said (p. 220) that the "correct rule" was stated by this Court in *Gardner* v. *Panama R. R. Co.*, 342 U. S. 29, viz: "Where there has been no inexcusable delay in seeking a remedy and where no prejudice to the defendant has ensued from the mere passage of time, there should be no bar to relief."

In *McGrath* v. *Panama Railway Co.*, 298 F. 303 (Cir. 5), the court said that since in the case of a libel in personam the libelant can sue at common law as well as in admiralty, "It would be inconsistent to permit him (libelant) to sue in admiralty, with the same effect as at common law (as is true in the case of a libel in personam), after his right to sue at common law had become barred."

In *Redman* v. *United States*, 176 F. 2d 713 (Cir. 2), a libel case, the determination of the court was to the same effect as in the *McGrath* case, *supra*.

In *Shell* v. *Strong*, 151 F. 2d 909 (Cir. 10), the court said (p. 911) "Lapse of time alone does not constitute laches. Delay will not bar relief where it has not worked injury, prejudice, or disadvantage to the defendant or others adversely interested."

In *Hammond* v. *Hopkins*, 143 U. S. 224, the Court said (p. 250) that a court of equity will not aid a party "whose application is destitute of conscience, good faith and reasonable diligence", as "when the difficulty of doing entire justice arises through the death of the principal participants in the transaction complained of, or of the witness or witnesses, or by reason of the original transactions having become so obscured by time as to render the ascertainment of the exact facts impossible."

In *Westfal-Larson* v. *Allman-Hubble Tug Boat Co.*, 73 F. 2d 200 (Cir. 9), a libel case, the determination of

the court was to the same effect as in the McGrath case, supra.

Defendant herein, having counterclaimed for the identical relief in its favor (R. 147a-148a) as that sought by plaintiff (R. 18a), had for every intent and purpose the same status as plaintiff in the prosecution of the action.

Despite the fact that defendant jointly participated with plaintiff in the delay, that it was not prejudiced by the delay, and that the District Court found it had not acquired even the semblance of a right to the renewals, it nevertheless seeks to invoke such delay to reap the gains of its infringement over a substantial part of the respective renewal terms.

CONCLUSION

The petition should be denied.

Respectfully submitted,

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